MANUAL OF PATENT EXAMINING PROCEDURE

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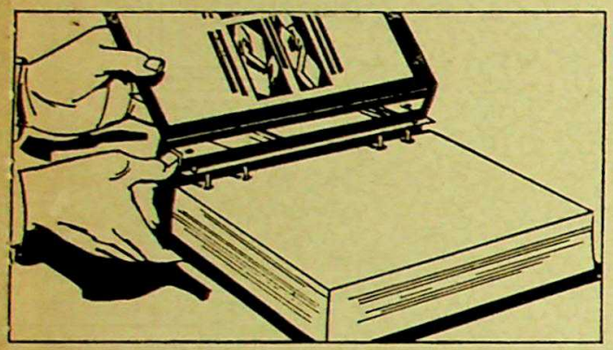
MANUAL OF

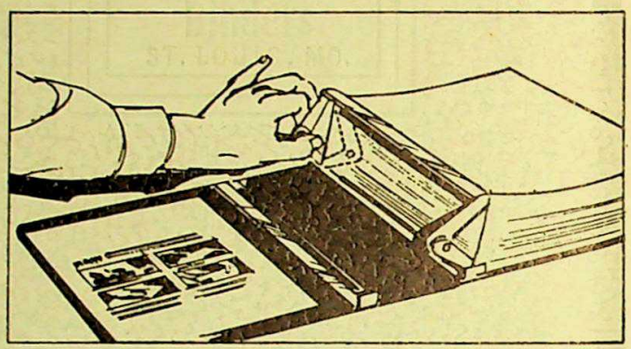
PATENT EXAMINING PROCEDURE

PROPERTY OF THE UNITED STATES GOVERNMENT

For fast operation of your Swing Hinge Binder follow these simple instructions:

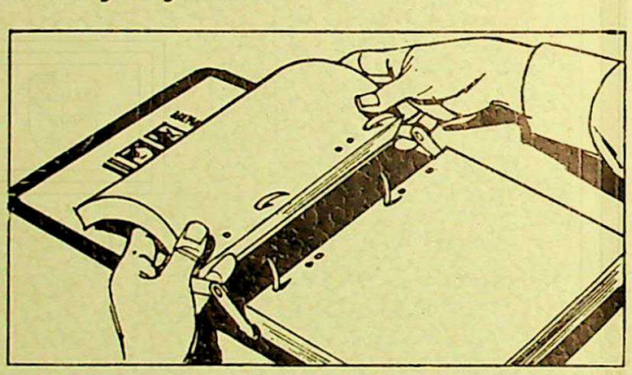


1. To open: Push forward on latch; lay cover back.



2. Swing hinges outward.

3. Place hand as illustrated where sheet is to be removed or inserted. Then roll back.



4. To close: Place fingers under prong-bar with thumbs holding front section. Roll pages toward back, threading prongs into holes.

5. Swing hinges in. Close cover.

Manufactured by
ROYAL McBEE CORP.
St. Louis, Mo.

PROTECTED BY U. S. PATENT No. 2,791,220

TO REORDER, REFER TO T-61650

UNITED STATES DEPARTMENT OF COMMERCE ★ PATENT OFFICE ★ WASHINGTON

MANUAL OF PATENT EXAMINING PROCEDURE, 3rd. Ed.
Change Notice

Series No. 41-1
(Follows Change 29-1)

Reference: MPEP 803

May 1, 1974

PRACTICE RE MARKUSH-TYPE CLAIMS

This notice deals with Markush-type claims which include a plurality of alternatively usable substances or members. In most cases this recitation by enumeration is used because there is no appropriate or true generic language.

Where an application claims two or more independent and distinct inventions, the Commissioner, under the provisions of 35 U.S.C. 121, may require the application to be restricted to one of the inventions.

A Markush-type claim is directed to "independent and distinct inventions," if two or more of its members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s).

If the claim is of that nature, the examiner is authorized to reject it as an improper Markush claim and for misjoinder under 35 U.S.C. 121 and to require the applicant to restrict the application to a single invention. In making such a requirement, the examiner will (1) clearly delineate the members or groups of members believed to constitute improperly joined inventions, and (2) state reasons fully explaining why they are independent and distinct. Applicant's response to such a requirement should be an election of a single adequately disclosed and supported invention, with or without restriction of the claim(s) to that invention. Of course, the response must not introduce new matter into the application. See 35 U.S.C. 132 and In re Welstead, 59 CCPA 1105, 463 F. 2d 1110, 174 USPQ 449 (1972). A refusal to elect a single invention will be treated as a non-responsive reply.

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner is encouraged to examine it on the merits, even though it is directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure outlined in the preceding paragraph and will not require restriction.

Where the examiner has rejected the claim and required restriction and the applicant has responded without restricting the claim(s) to a single invention, the examiner shall, if the position is adhered to, again reject the claim and any other Markush claims not restricted to the elected invention. No further examination of these claims is required unless and until such rejection has been overcome. However, if the search of the single elected invention develops prior art which would render both the elected invention and the improper Markush claim(s) unpatentable, such prior art may be applied in rejections of both without a complete search of the subject matter of the improper Markush claim(s). Otherwise, only true generic claims and those restricted to the elected invention will be examined in the usual manner.

Review of the rejection will be by appeal to the Board of Appeals under 35 U.S.C. 134.

C. Marshall Dann
Commissioner of Patents

922 O.G. _____, issue of May 28, 1974

UNITED STATES DEPARTMENT OF COMMERCE ★ PATENT OFFICE ★ WASHINGTON

MANUAL OF PATENT EXAMINING PROCEDURE, 3rd. Ed.
Change Notice

Reference: MPEP 608.01(n)

SERIES NO. 17-2
(Follows Change 17-1)

June 4, 1968

TRIAL MULTIPLE DEPENDENT CLAIM PRACTICE

For the trial period running from July 1, 1968 through December 31, 1968, all applications and amendments to applications filed in the Patent Office will be permitted to include multiple dependent claims which refer back to any of the preceding claims in the alternative whether independent or dependent. In this manner a claim may have a single number but would effectively be considered and treated as a plurality of claims. Entry into this program will require (1) the filing of a written request in which the applicant agrees to abide by the conditions of the program, and (2) the filing of appropriate fees and a showing of the fee calculation. Although the trial period terminates December 31, 1968, the prosecution of all applications placed in this program will continue under the program guidelines.

A claim dependent upon any of a plurality of preceding claims will be considered in acceptable form and entered provided it is otherwise acceptable and does not (1) cross statutory classes with any of its parent claims, or (2) depend from any other multiple dependent claim, or (3) refer back to preceding claims in the conjunctive rather than the disjunctive form (e.g., "The tool as defined in any one of claims 1, 2, and 4 . . ." is acceptable, but "The tool as defined in claims 1 and 2 . . ." is not acceptable. Likewise, "The tool as defined in claims 1, 2, or 4 . . ." is acceptable, whereas "The tool as defined in claims 1, 2 and/or 4 . . . " is not acceptable). Should any dependent claim include a claim association that violates any of the above prohibitions the claim will be rejected as indefinite for failure to comply with 35 U.S.C. 112 and will not be further treated with regard to any other claim association. Also, multiple dependent claims will not be considered for entry after final rejection. Further, during this trial period, for the applications involved in this program the total numbered claims may not exceed ten. Non-compliance with this condition will result in applicant being given one month to reduce the total numbered claims to ten. In newly filed cases, the failure to comply within the one month period will result in loss of filing date. In all other cases the entire amendment will not be entered in the absence of compliance with this requirement.

It is suggested that the claims be arranged in order of narrowing scope whereby the first claim presented is the broadest. Claims dependent upon the broad claim should come next, followed by claims which are dependent upon any of the plurality of preceding claims.

Practice and Rejections

When acting on a multiple dependent claim, the examiner will consider the patentability of the various claim associations encompassed by said claim and apply any pertinent prior art in the usual manner. Each of these associations should be compared with the prior art, exactly as if it were presented as an independent claim. If a claim having multiple dependency should include both patentable and unpatentable claim associations, the Examiner will identify each of the patentable claim associations and identify and specifically reject each of the unpatentable claim associations. However, mere failure to reject a claim association does not give rise to a presumption of allowability.

For fee purposes every claim which refers to any of the preceding claims will be considered effectively as a dependent claim for each association of claims that it represents, thereby effectively increasing the number of claims in the case. Therefore, in these cases the additional fees required for claims in excess of ten will be two dollars($2.00) times the total effective number of claims in excess of ten. This fee is based on the fact that such a claim is, in substance and so far as the work of examination is concerned, equivalent to a number of dependent claims each based on a single preceding claim.

(over)

In applications not under this program but having multiple dependent claims, it will be assumed that applicant intends these claims as effectively only a single claim. Accordingly, such claims will be considered alternative and therefore indefinite under 35 U.S.C. 112.

Rule 75(c) is hereby suspended for the duration of the trial period in those cases presenting multiple dependent claims under this program insofar as conflict exists between the requisites of the rule and the proposed practice.

Richard A. Wahl
Assistant Commissioner

Published 851 O.G.
6/25/68

identified as a division of the joint application. In like manner under Rule 45(c), a new joint application for divisible subject matter present in a sole application may be identified as a division if filed by the sole applicant and another during the pendency of the sole. See § 201.11.

However, the following conditions must be satisfied in each of the foregoing situations,

(a) It must appear that the parent application was filed "through error and without any deceptive intention".

(b) On discovery of the mistake the new application must be diligently filed and the burden of establishing good faith rests with the new applicant or applicants.

(c) There must be filed in the new application the verified statement of facts required by Rule 45.

For notation to be put on the file wrapper by the Examiner in the case of a divisional application see § 202.02. [R–22]

201.07 Continuation [R–22]

A continuation is a second application for the same invention claimed in a prior application and filed before the original becomes abandoned. Except as provided in Rule 45, the applicant in the continuing application must be the same as in the prior application. The disclosure presented in the continuation must be the same as that of the original application, i.e., the continuation should not include anything which would constitute new matter if inserted in the original application.

At any time before the patenting or abandonment of or termination of proceedings on his earlier application, an applicant may have recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the Primary Examiner.

For notation to be put on the file jacket by the Examiner in the case of a continuation application see § 202.02.

Streamlined Continuation

If the drawings and specification of a new application are to be identical with those of a pending application of the same applicant, and if the claims are to be directed to the same invention as that prosecuted in the pending application, the application papers of the earlier case, excepting the claims but including the drawing, may be used in the new case. A request for the use of such papers must be made and such request will be considered a waiver of the right to further prosecution of the earlier application and will terminate proceedings therein as of the filing date accorded the new application. The streamlined continuation application will be considered as having been filed before the abandonment of the earlier application (35 U.S.C. 120). A new set of claims directed to the same invention as that prosecuted in the pending application is required. The filing fee will be that appropriate to all the claims to be included in the new case. The entire file wrapper contents of the earlier application will be included in the file of the new one but the Office actions in the former will not be regarded as actions in the latter and the prosecution of the new application will be conducted in the same manner as if new application papers had been filed. A new serial number and filing date will be accorded but the effective filing date will be that of the earlier application.

A suggested format for transmitting a new set of claims and requesting the use of the contents of an earlier filed application for a streamlined continuation application is set forth below.

Request for Streamlined Continuation Application Under Commissioner's Order 824 O.G. 1

Earlier copending application:

Applicant(s) _____

Serial No. _____

Filed _____

Title _____

Enclosed are:

1. A new set of claims.
2. Filing Fee of $_____ (or*), to cover—

Total Number of Claims _____

Independent Claims _____

Please use the contents (specification and drawings) of the above application in the new application since it meets all the requirements of the above Commissioner's Order dated February 11, 1966. The specification (and drawings) of the new application are identical with the earlier application, and the new claims are directed to the same invention.

*"Authorization letter (2 copies) for use of funds in my Deposit Account No. _____ for the filing fee of $_____, to cover—

Total Number of Claims _____

Independent Claims _____

The streamlined continuation application procedure may not be used when at the time of filing the continuation application: (1) the parent application has been allowed and the issue fee has been paid; (2) the parent application is, or has been, involved in court action; (3) the parent application has been abandoned; or (4) the parent application is, or has been, involved in an interference declared prior to the date of filing the streamlined continuation application. If a continuation application having one of the above defects (as determined by the clerical personnel as soon as the application

is received in the Examining Group) is filed, it is returned to Application Branch for cancellation of the serial number and filing date, and applicant notified accordingly.

If there is a defect in the format of a streamlined continuation application which can be corrected, such as failure to include claims drawn to the same invention prosecuted in the parent application, failure to grant a power of attorney in either application to the person filing the continuation application, or some other minor defect, applicant will be given one month to correct the defect. Failure to do so will result in the cancellation of the continuation application.

The Primary Examiner makes an initial review, the main function of which is to determine that the new case is a proper continuation and how to treat the case if it is not proper.

While the conditions of the streamlined practice require that "the claims are to be directed to the same invention as that prosecuted in the pending application," the inclusion of one such claim will be acceptable to preserve the serial number and filing date. Claims to the same invention in continuation cases are claims which cannot be properly restricted from the claims prosecuted in the parent application and are fully supported by that disclosure.

The Examiner will notify applicant by telephone of a defective or unacceptable application. Form POL–324 will be completed and signed by the Primary Examiner in each instance where a streamlined continuation is defective or not accepted and a copy mailed to applicant. The defect, if correctible, must be corrected within one month from the mailing date of the form.

When examining a streamlined continuation that includes claims (1) having matter not supported by the original disclosure or (2) directed to an invention other than that prosecuted in the parent case, these claims will be rejected by the Examiner on 35 U.S.C. 132 and 121, respectively. These rejections should indicate that the claims are not in accordance with the conditions set out in the Notice of February 11, 1966 (824 O.G. 1), instituting the streamlined continuation practice.

Although the filing of a defective streamlined continuation will not operate to abandon the parent case, neither will it prevent the parent case from becoming abandoned by operation of law. On the other hand, in situations where the parent case is awaiting action by the Office, no action will be taken while the streamlined continuation application is being reviewed for acceptability of its filing date.

Where the applicant has inadvertently omitted a reference to the parent case in a streamlined continuation, as required by 35 U.S.C. 120, the reference may be inserted by Examiner's Amendment if the case is otherwise ready for allowance (see § 201.11).

All foreign priority information under 35 U.S.C. 119 and continuing application data under 35 U.S.C. 120 must be entered on the file wrapper of the streamlined continuation.

201.08 Continuation-in-Part [R–22]

A continuation-in-part is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application *and adding matter not disclosed* in the said earlier case. (In re Klein, 1930 C.D. 2; 393 O.G. 519.)

A continuation-in-part filed by a sole applicant may also derive from an earlier joint application showing a portion only of the subject matter of the later application, subject to the conditions stated in the case of a sole divisional application stemming from a joint application (§ 201.06). Subject to the same conditions, a joint continuation-in-part application may derive from an earlier sole application.

claiming the benefit of the foreign application is accepted as the claim for priority. The claim for priority may appear in the oath or declaration with the recitation of the foreign application.

The certified copy which must be filed is a copy of the original foreign application with a certification by the patent office of the foreign country in which it was filed. Certified copies ordinarily consist of a copy of the specification and drawings of the application as filed with a certificate of the foreign patent office giving certain information. Application in this connection is not considered to include formal papers such as a petition. A copy of the foreign patent as issued does not comply since the application as filed is required; however, a copy of the printed specification and drawing of the foreign patent is sufficient if the certification indicates that it corresponds to the application as filed. A French patent stamped "Service De La Propriété Industrielle—Conforme Aux Piéces Déposées A L' Appui de La Demande" and additionally bearing a signed seal is also acceptable in lieu of a certified copy of the French application.

When the claim to priority and the certified copy of the foreign application are received while the application is pending before the Examiner, the Examiner should make no examination of the papers except to see that they correspond in date and country to the application identified in the oath and contain no obvious formal defects. The subject matter of the application is not examined to determine whether the applicant is actually entitled to the benefit of the foreign filing date on the basis of the disclosure thereof.

During Interference

If priority papers are filed in an interference, it is not necessary to file an additional certified copy in the application file. The Interference Examiner will place them in the application file.

Continuing Applications, Reissues

Where the benefit of a foreign filing date is claimed in a continuing application or in a reissue application and a certified copy has been received in the parent case, it is not necessary to file an additional certified copy in the later case. The applicant when making the claim for priority may simply call attention to the fact that the certified copy is in the parent application. In such cases the Examiner should acknowledge the claim with a statement as follows:

[1] "Applicant's claim for priority, based on papers filed in parent application Serial No. ------, submitted under 35 U.S.C. 119, is acknowledged."

This sentence appears on work sheet form PO–1002 as statement No. 4.

If the applicant fails to call attention to the fact that the certified copy is in the parent application and the Examiner is aware of the fact that the parent of a continuing application has fully complied with the requirements of 35 U.S.C. 119 and is therefore entitled to the benefit of the filing date of an earlier filed foreign application, he should direct it to the applicant's attention in an Office action, as in the following exemplary language:

[2] "Applicant is reminded that in order to be entitled to priority based on papers filed in parent application Serial No. ------ under 35 U.S.C. 119, a claim for such priority must be made in this application. In making such claim, applicant may simply call attention to the fact that a certified copy of the foreign application is in the parent application. (M.P.E.P. 201.14(b).)" [R–20]

201.14(c) Right of Priority, Practice [R–20]

Before going into the practice with respect to those instances in which the priority papers are used to overcome a reference, there will first be described the practice when there is no occasion to use the papers, which will be in the majority of cases. In what follows in this section it is assumed that no reference has been cited which requires the priority date to be overcome.

No Irregularities

When the papers under 35 U.S.C. 119 are received they are to be endorsed on the contents page of the file as "Letter (or amendment) and foreign application". Assuming that the papers are regular in form and that there are no irregularities in dates, the Examiner in the next Office action will advise the applicant that the papers have been received. The form of acknowledgment may be as follows:

[1] "Receipt is acknowledged of papers submitted under 35 U.S.C. 119, which papers have been placed of record in the file."

This sentence appears on work sheet form PO–1002 as statement 3.

The Examiner will enter the information specified in section 202.03 on the face of the file wrapper.

If application is in interference when papers under 35 U.S.C. 119 are received see section 1111.10.

Papers Inconsistent

If the certified copy filed does not correspond to the application identified in the application oath or declaration, or if the application oath or declaration does not refer to the particular foreign application, the applicant has not complied with the requirements of the rule relating to the oath or declaration. In such instances the Examiner's letter, after acknowledging receipt of the papers, should require the applicant to explain the inconsistency and to file a new oath or declaration stating correctly the facts concerning foreign applications required by Rule 65. A letter in such cases may read:

[2] "Receipt is acknowledged of papers filed _____, based on an application filed in _____ on _____. Applicant has not complied with the requirements of Rule 65(a), since the (*oath or declaration*) does not acknowledge the filing of any foreign application. A new (*oath or declaration*) is required."

This paragraph appears on work sheet form PO–1002 as statement 7.

Other situations requiring some action by the Examiner are exemplified by the following sample letters.

No Claim for Priority

[3] "Receipt is acknowledged of a certified copy, filed _____, of the _____ application referred to in the (oath or declaration). If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119, applicant should also file a claim for priority as required by said section."

Note: Where the accompanying letter states that the certified copy is filed for priority purposes or for the convention date, it is accepted as a claim for priority.

Foreign Applications All More Than a Year Before U.S. Filing

[4] "Receipt is acknowledged of the filing on _____, of a certified copy of the _____ application referred to in the (*oath or declaration*). A claim for priority can not be based on said application, since the United States application was filed more than twelve months thereafter."

This paragraph appears as statement 6 on work sheet form PO–1002.

Some Foreign Applications More Than a Year Before U.S. Filing

For example, British provisional specification filed more than a year before U.S. application, but British complete filed within the year, and certified copies of both submitted.

[5] "Receipt is acknowledged of papers filed on September 18, 1953, purporting to comply with the requirements of 35 U.S.C. 119. It is not seen how the claim for priority can be based on the British specification filed January 23, 1948, because the instant application was filed more than one year thereafter. However, the printed heading of the patent will note the claimed priority date based on the complete specification; i.e., November 1, 1948, for such subject matter as was not disclosed in the provisional specification."

Certified Copy Not the First Filed Foreign Application

[6] "Receipt is acknowledged of papers filed on _____ (date), purporting to comply with the requirements of 35 U.S.C. 119 and they have been placed of record in the file.

Attention is directed to the fact that the date for which priority is claimed is not the date of the first filed foreign application acknowledged in the oath or declaration. However, the priority date claimed which will appear in the printed heading of the patent will be _____ (date claimed)."

No Certified Copy

[7] "Acknowledgment is made of applicant's claim for priority based on an application filed in _____ on _____. It is noted, however, that applicant has not filed a certified copy of the _____ application as required by 35 U.S.C. 119."

The above paragraph appears as statement 5 on work sheet form PO–1002.

The above letters are merely typical ones which have been used, and any unusual situation may be referred to the Group Director.

Application in Issue

The priority papers may be received while the application is in issue. When the papers are apparently regular in form and correspond to the earliest foreign application recited in the oath or declaration and this application is not too old, the Issue Branch will enter the papers, acknowledge their receipt, and make the notation on the face of the file. If irregular priority papers are received while the applica-

U.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office
Washington, D.C. 20231

MANUAL OF PATENT EXAMINING PROCEDURE
Third Edition

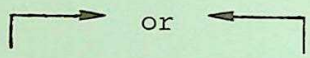
Instructions regarding Revision No. 43

The attached revised pages are replacements for those in the Manual having corresponding numbers, or additional pages to be placed in appropriate numerical sequence.

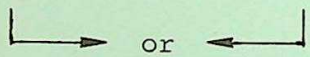
On an experimental basis, arrows are printed in the margin of pages to indicate material changed, deleted, or added by this revision. Where insertion of new material results in shifting of unchanged material onto following pages, no arrows appear on such pages but the revision number is cited at the bottom of each page.

The notation "[R-43]" in the attached pages appears either at the title or at the end of a section that has been revised.

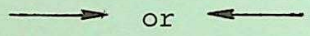
Louis O. Maassel
Editor, Manual of Patent
Examining Procedure



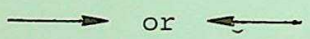
Line on which change begins.



Line on which change ends.



Line on which change both begins and ends.



Opposite a blank space, indicates deletion of material.

Particular attention is called to the following sections:

The terms "Patent Office" and "Commissioner of Patents" have been changed to -- Patent and Trademark Office -- and -- Commissioner of Patents and Trademarks -- respectively wherever they occur on the revised pages in accordance with Public Law 93-596.

Section	Change
201.14(c)	Section on "Application in Issue" changed to indicate that Patent Issue Division will acknowledge priority papers when case is at Issue.
308	Includes notice relating to issuance of patent to assignee named on Issue Fee payment form.
706.07(b)	First action final rejection practice amended.
707	Sample form PO-326 included.
713.01	Reference to normal time of 1/2 hour for interview added.
721 and 721.01	Completely new sections relating to "Fraud on the Patent and Trademark Office".
903.07	Reference to the "Supplement to the Manual of Classification" deleted.
903.09	Section on International Patent Classification substantially revised.
1001	Revised 35 U.S.C. 3 included.
1002.02(c)	"Petitions relating to refusal to enter an amendment under rule 312" added to group director's authority list.
Chapter 1100	Minor changes suggested by the Board of Interferences.
1203	Includes revised 35 U.S.C. 7 wording.
1306	Incorporates notice on calculation of Issue Fee, and revised wording of 35 U.S.C. 151.
Appendix I	Includes trademarks Airveyor, Cardioverter, Head, Orthomode, Touch-tone, Vise-grip, and Wire Nut.

UNITED STATES DEPARTMENT OF COMMERCE ★ PATENT OFFICE ★ WASHINGTON

MANUAL OF PATENT EXAMINING PROCEDURE, 3rd. Ed.
Change Notice

References: MPEP 803, 806.05(c), 806.05(d), 808, 808.02, 809, 809.03, 816, 817

SERIES NO. 44 - 1
(Follows Change 42 - 2)

April 9, 1975

RESTRICTIONS BETWEEN INVENTIONS

The practice set out in the notice of June 20, 1968 (852 O.G. 509) is hereby revised.

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent or distinct.

If it is demonstrated that two or more claimed inventions have no disclosed relationship ("independent"), restriction should be required, and it is not necessary to further show that the claimed inventions are distinct. If it is demonstrated that two or more claimed inventions have a disclosed relationship ("dependent"), then a showing of distinctness is required to substantiate a restriction requirement.

Where inventions are neither independent nor distinct, one from the other, or they are not sufficiently different to support more than one patent, their joinder in a single application must be permitted.

Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions as claimed are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween.

In order to support a requirement to restrict between combination and subcombination inventions, two-way distinctness must be demonstrated.

If it can be shown that a combination, as claimed

(1) does not require the particulars of the subcombination as claimed for patentability, and

(2) the subcombination can be shown to have utility either by itself or in other and different relations, the inventions are distinct. When these factors cannot be shown, such inventions are not distinct.

Two or more claimed subcombinations, disclosed as usable together in a single combination, and which can be shown to be separately usable, are usually distinct from each other.

In applications claiming inventions in different statutory classes only one-way distinctness is needed to support a restriction requirement. For example, in applications containing claims to both process and apparatus, distinctness may be shown if (1) the process as claimed can be practiced by hand or by another materially different apparatus, or (2) the apparatus as claimed can be used to practice another and materially different process.

As in the notice of May 1, 1974 concerning Markush-Type claims (922 O.G. 1016), if the search and examination of an entire application can be made without serious burden, the examiner is encouraged to examine it on the merits, even though it includes claims to distinct or independent inventions.

William Feldman
Deputy Assistant Commissioner
for Patents

MANUAL OF

PATENT EXAMINING PROCEDURE

Original Third Edition, dated November 1961

Latest Revision April 1975

U.S. DEPARTMENT OF COMMERCE • PATENT AND TRADEMARK OFFICE

Rev. 44, Apr. 1975

The Patent and Trademark Office does not handle the sale of the Manual, distribution of notices and revisions or change of address of those on the subscription list.

Correspondence relating to any of the above items should be sent to the Superintendent of Documents at the following address:

Superintendent of Documents
Mail List Section
P.O. Box 1533
Washington, D.C. 20013

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P.O. Box 1533
Washington, D.C. 20013

Orders for individual replacement pages not amounting to a complete revision of the Manual should be sent to the following address:

Commissioner of Patents and Trademarks
Attn: Customer Services Division
Washington, D.C. 20231

The cost per page will be 30¢ (see rules 13(a), 21(b), and 21(t) Rules of Practice).

Charges may be made to deposit accounts if the requestor is an account holder in good standing at the time the request is received. Checks or money orders should be made payable to the Commissioner of Patents and Trademarks. Requests must identify the specific pages required and the number of copies of each page.

Employees of the Patent and Trademark Office should direct their requests for the Manual, replacement pages, notices, and revisions to the Scientific Library.

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Revision 1, November 1950
Revision 2, December 1951
Revision 3, May 1952
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Revision 1, April 1955
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Foreword

This Manual is published to provide Patent Office examiners, applicants, attorneys, agents, and representatives of applicants with a reference work on the practices and procedures relative to the prosecution of applications before the Patent Office. It contains instructions to examiners, as well as other material in the nature of information and interpretation, and outlines the current procedures which the examiners are required or authorized to follow in appropriate cases in the normal examination of application.

Examiners will be governed by the applicable statutes, the Rules of Practice, decisions, and orders and instructions issued by the Commissioner and the Assistant Commissioners. Orders and Notices still in force which relate to the subject matter included in this Manual are incorporated in the text. Orders and Notices, or portions thereof, relating to the examiners' duties and functions which have been omitted or not incorporated in the text may be considered obsolete. Interference procedure not directly involving the Primary Examiner is not included in this Manual and, therefore, Orders and Notices relating thereto remain in force.

Subsequent changes in practice and other revisions will be incorporated in the form of substitute or additional pages for the Manual.

Suggestions for improving the form and content of the Manual are always welcome. The should be addressed to:

Commissioner of Patents,
Washington, D.C. 20231

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Introduction

Constitutional Basis

The Constitution of the United States provides:

"ART. 1, SEC. 8. The Congress shall have power . . . To promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."

Statutes

Pursuant to the provision of the Constitution, Congress has over the years passed a number of statutes under which the Patent Office is organized and our patent system is established. The provisions of the statutes can in no way be changed or waived by the Patent Office.

Prior to January 1, 1953, the law relating to patents consisted of various sections of the Revised Statutes of 1874, derived from the Patent Act of 1870 and numerous amendatory and additional acts.

By an Act of Congress approved July 19, 1952, which came into effect on January 1, 1953, the patent laws were revised and codified into their present form. With certain exceptions applying to applications filed and patents issued before January 1, 1953, this law governs all cases in the Patent Office. The patent law is Title 35 of the United States Code, which contains 96 sections numbered from 1 to 293, with gaps in the numbering between various chapters of the title. In referring to a particular section of the patent code the citation is given, for example, as, 35 U.S.C. 31. The pamphlet "Patent Laws" (available from the Superintendent of Documents for 75 cents) reprints the patent code and some additional statutes.

35 U.S.C. 1 Establishment. The Patent Office shall continue as an office in the Department of Commerce, where records, books, drawings, specifications, and other papers and things pertaining to patents and to trademark registrations shall be kept and preserved, except as otherwise provided by law.

Rules of Practice

One of the sections of the patent statute, namely, 35 U.S.C. 6, authorizes the Commissioner of Patents, subject to the approval of the Secretary of Commerce, to establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent Office.

Rule 351. Amendments to rules will be published. All amendments to these rules will be published in the Official Gazette and in the Federal Register.

Rule 352. Publication of notice of proposed amendments. (a) Whenever required by law, and in other cases whenever practicable, notice of proposed amendments to these rules will be published in the Official Gazette and in the Federal Register. If not published with the notice, copies of the text will be furnished to any person requesting the same. All comments, suggestions, and briefs received within a time specified in the notice will be considered before adoption of the proposed amendments which may be modified in the light thereof.

(b) Oral hearings may be held at the discretion of the Commissioner.

These rules and the various amendments were published in the Federal Register. In the Federal Register and in the Code of Federal Regulations these rules are Part 1 of Title 37, Patents, Trademarks and Copyrights, and the individual rules, there called sections, are numbered with the Part number and a decimal point prefixed to the numbers to the rule number; thus section 1.33 in the Federal Register and the Code of Federal Regulations is the same as rule 33. A booklet entitled "37 Code of Federal Regulations," published by the Office of the Federal Register, contains all of the patent rules and forms, as well as trademark rules and forms and copyright rules. Persons desiring a copy of the patent rules should order a copy of "37 Code of Federal Regulations" from the Superintendent of Documents.

The primary function of the Rules of Practice is to advise the public of the regulations which have been established in accordance with the statutes and which must be followed before the Office. The Rules of Practice govern the examiners, as well as applicants and their attorneys.

Commissioner's Orders and Notices

From time to time, the Commissioner of Patents has issued Orders and Notices relating to various specific situations that have arisen in operating the Patent Office. Notices and circulars of information or instructions have also been issued by other Office Officials under authority of the Commissioner. Orders and

Notices have served various purposes including directions to the examiners giving them instruction, information, interpretations and the like. Some may be for the information of the public, advising what the Office will do under specified circumstances.

Decisions

In addition to the statutory regulations, the actions taken by the examiner in the examination of applications for patents are to a great extent governed by decisions on prior cases. Applicants dissatisfied with an examiner's action may have it reviewed. In general, that portion of the examiner's action pertaining to objections on formal matters may be reviewed by petition to the Commissioner of Patents (see § 1002) and that portion of the examiner's action pertaining to the rejection of claims on the merits, may be reviewed by appeal to the Board of Appeals (see § 1201). The distinction is set forth in rules 181 and 191. In citing decisions as authority for his actions, the examiner should cite the decision in the manner set forth in § 707.06.

Publications Available from Superintendent of Documents

Orders should be addressed and remittances made payable to Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

Patent Official Gazette. The official journal of the Patent Office relating to patents. Issued each Tuesday, simultaneously with the weekly issuance of patents, it contains a selected figure of the drawings and an abstract of each patent granted, indexes of patents, list of patents available for license or sale, and general information such as orders, notices, changes in rules, and changes in classification. Annual subscription $211.00 ($52.75 additional for foreign mailing). Single copy $4.10.

Annual Indexes. An index of the patents issued each year is published in two volumes, one an alphabetical index of patentees and the other an index by subject matter of inventions. The two parts are sold separately. Price varies from year to year, depending upon size of the publication. An annual Index of Trademarks contains an alphabetical index of trademark registrants, registration numbers, dates published, classification of goods for which registered, and decisions published during the calendar year. Price varies from year to year, depending upon size of the publication.

Guide for Patent Draftsmen. Patent Office requirements for patent drawings with illustrations. Price 30 cents.

Manual of Classification. A loose-leaf volume listing the numbers and descriptive titles of the more than 300 classes and 66,000 subclasses used in the subject classification of patents, with an index to the classifications. Substitute and additional pages, which are included in the subscription service, are issued from time to time. Subscription $30.50 ($7.75 additional for foreign mailing).

Manual of Patent Examining Procedure. A loose-leaf manual which serves primarily as a detailed reference work on patent examining practice and procedure for the Patent Office's Examining Corps. Subscription service includes basic manual, quarterly revisions, and change notices. Subscription $19.50 ($5.00 additional for foreign mailing).

Patents and Inventions—An Information Aid to Inventors. The purpose of this publication is to aid inventors in deciding whether to apply for patents, in obtaining patent protection, and in promoting their inventions. Price 20 cents.

Patents: Spur to American Progress. Focuses on the functioning of the patent system, outlining its purpose and practices and charting the "how-to" path to patents. It illustrates how the sysem nurtures discovery of data and devices on which the American partnership of inventor, industry, and the public builds prosperity. This publication is one of the U.S. Department of Commerce's "Know Your Economic ABC's" series. Price 35 cents.

The Story of the United States Patent Office. Cites important events in the development of the United States patent system and lists chronologically inventions having important effects on the economy. Price 35 cents.

Patent Laws. Compilation of patent laws in force. Price 75 cents.

Patent Attorneys and Agents Registered to Practice Before The U.S. Patent Office. An alphabetically and a geographically arranged listing of patent attorneys and agents registered to practice before the U.S. Patent Office. Price $2.85.

Publications Available From the Patent Office

Orders should be addressed to U.S. Department of Commerce, Patent Office, Washington, D.C. 20231. Remittances should be made payable to Commissioner of Patents. Postage stamps, Superintendent of Documents coupons or other Government coupons are not acceptable in payment of Patent Office fees.

Q & A About Patents. Brief, non-technical answers to questions most frequently asked about patents. Free.

Q & A About Plant Patents. Same as above for plant patents. Free.

General Information Concerning Patents. Contains a vast amount of general information concerning the application for and granting of patents, expressed in non-technical language for the layman. Single copy free. Multiple copies available from Superintendent of Documents, 45 cents each.

Patents. Copies of the specification and drawings of all patents are available at 50 cents each, except design patents. Design patents are 20 cents each. When ordering, identify the patent by the patent number, or give full name of the inventor and approximate date of issuance of the patent.

Classification Definitions. Contain the changes in classification of patents as well as definitions of new and revised classes and sub-classes. Price is based upon size of publication, minimum price 10 cents.

Weekly Class Sheets. Lists showing classification of each patent in the weekly issue of the *Patent Official Gazette.* Annual subscription, $5.

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101 General [R–35]

35 U.S.C. 122. Confidential status of applications. Applications for patents shall be kept in confidence by the Patent Office and no information concerning the same given without authority of the applicant or owner unless necessary to carry out the provisions of any Act of Congress or in such special circumstances as may be determined by the Commissioner.

18 U.S.C. 2071. Concealment, removal, or mutilation generally. (a) Whoever willfully and unlawfully conceals, removes, mutilates, obliterates, or destroys, or attempts to do so, or, with intent to do so takes and carries away any record, proceeding, map, book, paper, document, or other thing, filed or deposited with any clerk or officer of any court of the United States, or in any public office, or with any judicial or public officer of the United States, shall be fined not more than $2,000 or imprisoned not more than three years, or both.

(b) Whoever, having the custody of any such record, proceeding, map, book, document, paper, or other thing, willfully and unlawfully conceals, removes, mutilates, obliterates, falsifies, or destroys the same, shall be fined not more than $2,000 or imprisoned not more than three years, or both; and shall forfeit his office and be disqualified from holding any office under the United States.

Extract from Rule 14. Patent applications preserved in secrecy. (a) Except as provided in rule 11(b) pending patent applications are preserved in secrecy. No information will be given by the Office respecting the filing by any particular person of an application for a patent, the pendency of any particular case before it, or the subject matter of any particular application, nor will access be given to or copies furnished of any pending application or papers relating thereto, without written authority in that particular application from the applicant or his assignee or attorney or agent of record, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules.

All Patent Office employees are legally obligated to preserve pending applications for patents in confidence. 35 U.S.C. 122 and 18 U.S.C. 2071 impose statutory requirements which cover the handling of patent applications and related documents. Suspension, removal, and even criminal penalties may be imposed for violations of these statutes.

In order to provide prompt and orderly service to the public, application files must be readily available to authorized Patent Office employees at all times. Accordingly, in carrying or transporting applications and related papers, care must be exercised by Patent Office employees, especially in corridors and elevators, to insure that applications and related papers are always under employee surveillance and control. Application files must not be displayed or handled so as to permit perusal or inspection by any unauthorized member of the public.

Interoffice mail must be sent in appropriate envelopes.

No part of any application or paper related thereto should be reproduced or copied except for official purposes.

No patent application or related document may be removed from the premises occupied by the Patent Office, except for handling as required by the issue process, unless specifically authorized by the Commissioner. If such authorization is given, the employee having custody will be responsible for maintaining confidentiality and otherwise conforming with the requirements of law.

Applications must not be placed in desk drawers or other locations where they might be easily overlooked or not visible to authorized personnel.

Whenever an application is removed from the operating area having custody of the file, a charge card with appropriate notations must be properly and promptly filed.

Papers arriving within the groups must be properly and promptly placed within the appropriate files. If papers are received with faulty identification, this should be corrected at once. If papers are received at a destination for which they are not intended due to faulty identification or routing, appropriate corrective action should be taken at once to insure the prompt

receipt thereof at the intended destination. See §§ 508.01 and 508.03.

All Patent Office employees should bear in mind at all times the critical importance of insuring the confidentiality and accessibility of patent application files and related documents, and in addition to the specific procedures referred to above, should take all appropriate action to that end.

Examiners, while holding interviews with attorneys and applicants, should be careful to prevent exposures of files and drawings of other applicants.

Extreme care should be taken to prevent inadvertent disclosure of the filing date or serial number of any application filed by another party. This applies not only to Office actions but also to notes (usually in pencil) in the file wrapper.

Several lithographic firms in the Washington, D.C. area file bonds each year with the Patent Office for the privilege of temporarily withdrawing certain drawings from the Patent Office in order that drawings may be prepared for foreign filing.

Patent Office employees are authorized to release drawings to representatives of these firms provided they: (1) Have an unexpired identification card, (2) Present an order signed by a party of record in the application, and (3) Leave a receipt which can be filed as a charge card.

Normally, drawings will be returned within three days. Any drawings which have not been returned within five days or which are returned in damaged condition should be reported immediately to the Office of Public Services (Ext. 73236).

102 Information as to Status of an Application [R–39]

Status information of an application means only the following information:

1. that the application is abandoned, or
2. that the application is pending, or
3. that the application has issued as a patent and the patent number, issue date and classification of such patent.

Patented

If an application on which status information is requested has matured into a patent, the fact that the application is patented and the patent number, issue date and classification relative to the application may be given to anyone.

Pending or Abandoned, No Reference

If an application is in pending or abandoned status and has not been referred to by number and date in a United States or foreign patent or printed application, status information indicating only that the application is pending or abandoned may be given only to Patent Office employees and parties of record such as:

(a) The applicant.

(b) The attorney or agent *of record* in the application.

(c) The assignee *of record* in the Patent Office.

(d) Anyone who has and furnishes written authority from a, b, or c.

Referenced Application

If an application has been referred to by number and date in a United States or foreign patent or printed application, status information may be given to Patent Office employees and to anyone who furnishes the Patent Office with a written request citing the application in question by serial number and date of filing. The source document (a United States or foreign patent or printed application) must be identified in the written request by the country, number and date of such patent or application.

Referenced Application, Source Document Not Presented

If a written request for status information is presented without a copy of the source document, Patent Office employees will check to see that the source document and the application in question are properly identified and that the source document refers to the application in question before supplying the status information. Requests for information not accompanied with a copy of the source document may require the Office to obtain a copy of the source document for verification before status information can be supplied. This may result in some delay before the desired status information can be forwarded to the requester.

Referenced Application, Source Document Presented

If a copy of the source document is presented, the Office will verify that the United States application in question is cited therein. After checking, status information may be immediately given and the source document copy may be returned to the requester. In either case, at the time the status information is supplied, the person supplying the status information marks the request "Information furnished", the date and his name. The request is then placed in the file wrapper or forwarded to the appropriate area (group art unit, abandoned files, etc.) for inclusion in the file wrapper as part of the official record of the application. The applicant is not consulted. See § 203.08.

103 Right of Public to Inspect Patent Files and Some Application Files [R–35]

Rule 11. Files open to the public. (a) After a patent has been issued, the specification, drawings, and all papers relating to the case in the file of the patent are open to inspection by the general public, and copies may be furnished upon paying the fee therefor. The file of any terminated interference involving a patent, or an application on which a patent has subsequently issued, is similarly open to public inspection and procurement of copies. See trademark rule 2.27 for trademark files.

(b) Applications in which the Office has accepted a request filed under rule 139 are open to inspection by the general public, and copies may be furnished upon paying the fee therefor.

Whenever a patent relies upon the filing date of an earlier but still pending application, the public is entitled to see the portion of the earlier application that relates to the common subject matter, and also what prosecution, if any, was had in the earlier application of subject matter claimed in the patent. The interested party may file a petition to the Commissioner for access to the application. (See § 1002.02(k).)

Inasmuch as the Post Office address is necessary for the complete identification of the petitioner, it should always be included complete with the ZIP Code number.

The petition may be filed either with proof of service of a copy upon the applicant, owner or attorney of record, if known, in the application to which access is sought, or may be filed in duplicate, in which case the duplicate copy is sent by the associate solicitor to the applicant, attorney or owner of the application, who is given a limited period, as a week or ten days, within which to state any objection he may have to the granting of the petition. If no objection is raised, the petition is approved by the associate solicitor. If there is no objection the petitioner is permitted to see the entire parent application. Otherwise, the petitioner is allowed to order a copy of only that portion of the parent application that relates to the common subject matter. A separate petition should be filed for each application to which access is desired, or sufficient extra copies provided so there may be one for placement in each application file, if the petition be granted, and one for service upon each attorney of record, if the applicant has different attorneys in his applications. Each petition should show not only why access is desired, but also why petitioner believes he is entitled to access.

The patent interference examiner handles all petitions for access to applications involved in an interference or having an interference background.

If a defensive publication, an abstract or an abbreviature has been published, the entire application is available to the public for inspection and obtaining copies, see § 711.06.

Extract from Rule 14. (b) Except as provided in rule 11(b) abandoned applications are likewise not open to public inspection, except that if an application referred to in a United States patent is abandoned and is available, it may be inspected or copies obtained by any person on written request, without notice to the applicant. Abandoned applications may be destroyed after twenty years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

(d) Selected decisions of the Board of Appeals, or of the Commissioner, in abandoned applications not otherwise open to public inspection (paragraph (b) of this rule) may be published or made available for publication at the Commissioner's discretion, unless the applicant timely presents sufficient reasons for not doing so. The applicant will be notified, through the attorney of record in the application file, when it is proposed to release such a decision and a time not less than thirty days set for presenting any such reasons. The fact that the subject matter of the application has not been made public in any manner, or that the same subject matter is being prosecuted in a pending application, will be considered sufficient reason for not releasing the decision if the applicant so requests unless the text of the decision contains no description of such subject matter. Other reasons presented will be duly considered.

See rule 2.27 for trademark applications.

Access to abandoned patent applications forming a part of a streamlined continuation application is governed by rule 14(b) and requires a written request. However, such access must be limited to those papers which were part of the abandoned application.

Rule 14(d) authorizes publication of decisions of the Board of Appeals or of the Commissioner, in abandoned applications, under certain conditions.

Rule 15. Requests for identifiable records. (a) Requests for records not disclosed to the public as part of the regular informational activity of the Patent Office and which are not otherwise dealt with in these rules may be made by completing Form CD–244, "Application to Inspect Department Records," and submitting this form, in person or by mail, to the Commissioner of Patents, Washington, D.C., 20231. A non-refundable application fee of $2.00 must accompany each application. Copies of Form CD–244 are available in the Central Reference and Records Inspection Facility, Room 2122, Department of Commerce Building, Washington, D.C., 20230, the search room of the Patent

Reference Branch of the Patent Office, the search room of the Trademark Examining Operation, and in many public information offices and field offices of the Department of Commerce. If the requested record is identifiable, the request will be reviewed by the appropriate official authorized to make an initial determination of the availability of the record. If it is determined that the material is not to be made available to the requesting person, said person shall be notified in writing of that fact and the reasons why the record will not be disclosed. If the record is to be made available, inspection will be permitted in the appropriate Patent Office search room. Fees for copies of records and for searches and related services are payable in accordance with the schedule of fees and charges established in § 4.8 of Title 15, Code of Federal Regulations.

(b) Any person whose application to inspect a record has been refused may request a reconsideration of the initial denial by completing and submitting the appropriate section of the Form CD-244. The request for reconsideration should be made within 30 days of the date of the original denial. In submitting such request the party should include any written argument he desires to support his belief that the record requested should be made available. No personal appearance, oral argument, or hearing shall be permitted. The decision upon such request shall be made by the Commissioner of Patents, and shall be based upon the original request, the denial, and any written argument submitted by the person seeking access to the record. The decision upon review shall be promptly made in writing and communicated to the person seeking access. If the decision is wholly or partly in favor of availability, the requested record to such extent shall be made available for inspection as described in paragraph (a) of this rule. To the extent that the decision is adverse to the request, the reasons for the denial shall be stated. A decision upon review completed as provided herein shall constitute the final decision and action of the Patent Office as to the availability of a requested record, except as may be required by court proceedings initiated pursuant to 5 U.S.C. 552(a)(3). Reconsiderations resulting in final decisions as prescribed herein shall be indexed and made available in the search room of the Patent Reference Branch.

(c) Procedures applicable in the event of a subpoena, order, or other compulsory process or demand of a court or other authority shall be those set forth in Section 7 of Department Order 64 (32 F.R. 9734, July 4, 1967).

104 Power to Inspect Application [R-42]

No person but the applicant (any one of joint applicants), applicant's legal representative, the assignee whose assignment is of record, or the attorney, agent or associate attorney of record will be permitted to have access to the file of any pending application, except as provided for under rule 11(b) or under the interference rules, unless written authority from one of the above indicated parties, identifying the application to be inspected and the name of the person authorized to have access, is made of record, or upon the written order of the Commissioner, which will also become a part of the record of the case.

Approval by the primary examiner of a power to inspect is *not* required. The clerk of the group to which the application is assigned ascertains that the power is properly signed by one of the above indicated parties, and if acceptable, enters it into the file. If the power to inspect is unacceptable, notification of non-entry is written by the clerk to the person who signed the power.

When a power to inspect is received while a file is under the jurisdiction of a service branch, such as the Customer Services Division, the Service Branch of the Board of Appeals, and the Patent Issue Division, the question of permission to inspect is decided by the head of the branch who, if he approves, indicates the approval directly on the power.

Power to inspect may be granted when a duplicate copy of a filed power to inspect is hand delivered. The copy with indication of approval is placed in the file.

A "power to inspect" is, in effect, the same as a "power to inspect and make copies."

Where an applicant relied upon his application as a means to interfere with a competitor's business or customers, permission to inspect the application may be given the competitor by the Commissioner. (Ex Parte Bonnie-B Co. Inc., 1923 C.D. 42; 313 O.G. 453.)

An unrestricted power to inspect given by an applicant is, under existing practice, recognized as good until and unless rescinded. The same is true in the case of one given by the attorney or assignee so long as such attorney or assignee retains his connection with the application.

Permission to inspect given by the Commissioner, however, is not of a continuing nature, since the conditions that justified the permit to inspect when given may not obtain at a later date.

Access to Patent Application and Interference Files

In order to insure that access to patent application and interference files is given only to persons who are entitled thereto or who are specially authorized to have access under rule 14 of the Rules of Practice in Patent Cases, and to

insure also that the file record identifies any such specially authorized person who has been given access to a file, the following practice will be observed by all personnel of the Patent Office:

1. Access, as provided for in the Rules of Practice, will be given on *oral request* to any applicant, patentee, assignee, or attorney or agent of record in an application or patent only upon *proof of identity* or upon *recognition* based on personal acquaintance.

2. Where a power of attorney or authorization of agent was given to a registered firm prior to July 2, 1971, access will be given upon oral request as in paragraph 1 above to any registered member or employee of the firm who has signatory power for the firm.

3. Unregistered employees of attorneys or agents, public stenographers, and all other persons not within the provisions of paragraphs 1 and 2 above will be given access only upon presentation of a *written authorization for access* signed by a person specified in paragraph 1 above, which authorization will be entered as a part of the official file.

105 Disbarred Attorney Cannot Inspect

Patent Office employees are forbidden to hold either oral or written communication with an attorney who has been suspended or excluded from practice regarding an application unless it be one in which said attorney is the applicant. Power to inspect given to such an attorney will not be accepted.

106 Control of Inspection by Assignee [R–29]

The assignee of the entire interest in an application may intervene in the prosecution of the case, appointing an attorney of his own choice. (See rule 32.) Such intervention, however, does not exclude the applicant from access to the application to see that it is being prosecuted properly, unless the assignee makes specific request to that effect. Even when such request is made, the applicant may be permitted to inspect the case on sufficient showing why such inspection is necessary to conserve his rights. In re The Kellogg Switchboard & Supply Company, 1906 C.D. 274.

106.01 Rights of Assignee of Part Interest

While it is only the assignee of the entire interest who can intervene in the prosecution of an application or interference to the exclusion of the applicant, an assignee of a part interest or a licensee of exclusive right is entitled to inspect the application.

107 "Secrecy Order" Cases [R–28]

Title 35, United States Code, section 181 provides, in part, that any invention in which the Government does not have a property interest, and whose publication or disclosure by the granting of a patent might, in the opinion of the Commissioner, be detrimental to the national security, shall be made available to the

defense agencies. Upon notification by the defense agencies, the Commissioner is directed to order that such inventions be kept secret and to withhold the grant of a patent for such period as the national interest requires. Where the Government has a property interest, the interested Government agency determines whether to notify the Commissioner to keep the invention secret.

35 U.S.C. 184, *Filing of application in foreign country.* Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

Since May 3, 1965, all licenses granted by the Commissioner of Patents to file patent applications in foreign countries have been made of record in the application to which they correspond. The granted request for a license and the license are given paper numbers and endorsed on the file wrapper and on the Serial Register Card. Requests for licenses which are not approved are neither recorded nor placed in the application file wrapper.

107.01 "Review" of Applications for Secrecy Order [R–42]

Under 35 U.S.C. 181 the obligation is directly on the Patent Office to appreciate the possible interest of the defense agencies in pending applications and to take steps to make them available to such agencies.

All new applications received in the Patent Office are now being screened by Group 220 personnel to determine which applications should be made available for review or treated under the Atomic Energy and Space Acts for property interests.

All applications that have been screened by Group 220 will be stamped "LICENSING & REVIEW" inside the file wrapper. This stamp simply indicates that the application has been initially screened and is not to be considered as a conclusive indication of the security status of the application or as an indication that a license for foreign filing will be granted.

All papers subsequently filed must be inspected by the examiner to determine whether matter of an obvious defense interest which requires a security review has been introduced into the application. In such applications forwarded to the Licensing and Review Section of Group 220, it is helpful if a check mark is placed in the margin opposite to the part which is significant in suggesting security review.

Applications in Group 220 for the review thereof by the appropriate defense agency may be borrowed by the examiner when reached for action. Allowable applications requiring consideration for processing under Section 152 of the Atomic Energy Act (42 U.S.C. 2182) and/or Section 305c of the Space Act (42 U.S.C. 2457c) are processed to issue, including counting of the issue, and forwarded through Group 220 to the Patent Issue Division. When the security status of the application cannot be promptly decided, Group 220 will report the progress that has been made to the group director. Any action to be taken in the case, for the purpose of advancing said group date, must be arranged through the group director.

107.02 Prosecution of "Secrecy Order" Cases [R–28]

"Secrecy Order" Cases are examined as in other cases, but may not be passed for issue; nor will an interference be declared where one or more of the conflicting cases is secret. See § 1111.04.

In case of a final rejection, while such action must be properly responded to, and an appeal, if filed, must be completed by the applicant to prevent abandonment, such appeal will not be set for hearing by the Board of Appeals until the secrecy order is removed, unless specifically ordered by the Commissioner.

When a "Secrecy Order" Case is in condition for allowance, a notice of allowability [Form D–10] is issued, thus closing the prosecution. Any amendments received thereafter are not entered or responded to until such time as the secrecy order is rescinded. At such time amendments which are free from objection will be entered; otherwise they are denied entry.

108 Applications Relating to Atomic Energy [R–28]

Rule 14(c) reads as follows:

"Applications for patents which disclose or which appear to disclose, or which purport to disclose, in-

ventions or discoveries relating to atomic energy are reported to the Atomic Energy Commission and the Commission will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by secs. 151(c) and 151(d) of the Atomic Energy Act of 1954, 68 Stat. 919; 42 U.S.C. 2181."

The Atomic Energy Act of 1954 requires that the Commissioner of Patents shall notify the Atomic Energy Commission of all applications for patent which, in his opinion, disclose inventions or discoveries required to be reported under subsection 151(c) (42 U.S.C. 2181c) which reads in part as follows:

". . . any invention or discovery useful in the production or utilization of special nuclear material or atomic energy. . . ."

The term "atomic energy" is defined as all forms of energy released in the course of nuclear fission or nuclear transformation (42 U.S.C. 2014c).

All applications received in the Patent Office are sent to Licensing and Review for screening by Group 220 personnel, under rule 14(c), in order for the Commissioner to fulfill his responsibilities under section 151(d) (42 U.S.C. 2181d) of the Atomic Energy Act. Papers subsequently added must be inspected promptly by the examiner when received to determine whether the application has been amended to relate to atomic energy and those so related must be promptly forwarded to Licensing and Review.

When applications are forwarded to Group 220 for consideration of the above requirements, it is helpful if a check mark is made in the margin opposite to the part of the paper which is significant in suggesting that the application be reported.

In considering applications under the terms of rule 14(c), the relation of the subject matter to national security under § 107.01 is not a significant factor. EVEN applications using a well-known radioactive source for any purpose or which disclose inventions having special relation to atomic energy MUST BE SUBMITTED TO Group 220. See § 706.03(b).

109 Security Markings [R–42]

Under Executive Order 11,652, 37 Federal Register, Number 48, pages 5212 et seq., standards are prescribed for the marking, handling, and care of official information which requires safeguarding in the interest of security.

Papers marked as prescribed in the Executive Order, and showing that such marking is applied by, or at the direction of, a Government Agency, are accepted in patent applications. All applications or papers in the Patent Office bearing words such as "Secret," or "Confidential," must be promptly referred to Group 220 for clarification or security treatment. Under no circumstances can any such application, drawing, exhibit, or other paper be placed in public records, such as the Patented Files, until all security markings have been considered and declassified or otherwise explained.

Authorized security markings may be placed on the patent application drawings when filed provided that such markings are outside the illustrations and that they are removed when the material is declassified, rule 84(l).

Chapter 200 Types, Cross-Noting, and Status of Application

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201 Types of Applications

Patent applications fall under three broad types: (1) applications for patent under 35 U.S.C. 101 relating to a "new and useful process, machine, manufacture, or composition of matter, etc."; (2) applications for plant patents under 35 U.S.C. 161; and (3) applications for design patents under 35 U.S.C. 171. The first type of patents are sometimes referred to as "utility" patents or "mechanical" patents when being contrasted with plant or design patents. The specialized procedure which pertains to the examination of applications for design and plant patents will be treated in detail in Chapters 1500 and 1600, respectively.

201.01 Sole

An application wherein the invention is presented as that of a single person is termed a sole application.

201.02 Joint

A joint application is one in which the invention is presented as that of two or more persons.

201.03 Convertibility of Application [R–38]

Rule 45. (b) If an application for patent has been made through error and without any deceptive intention by two or more persons as joint inventors when they were not in fact joint inventors, the application may be amended to remove the names of those not inventors upon filing a statement of the facts verified by all of the original applicants, and an oath or declaration as required by rule 65 by the applicant who is the actual inventor, provided the amendment is diligently made. Such amendment must have the written consent of any assignee.

The required "statement of the facts verified by all of the original applicants" must include at the least, a recital of the circumstances, including the relevant dates, of (1) the misjoinder and (2) the discovery of the misjoinder. Without such a showing of circumstances, no basis exists for a conclusion that the application had been made in the names of the original sole or joint applicant(s) "through error and without any deceptive intention", and no foundation is supplied for a ruling that the amendment to remove the names of those not inventors or include those

to be added as inventors was "diligently made."

On the matter of diligence, attention is directed to the decision of the C.C.P.A. in Van Otteren v. Hafner et al., 757 O.G. 1026; 126 USPQ 151.

It is possible to file a sole application to take the place of the joint application, subject to the requirements of rule 45.

For the procedure to be followed when the joint application is involved in an interference, see § 1111.07.

Conversion from a sole to a joint application is permitted by 35 U.S.C. 116.

Rule 45. (c). If an application for patent has been made through error and without any deceptive intention by less than all the actual joint inventors, the application may be amended to include all the joint inventors upon filing a statement of the facts verified by, and an oath or declaration as required by rule 65 executed by, all the actual joint inventors, provided the amendment is diligently made. Such amendment must have the written consent of any assignee.

Any attempt to effect a second conversion, of either type or to effect both types of conversion, in a given application, must be referred to the group director. The provisions of rule 312 apply to attempted conversions after allowance and before issue. When any conversion is effected, the file should be sent to the Application Division for a revision of its records.

An application which was filed by A and amended to add B to form joint applicants AB, cannot be again amended to make B the sole applicant.

Where a person is added or removed as an inventor during the prosecution of an application before the Patent Office, problems may occur upon applicant claiming U.S. priority in a foreign filed case. Therefore, examiners should acknowledge any addition or removal of inventors made in accordance with the practice under rule 45 and include the following statement in the next communication to applicant or his attorney.

"In view of the papers filed _____, it has been found that this application, as filed, through error and without any deceptive intention (failed to include _____ as an actual joint inventor; or included _____ as a joint inventor who was not in fact a joint inventor) and accordingly, this application has been corrected in compliance with rule 45."

201.04 Original or Parent

The terms *original* and *parent* are interchangeably applied to the first of a series of applications of an inventor, all disclosing a given invention. Such invention may or may not be claimed in the first application.

201.05 Reissue

A reissue application is an application for a patent to take the place of an unexpired patent that is defective in some one or more particulars. A detailed treatment of reissues will be found in chapter 1400.

201.06 Division [R–39]

A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in the earlier or parent application, is known as a divisional application or "division". Except as provided in rule 45, both must be by the same applicant. (See below.) The divisional application should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application.

In the interest of expediting the processing of newly filed divisional applications, filed as a result of a restriction requirement, applicants are requested to include the appropriate Patent Office classification of the divisional application and the status and location of the parent application, on the papers submitted. The appropriate classification for the divisional application may be found in the office communication of the parent case wherein the requirement was made. It is suggested that this classification designation be placed in the upper right hand corner of the letter of transmittal accompanying these divisional applications.

A design application is not to be considered to be a division of a utility application, and is not entitled to the filing date thereof, even though the drawings of the earlier filed utility application show the same article as that in the design application. In re Campbell, 1954 C.D. 191; 101 USPQ 406; Certiorari denied 348 U.S. 858.

While a divisional application may depart from the phraseology used in the parent case there may be no departure therefrom in substance or variation in the drawing that would amount to "new matter" if introduced by amendment into the parent case. Compare §§ 201.08 and 201.11.

RULE 45

Since rule 45(b) permits the conversion of a joint application to a sole, it follows that a new application, restricted to divisible subject matter, filed during the pendency of the joint ap-

plication by one of the joint applicants, in place of restricting and converting the joint case, may properly be identified as a division of the joint application. In like manner under rule 45(c), a new joint application for divisible subject matter present in a sole application may be identified as a division if filed by the sole applicant and another during the pendency of the sole. See § 201.11

However, the following conditions must be satisfied in each of the foregoing situations,

(a) It must appear that the parent application was filed "through error and without any deceptive intention".

(b) On discovery of the mistake the new application must be diligently filed and the burden of establishing good faith rests with the new applicant or applicants.

(c) There must be filed in the new application the verified statement of facts required by rule 45.

For notation to be put on the file wrapper by the examiner in the case of a divisional application see § 202.02.

The rule 147 divisional practice has been superseded by the rule 60 practice which became effective on September 1, 1971. See § 201.06(a).

201.06(a) Division-Continuation Program [R–39]

Rule 60. Continuing application for invention disclosed and claimed in a prior application. A continuation or divisional applicatin (filed under the conditions specified in 35 U.S.C. 120 or 121), which discloses and claims only subject matter disclosed in a prior application may be filed as a separate application before the patenting or abandonment of or termination of proceedings on the prior application. If the application papers comprise a copy of the prior application as filed, signing and execution by the applicant may be omitted provided the copy either is prepared and certified by the Patent Office or is prepared by the applicant and verified by an affidavit or declaration by the applicant, his attorney or agent, stating that it is a true copy of the prior application as filed. Certification may be omitted if the copy is prepared by and does not leave the custody of the Patent Office. Only amendments reducing the number of claims or adding a reference to the prior application (rule 78(a)) will be entered before calculating the filing fee and granting of the filing date.

The former rule 147 division practice and streamline continuation practice have been superseded by the change in the Rules of Practice establishing rule 60, which became effective on September 1, 1971.

Rule 60 Practice

The rule 60 practice was developed to provide a procedure for filing a continuation or divisional application where hardships existed in obtaining the signature of the inventor on such an application during the pendency of the prior application. It is suggested that the use of the rule 60 practice be limited to such instances in view of the additional work required by the Office to make copies and enter preliminary amendments.

Rule 60 practice permits persons having authority to prosecute a prior copending application to file a continuation or divisional application without requiring the inventor to again execute an oath or declaration under 35 U.S.C. 115, if the continuation or divisional application is an exact copy of the prior application as executed and filed. Where the immediate prior application was not signed (for example, where it was filed under the former rule 147 or current rule 60 practice), a copy of the most recent application having a signed oath or declaration in the chain of copending prior applications under 35 U.S.C. 120 must be used.

The basic concept of rule 60 practice is that since the inventor has already made the affirmation required by 35 U.S.C. 115, it is not necessary to make another affirmation in a later application that discloses and claims only the same subject matter. It is for this reason that a rule 60 application must be an exact duplicate of an earlier application executed by the inventor. It is permissible to retype pages to provide clean copies.

Rule 60 Application Content

As mentioned previously, a rule 60 application must consist of a copy of an executed application as filed (specification, claims, drawings and oath or declaration). The use of transmittal form 54 is urged since it acts as a checklist for both applicant and the Office.

Although a copy of all original claims in the prior application must appear in the rule 60 application, some of the claims may be canceled by request in the rule 60 application in order to reduce the filing fee (see form 54, item 6). Any preliminary amendment presenting additional claims (claims not in the prior application as filed) should accompany the request for filing an application under rule 60, but such an amendment will not be entered until after the filing date has been granted. Any claims added by amendment should be numbered consecutively beginning with the number next following the highest numbered original claim in the prior executed application. Amendments made

in the prior application do not carry over into the rule 60 application. Any preliminary amendment should accompany the rule 60 application and be directed to "the accompanying rule 60 application" and not to the prior application.

All application copies must comply with rule 52 and must be on paper which permits entry of amendments thereon in ink.

Copies of the application should be prepared and submitted by the applicant, his attorney or agent, and be verified to be true copies by him. The copy of the oath or declaration need not show a copy of the inventor's or notary's signature provided that all other data is shown and an indication is made that the oath or declaration has been signed.

The Patent Office will prepare copies of the prior application without charge if the applicant is unable to supply them.

Claims for priority rights under 35 U.S.C. 119 must be made in rule 60 applications if they are desired. Reference should be made to certified copies filed in a prior application if reliance thereon is made.

If the claims presented by amendment in a rule 60 application are directed to matter shown and described in the prior application but not substantially embraced in the statement of invention or claims originally presented, the applicant should file a supplemental oath or declaration under rule 67 as promptly as possible.

In view of the fact that rule 60 applications are limited to continuations and divisions, no new matter may be introduced in a rule 60 application, 35 U.S.C. 132.

A statement to the effect that the verifier believes the submitted copy to be a true copy of the prior application as filed to the best of his information and belief is a sufficient verification, if an explanation is made as to why the statement must be based only on belief.

If the inventorship shown on the original oath or declaration has been changed and approved during the prosecution of the prior application, the rule 60 application papers must indicate such a change has been made and approved in order that the changed inventorship may be indicated in the rule 60 application. The rule 60 application papers should also include any additions or changes in an inventor's citizenship, residence or post office address made and approved in the prior application.

Formal Drawings Required

Formal bristolboard drawings are required in rule 60 applications as in other applications. Transfer of drawings from abandoned applications is permitted. If informal drawings are filed with the application papers, a ten dollar comparison fee will be charged at the time when new formal drawings are filed.

Any drawing corrections requested but not made in the prior application should be repeated in the rule 60 application if such changes are still desired. If the drawings were changed during the prosecution of the prior application, such drawings may be transferred, however, a copy of the drawings as originally filed must be included in the rule 60 application papers to indicate the original content.

Affidavits and declarations, such as those under rules 131 and 132 filed during the prosecution of the prior application do not automatically become a part of the rule 60 application. Where it is desired to rely on an earlier filed affidavit, the applicant should make his remarks of record in the rule 60 application and include a copy of the original affidavit filed in the prior application.

Abandonment of the Prior Application

Under rule 60 practice the prior application is not automatically abandoned upon filing of the rule 60 application. If the prior application is to be expressly abandoned, such a paper must be signed by the applicant himself, the assignee of record or the attorney or agent of record, rule 138. A registered attorney or agent not of record acting in a representative capacity under rule 34(a) may not expressly abandon an application.

If the prior application which is to be expressly abandoned has a notice of allowance issued therein, the prior application can become abandoned by the nonpayment of the base issue fee. However, once a base issue fee has been paid in the prior application, even if the payment occurs following the filing of a continuation application under rule 60, a petition to withdraw the prior application from issue must be filed before the prior application can be abandoned (rule 313). The checking of box 8 on form 54 is not sufficient to expressly abandon an application having a notice of allowance issued therein and the base issue fee submitted (see § 608.02(i)).

If the prior application which is to be expressly abandoned is before the Board of Appeals or the Board of Interferences, a separate notice should be forwarded by the applicant to such Board, giving notice thereof.

After a decision by the CCPA in which the rejection of all claims is affirmed, proceedings are terminated on the date of receipt of the

Court's certified copy of the decision by the Patent Office, Continental Can Company, Inc., et al. v. Schuyler, 168 USPQ 625 (D.C.D.C. 1970). See § 1216.01.

EXAMINATION

The practice relating to making first action rejections final applies also to rule 60 applications, see § 706.07(b).

Where the rule 60 application has reached the examining group without a copy of the oath or declaration from the prior application, a copy should be ordered from a copy center at the time the prior application is reviewed during examination of the rule 60 application.

Any preliminary amendment filed with a rule 60 application which is to be entered after granting of the filing date should be entered by the clerical personnel of the examining group where the application is finally assigned to be examined. Accordingly, these applications should be classified and assigned to the proper examining group by taking into consideration the claims that will be before the examiner upon entry of such a preliminary amendment.

If the examiner finds that a filing date has been granted erroneously because the application was incomplete, the application should be returned to the Application Division via the Office of the Assistant Commissioner for Patents.

Form 54 is designed as an aid for use by both applicant and the Patent Office and should simplify filing and processing of applications under rule 60.

Form 54 (modified) Division-continuation program application transmittal form.

IN THE UNITED STATES PATENT OFFICE

Docket No. _____

Anticipated Classification of this application:
Class ____ Subclass ____
Prior application:
Examiner _____
Art Unit _____

THE COMMISSIONER OF PATENTS
Washington, D.C. 20231.

SIR: This is a request for filing a ☐ continuation ☐ divisional application under 37 CFR 1.60, of pending prior application serial no. _____ filed on _____
(date)
of _____
(inventor currently of record in prior application)
for _____.
(title of invention)

1. ☐ Enclosed is a copy of the prior application, including the oath or declaration as originally filed and an affidavit or declaration verifying it as a true copy. (See 8 and 8*a* for drawing requirements.)
2. ☐ Prepare a copy of the prior application.
3. ☐ The filing fee is calculated below:

CLAIMS AS FILED IN THE PRIOR APPLICATION, LESS ANY CLAIMS CANCELLED BY AMENDMENT BELOW

For	Number filed	Number extra	Rate	Basic fee $65
Total claims	−10=	×	$2=	
Independent claims	− 1=	×	10=	
Total filing fee				

4. ☐ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Account No. _____. A duplicate copy of this sheet is enclosed.
5. ☐ A check in the amount of $ _____ is enclosed.
6. ☐ Cancel in this application original claims _____ of the prior application before calculating the filing fee. (At least one original independent claims must be retained for filing purposes.)
7. ☐ Amend the specification by inserting before the first line the sentence: —This is a ☐ continuation, ☐ division, of application serial no. _____, filed _____.
8. ☐ Transfer the drawings from the prior application to this application and abandon said prior application as of the filing date accorded this application. A duplicate copy copy of this sheet is enclosed for filing in the prior application file. (May only be used if signed by person authorized by rule 138 and before payment of base issue fee.)

8*a*. ☐ New formal drawings are enclosed.

8*b*. ☐ Priority of application serial no. _____ filed on _____ in _____
(country)
is claimed under 35 U.S.C. 119.
☐ The certified copy has been filed in prior application serial no. _____, filed _____.

9. ☐ The prior application is assigned of record to _____.
10. ☐ The power of attorney in the prior application is to _____.
(name, registration number, and address)
a. ☐ The power appears in the original papers in the prior application.
b. ☐ Since the power does not appear in the original papers, a copy of the power in the prior application is enclosed.
c. ☐ Address all future communications to _____. (May only be completed by applicant, or attorney or agent of record.)
11. ☐ A preliminary amendment is enclosed. (Claims added by this amendment have been prop-

erly numbered consecutively beginning with the number next following the highest numbered original claim in the prior application.)

12. ☐ I hereby verify that the attached papers are a true copy of prior application serial no. _____ as originally filed on _____ (date)

The undersigned declare further that all statements made herein of his own knowledge are true and that *all statements made on information and belief are believed to be true;* and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

_____ _____
(date) (signature)

Address of signator:
_____
_____

☐ Inventor(s)
☐ Assignee of complete interest
☐ Attorney or agent of record
☐ Filed under rule 34(a)

201.07 Continuation [R–39]

A continuation is a second application for the same invention claimed in a prior application and filed before the original becomes abandoned. Except as provided in rule 45, the applicant in the continuing application must be the same as in the prior application. The disclosure presented in the continuation must be the same as that of the original application, i.e., the continuation should not include anything which would constitute new matter if inserted in the original application.

At any time before the patenting or abandonment of or termination of proceedings on his earlier application, an applicant may have recourse to filing a continuation in order to introduce into the case a new set of claims and to establish a right to further examination by the primary examiner.

For notation to be put on the file wrapper by the examiner in the case of a continuation application see § 202.02.

The Streamlined Continuation Program has been superseded by the rule 60 practice which became effective on September 1, 1971 (36 F.R. 12689). See § 201.06(a).

201.08 Continuation-in-Part [R–33]

A continuation-in-part is an application filed during the lifetime of an earlier application by the same applicant, repeating some substantial portion or all of the earlier application *and adding matter not disclosed* in the said earlier case. (In re Klein, 1930 C.D. 2; 393 O.G. 519.)

A continuation-in-part filed by a sole applicant may also derive from an earlier joint application showing a portion only of the subject matter of the later application, subject to the conditions stated in the case of a sole divisional application stemming from a joint application (§ 201.06). Subject to the same conditions, a joint continuation-in-part application may derive from an earlier sole application.

For notation to be put on the file wrapper by the examiner in the case of a continuation-in-part application see § 202.02. See § 708 for order of examination.

201.09 Substitute [R–25]

The use of the term "Substitute" to designate an application which is in essence the duplicate of an application by the same applicant abandoned before the filing of the later case, finds official recognition in the decision, Ex parte Komenak, 1940 C.D. 1; 512 O.G. 739. Current practice does not require applicant to insert in the specification reference to the earlier case. The notation on the file wrapper (See § 202.02) that one case is a "Substitute" for another is printed in the heading of the patent copies. See § 201.11.

As is explained in § 201.11 a "Substitute" does not obtain the benefit of the filing date of the prior application.

201.10 Refile [R–33]

No official definition has been given the term Refile, though it is sometimes used as an alternative for the term Substitute.

If the applicant designates his application as "refile" and the examiner finds that the application is in fact a duplicate of a former application by the same party which was abandoned prior to the filing of the second case, the examiner should require the substitution of the word *substitute* for "refile," since the former term has official recognition. The endorsement on the file wrapper that the case is a "substitute" will result in the further endorsement by the Assignment Division of any assignment of the parent case that may have been made.

201.11 Continuity Between Applications: When Entitled to Filing Date [R–39]

Under certain circumstances an application for patent is entitled to the benefit of the filing date of a prior application of the same inventor. The conditions are specified in 35 U.S.C. 120.

35 U.S.C. 120. Benefit of earlier filing date in the United States. An application for patent for an invention disclosed in the manner provided by the first paragraph of section 112 of this title in an application previously filed in the United States by the same inventor shall have the same effect, as to such invention, as though filed on the date of the prior application, if filed before the patenting or abandonment of or termination of proceedings on the first application or on an application similarly entitled to the benefit of the filing date of the first application and if it contains or is amended to contain a specific reference to the earlier filed application.

There are three conditions in addition to the basic requirement that the two applications be by the same inventor:

1. The second application (which is called a continuing application) must be an application for a patent for an invention which is also disclosed in the first application (the parent or original application); the disclosure of invention in the first application and in the second application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See In re Ahlbrecht, 168 USPQ 293 (CCPA 1971).

2. The continuing application must be copending with the first application or with an application similarly entitled to the benefit of the filing date of the first application.

3. The continuing application must contain a specific reference to the prior application(s) in the specification.

The term "same inventor" has been construed in *In re Schmidt*, 1961 C.D. 542; 130 USPQ 404, to include a continuing application of a sole inventor derived from an application of joint inventors where a showing was made that the joinder involved error without any deceptive intent (35 U.S.C. 116). See § 201.06.

Copendency

Copendency is defined in the clause which requires that the second application must be filed before (a) the patenting, or (b) the abandonment of, or (c) the termination of proceedings in the first application.

If the first application issues as a patent, it is sufficient for the second application to be copending with it if the second application is filed on the same date, or before the date the patent issues on the first application. Thus, the second application may be filed while the first is still pending before the examiner, while it is in issue, or even between the time the issue fee is paid and the patent issues.

If the first application is abandoned, the second application must be filed before the abandonment in order for it to be copending with the first. The term "abandoned," refers to abandonment for failure to prosecute (§ 711.02), express abandonment (§ 711.01), and abandonment for failure to pay the issue fee (§ 712). If an abandoned application is revived (§ 711.03(c)) or a petition for late payment of the issue fee (§ 712) is granted by the Commissioner, it becomes reinstated as a pending application and the preceding period of abandonment has no effect.

The expression "termination of proceedings" is new in the statute, although not new in practice. Proceedings in an application are obviously terminated when it is abandoned or when a patent has been issued, and hence this expression is the broadest of the three.

After a decision by the Court of Customs and Patent Appeals in which the rejection of all claims is affirmed, proceedings are terminated on the date of receipt of the Court's certified copy of the decision by the Patent Office. Continental Can Company, Inc. et al. v. Schuyler, 168 USPQ 625 (D.C.D.C. 1970). There are several other situations in which proceedings are terminated as is explained in § 711.02(c).

When proceedings in an application are terminated, the application is treated in the same manner as an abandoned application, and the term "abandoned application" may be used broadly to include such applications.

The term "continuity" is used to express the relationship of copendency of the same subject matter in two different applications of the same inventor, and the second application may be referred to as a continuing application. Continuing applications include those applications which are called divisions, continuations, and continuations-in-part. As far as the right under the statute is concerned the name used is immaterial, the names being merely expressions developed for convenience. The statute is so worded that the first application may contain more than the second, or the second application may contain more than the first, and in either case the second application is entitled to the benefit of the filing date of the first as to the common subject matter.

Reference to First Application

The third requirement of the statute is that the second (or subsequent) application must contain a specific reference to the first application. This should appear as the first sentence of the specification following the title and abstract, preferably as a separate paragraph. Status of the parent applications (whether it is patented or abandoned) should also be included. If a parent application has become a patent, the expression ", Patent No. ———" should follow the filing date of the parent ap-

plication. If a parent application has become abandoned, the expression ", abandaned" should follow the filing date of the parent application. In the case of design applications, it should appear as set forth in § 1503.01. In view of this requirement, the right to rely on a prior application may be waived or refused by an applicant by refraining from inserting a reference to the prior application in the specification of the later one. If the examiner is aware of the fact that an application is a continuing application of a prior one, he should merely call attention to this in an Office action, for example, in the following language:

"It is noted that this application appears to claim subject matter disclosed in applicant's prior copending application Serial No. ------, filed ----------. A reference to this prior application must be inserted in the specification of the present application if applicant intends to rely on the filing date of the prior application, Rule 78."

In rule 60 cases, applicant, in his amendment canceling the nonelected claims, should include directions to enter "This is a division (continuation) of application Serial No. ------, filed ----------" as the first sentence following the abstract. Where the applicant has inadvertently failed to do this and the rule 60 case is otherwise ready for allowance, the examiner should insert the quoted sentence by examiner's amendment.

If the examiner is aware of a prior application he should note it in an Office action, as indicated above, but should not require the applicant to call attention to the prior application.

Applications are sometimes filed with a division, continuation, or continuation-in-part oath or declaration, in which the oath or declaration refers back to a prior application. If there is no reference in the specification, in such cases, the examiner should merely call attention to this fact in his Office action, utilizing, for example, the language suggested in the first paragraph of this subsection.

Where the applicant has inadvertently failed to make a reference to the parent case in a streamlined continuation which is otherwise ready for issue the examiner should insert the required reference by examiner's amendment.

Sometimes a pending application is one of a series of applications wherein the pending application is not copending with the first filed application but is copending with an intermediate application entitled to the benefit of the filing date of the first application. If applicant desires that the pending application have the benefit of the filing date of the first filed application he must, besides making reference in the specification to the intermediate application, also make reference in the specification to the first application. See Hovlid v. Asari et al., 134 USPQ 162; 305 F. 2d 747 and Sticker Industrial Supply Corp. v. Blaw-Knox Co. et al., 160 USPQ 177.

There is no limit to the number of prior applications through which a chain of copendency may be traced to obtain the benefit of the filing date of the earliest of a chain of prior copending applications. See In re Henriksen, 158 USPQ 224; 853 O.G. 17.

A second application which is not copending with the first application, which includes those called substitutes in § 201.09, is not entitled to the benefit of the filing date of the prior application and the bars to the grant of a patent are computed from the filing date of the second application. An applicant is not required to refer to such applications in the specification of the later filed application. If the examiner is aware of such a prior abandoned application he should make a reference to it in an Office action in order that the record of the second application will show this fact. In the case of a "Substitute" application, the notation on the file wrapper is printed in the heading of the patent copies and thus calls attention to the relationship of the two cases.

If an applicant refers to a prior noncopending abandoned application in the specification, the manner of referring to it should make it evident that it was abandoned before filing the second.

For notations to be placed on the file wrapper in the case of continuing applications see §§ 202.02 and 1302.09.

When Not Entitled To Benefit of Filing Date

Where the first application is found to be fatally defective because of insufficient disclosure to support allowable claims, a second application filed as a "continuation-in-part" of the first application to supply the deficiency is not entitled to the benefit of the filing date of the first application. Hunt Co. v. Mallinckrodt Chemical Works, 83 USPQ 277 at 281 and cases cited therein. [R–24]

201.12 Assignment Carries Title [R–24]

Assignment of an original application carries title to any divisional, continuation, substitute or reissue application stemming from the original application and filed after the date of assignment. See § 306.

201.13 Right of Priority of Foreign Application [R–37]

Under certain conditions and on fulfilling certain requirements, an application for patent filed in the United States may be entitled to the benefit of the filing date of a prior application filed in a foreign country, to overcome an intervening reference or for similar purposes. The conditions are specified in 35 U.S.C. 119.

35 U.S.C. 119. Benefit of earlier filing date in foreign country; right to priority. An application for patent for an invention filed in this country by any person who has, or whose legal representatives or assigns have, previously regularly filed an application for a patent for the same invention in a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States, shall have the same effect as the same application would have if filed in this country on the date on which the application for patent for the same invention was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed; but no patent shall be granted on any application for patent for an invention which had been patented or described in a printed publication in any country more than one year before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country more than one year prior to such filing.

No application for patent shall be entitled to this right of priority unless a claim therefor and a certified copy of the original foreign application, specification and drawings upon which it is based are filed in the Patent Office before the patent is granted, or at such time during the pendency of the application as required by the Commissioner not earlier than six months after the filing of the application in this country. Such certification shall be made by the patent office of the foreign country in which filed and show the date of the application and of the filing of the specification and other papers. The Commissioner may require a translation of the papers filed if not in the English language and such other information as he deems necessary.

In like manner and subject to the same conditions and requirements, the right provided in this section may be based upon a subsequent regularly filed application in the same foreign country instead of the first filed foreign application, provided that any foreign application filed prior to such subsequent application has been withdrawn, abandoned, or otherwise disposed of, without having been laid open to public inspection and without leaving any rights outstanding, and has not served, nor thereafter shall serve, as a basis for claiming a right of priority.

Applications for inventors' certificates filed in a foreign country in which applicants have a right to apply, at their discretion, either for a patent or for an inventor's certificate shall be treated in this country in the same manner and have the same effect for purpose of the right of priority under this section as applications for patents, subject to the same conditions and requirements of this section as apply to applications for patents, provided such applicants are entitled to the benefits of the Stockholm Revision of the Paris Convention at the time of such filing. (effective August 25, 1973) Public Law 92-358, July 28, 1972.

The period of twelve months specified in this section is six months in the case of designs, 35 U.S.C. 172. See § 1506.

The conditions, for benefit of the filing date of a prior application filed in a foreign country, may be listed as follows:

1. The foreign application must be one filed in "a foreign country which affords similar privileges in the case of applications filed in the United States or to citizens of the United States."

2. The foreign application must have been filed by the same applicant (inventor) as the applicant in the United States, or by his legal representatives or assigns.

3. The application, or its copending parent United States application must have been filed within twelve months from the date of the earliest foreign filing in a "recognized" country as explained below.

4. The foreign application must be for the same invention as the application in the United States.

5. In the case where the basis of the claim is an application for an inventor's certificate, the requirements of rule 55(c) must also be met.

Recognized Countries of Foreign Filing

The right to rely on a foreign application is known as the right of priority in international patent law and this phrase has been adopted in our statute. The right of priority originated in a multilateral treaty of 1883, to which the United States adhered in 1887, known as the International Convention for the Protection of Industrial Property is administered by the World Intellectual Property Organization (WIPO) at Geneva, Switzerland. This treaty has been revised several times, the latest revision in effect being written in Stockholm in July, 1967 (copy at 852 O.G. 511). Articles 13–30 of the Stockholm Revision became effective on September 5, 1970. Articles 1–12 of the Stockholm Revision became effective on August 25, 1973. One of the many provisions of the treaty requires each of the adhering countries to accord the right of priority to the nationals of the other countries and the first United States statute relating to this subject was enacted to carry out this obligation. There is another treaty between the United States and some Latin American countries which also provides for the right of priority, and a foreign country may also provide for this right by reciprocal legislation.

Note: Following is a list of countries with respect to which the right of priority referred to in 35 U.S.C. 119 has been recognized. The authority in the case of these countries is the International Convention for the Protection of Industrial Property (613 O.G. 23, 53 Stat. 1748), indicated by the letter I following the name of the country; the Inter-American Convention relating to Inventions, Patents, Designs and Industrial Models, signed at Buenos Aires, August 20, 1910 (207 O.G. 935, 38 Stat. 1811), indicated by the letter P after the name of the country; or reciprocal legislation in the particular country, indicated by the letter L following the name of the country. Algeria (I), Argentina (I), Australia (I), Austria (I), Belgium (I), Brazil (I, P), Bulgaria (I), Cameroon (I), Canada (I), Central African Republic (I), Chad, Republic of (I), Congo, Republic of (Brazzaville) (I), Costa Rica (P), Cuba (I, P), Cyprus (I), Czechoslovakia (I), Dahomey (I), Denmark (I), Dominican Republic (I, P), Ecuador (P), Finland (I), France (I), Gabon (I), Germany, Federal Republic of (I), Greece (I), Guatemala (P), Haiti (I, P), Honduras (P), Hungary (I), Iceland (I), Indonesia (I), Iran (I), Ireland (I), Israel (I), Italy (I), Ivory Coast, Republic of (I), Japan (I), Jordan (I), Kenya (I), Korea (L), Lebanon (I), Liechtenstein (I), Luxembourg (I), Malagasy, Republic of (I), Malawi (I), Malta (I), Mauritania (I), Mexico (I), Monaco (I), Morocco (I), Netherlands (I), New Zealand (I), Nicaragua (P), Niger (I), Nigeria, Federation of (I), Norway (I), Panama (P), Paraguay (P), Philippines (I), Poland (I), Portugal (I), Rhodesia (I), Romania (I), San Marino (I), Senegal, Republic of (I), South Africa, Republic of (I), Spain (I), Sri Lanka (formerly Ceylon) (I), Sweden (I), Switzerland (I), Syrian Arab Republic (I), Tanzania (I), Togo (I), Trini-

dad and Tobago (I), Tunisia (I), Turkey (I), Uganda (I), U.S.S.R. (I), United Arab Republic (Egypt) (I), United Kingdom (I), Upper Volta, Republic of (I), Uruguay (I, P), Vatican City (I), Viet-Nam, Republic of (I), Yugoslavia (I), Zambia (I).

Thirteen African Countries have joined together to create a common patent office and to promulgate a common law for the protection of inventions, trademarks, and designs. The common patent office is called "Office Africain et Malgache de la Propriete Industrielle" (OAMPI) and is located in Yaounde, Cameroon. The member countries using the OAMPI Patent Office are Cameroon; Central African Republic; Congo, Republic of; Chad, Republic of; Dahomey; Gabon; Ivory Coast, Republic of; Malagasy, Republic of; Mauritania; Niger; Senegal, Republic of; Togo; and Upper Volta, Republic of. Since all these countries adhere to the International Convention for the Protection of Industrial Property, priority under 35 U.S.C. 119 may be claimed of an application filed in the OAMPI Patent Office.

If any applicant asserts the benefit of the filing date of an application filed in a country not on this list, the examiner should inquire to determine if there has been any change in the status of that country. It should be noted that the right is based on the *country* of the foreign filing and not upon the citizenship of the applicant.

Identity of Inventors

The inventors of the U.S. application and of the foreign application must be the same, for a right of priority does not exist in the case of an application of inventor A in the foreign country and inventor B in the United States, even though the two applications may be owned by the same party. However the application in the foreign country may have been filed by the assignee, or by the legal representative or agent of the inventor which is permitted in some foreign countries, rather than by the inventor himself, but in such cases the name of the inventor is usually given in the foreign application on a paper filed therein. An indication of the identity of inventors made in the oath or declaration accompanying the U.S. application by identifying the foreign application and stating that the foreign application had been filed by the assignee, or the legal representative, or agent, of the inventor, or on behalf of the inventor, as the case may be, is acceptable.

Time for Filing U.S. Application

The United States application, or its copending parent application, must have been filed within twelve months of the foreign filing. In computing this twelve months, the first day is not counted; thus, if an application was filed in Canada on January 2, 1952, the U.S. application may be filed on January 2, 1953. The Convention specifies in Article 4C (2) that "the day of filing is not counted in this period." (This is the usual method of computing periods, for example a six month period for reply to an Office action dated January 2 does not expire on July 1 but the reply may be made on July 2.) If the last day of the twelve months is a Sunday or a holiday within the District of Columbia, the U.S. application is in time if filed on the next succeeding business day; thus, if the foreign application was filed on September 6, 1952, the U.S. application is in time if filed on September 8, 1953, since September 6, 1953 was a Sunday and September 7, 1953 was a holiday. Since January 1, 1953, the Patent Office has not received applications on Saturdays and, in view of 35 U.S.C. 21, and the Convention which provides "if the last day of the period is a legal holiday, or a day on which the Patent Office is not open to receive applications in the country where protection is claimed, the period shall be extended until the next working day" (Article 4C3), if the twelve months expires on Saturday, the U.S. application may be filed on the following Monday.

First Foreign Application

The twelve months is from the earliest foreign filing except as provided in the second to the last paragraph of 35 U.S.C. 119. If an inventor has filed an application in France on January 2, 1952, and an application in Great Britain on March 3, 1952, and then files in the United States on February 2, 1953, he is not entitled to the right of priority at all; he would not be entitled to the benefit of the date of the French application since this application was filed more than twelve months before the U.S. application, and he would not be entitled to the benefit of the date of the British application since this application is not the first one filed. If the first foreign application was filed in a country which is not recognized with respect to the right of priority, it is disregarded for this purpose.

Public Law 87–333 extended the right of priority to "subsequent" foreign applications if one earlier filed had been withdrawn, abandoned or otherwise disposed of, under certain conditions and for certain countries only.

Great Britain and a few other countries have a system of "post-dating" whereby the filing date of an application is changed to a later date.

This "post-dating" of the filing date of the application does not affect the status of the application with respect to the right of priority; if the original filing date is more than one year prior to the U.S. filing no right of priority can be based upon the application. See In re Clamp, 151 USPQ 423.

If an applicant has filed two foreign applications in recognized countries, one outside the year and one within the year, and the later application discloses additional subject matter, a claim in the U.S. application specifically limited to the additional disclosure would be entitled to the date of the second foreign application since this would be the first foreign application for that subject matter.

EFFECT OF RIGHT OF PRIORITY

The right to rely on the foreign filing extends to overcoming the effects of intervening references or uses, but there are certain restrictions. For example the one year bar of 35 U.S.C. 102(b) dates from the U.S. filing date and not from the foreign filing date; thus if an invention was described in a printed publication, or was in public use in this country, in November 1952, a foreign application filed in January 1953, and a U.S. application filed in December 1953, granting a patent on the U.S. application is barred by the printed publication or public use occurring more than one year prior to its actual filing in the U.S.

The right of priority can be based upon an application in a foreign country for a so-called "utility model," called Gebrauchsmuster in Germany.

201.13(a) Right of Priority based upon an Application for an Inventor's Certificate [R–39]

Until August 25, 1973, the Patent Office did not recognize a right of priority based upon an application for an Inventors' Certificate such as used in the U.S.S.R. However, a claim for priority and a certificated copy of an application for Inventors' Certificate were entered in the file of the U.S. application and were retained therein. This allowed the applicant to urge the right of priority in possible later court action.

On August 25, 1973, Articles 1–12 of the Paris Convention of March 20, 1883, for the Protection of Industrial Property, as revised at Stockholm, July 14, 1967, came into force with respect to the United States and apply to applications filed thereafter in the United States. A fourth paragraph to 35 U.S.C. 119 (enacted by Public Law 92–358, July 28, 1972) (copy at § 201.13) and a new paragraph (c) to rule 55 (905 O.G. 684) also became effective on August 25, 1973.

Rule 55. Serial number and filing date of application.

* * * * *

(c) An applicant may under certain circumstances claim priority on the basis of an application for an inventor's certificate in a country granting both inventor's certificates and patents. When an applicant wishes to claim the right of priority as to a claim or claims of the application on the basis of an application for an inventor's certificate in such a country under 35 U.S.C. 119, last paragraph (as amended July 28, 1972), the applicant or his attorney or agent, when submitting a claim for such right as specified in paragraph (b) of this rule, shall include an affidavit or declaration including a specific statement that, upon an investigation, he has satisfied himself that to the best of his knowledge the applicant, when filing his application for the inventor's certificate, had the option to file an application either for a patent or an inventor's certificate as to the subject matter of the identified claim or claims forming the basis for the claim of priority.

An inventor's certificate may form the basis for rights of priority under 35 U.S.C. 119 only in countries maintaining patents and inventor's certificates as alternative systems for the recognition and reward of inventive contributions where an applicant has the right to apply at his discretion for either grant. Some countries such as Bulgaria, Rumania, and the Soviet Union provide alternatively for either patents or inventor's certificates on some types of inventions for some inventors.

Priority rights on the basis of an inventor's certificate application will be honored only if the applicant had the option or discretion to file for either an inventor's certificate or a patent on his invention in his home country. Certain countries which grant both patents and inventor's certificates issue only inventor's certificates on certain subject matter, generally pharmaceuticals, foodstuffs and cosmetics.

To insure compliance with the treaty and statute, rule 55(c) provides that at the time of claiming the benefit of priority for an inventor's certificate, the applicant or his attorney must submit an affidavit or declaration stating that the applicant when filing his application for the inventor's certificate had the option either to file for a patent or an inventor's certificate as to the subject matter forming the basis for the claim of priority.

Effective Date

Rule 55(c) went into effect on August 25, 1973, which is the date on which the international treaty entered into force with respect to

the United States. The rights of priority based on an earlier filed inventor's certificate shall be granted only with respect to U.S. patent applications where *both* the earlier application and the U.S. patent application were filed in their respective countries following this effective date.

201.14 Right of Priority, Formal Requirements [R–30]

Under the statute (35 U.S.C. 119, second paragraph), an applicant who wishes to secure the right of priority must comply with certain formal requirements within a time specified. If these requirements are not complied with the right of priority is lost and cannot thereafter be asserted.

The requirements of the statute are (a) that the applicant must file a claim for the right and (b) he must also file a certified copy of the original foreign application; these papers must be filed within a certain time limit. The maximum time limit specified in the statute is that the papers must be filed before the patent is granted, but the statute gives the Commissioner authority to set this time limit at an earlier time during the pendency of the application. If the required papers are not filed within the time limit set the right of priority is lost. A reissue was granted in Brenner v. State of Israel, 862 O.G. 661; 158 USPQ 584, where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119 before the patent was granted.

It should be particularly noted that these papers must be filed in all cases even though they may not be necessary during the pendency of the application to overcome the date of any reference. The statute also gives the Commissioner authority to require a translation of the foreign documents if not in the English language and such other information as he may deem necessary.

Rule 65 requires that the oath or declaration shall state whether or not any application for patent on the same invention has been filed in any foreign country either by the applicant or by his legal representatives or assigns; if any foreign application has been filed the applicant must state the country and the date of filing of the earliest such application and he must also identify every foreign application which was filed more than twelve months before the filing of the application in this country. If all foreign applications have been filed within twelve months of the U.S. filing the applicant is required to recite only the first such application and it should be clear in the recitation that the foreign application referred to is the first filed foreign application.

The requirements for recitation of foreign applications in the oath or declaration, while serving other purposes as well, are used in connection with the right of priority.

201.14(a) Right of Priority, Time for Filing Papers [R–39]

The time for filing the priority papers required by the statute is specified in the second paragraph of rule 55.

Rule 55(b). An applicant may claim the benefit of the filing date of a prior foreign application under the conditions specified in 35 U.S.C. 119. The claim to priority need be in no special form and may be made by the attorney or agent if the foreign application is referred to in the oath or declaration as required by rule 65. The claim for priority and the certified copy of the foreign application specified in the second paragraph of 35 U.S.C. 119 must be filed in the case of interference (rule 224); when necessary to overcome the date of a reference relied upon by the examiner; or when specifically required by the examiner, and in all other cases they must be filed not later than the date the issue fee is paid. If the papers filed are not in the English language, a translation need not be filed except in the three particular instances specified in the preceding sentence, in which event a sworn translation or a translation certified as accurate by a sworn or official translator must be filed.

It should first be noted that the Commissioner has by rule specified an earlier ultimate date than the date the patent is granted for filing a claim and a certified copy. The latest time at which the papers may be filed is the date of the payment of the issue fee, except that, under certain circumstances, they are required at an earlier date. These circumstances are specified in the rule as (1) in the case of interferences in which event the papers must be filed within the time specified in the interference rules, (2) when necessary to overcome the date of a reference relied upon by the examiner, and (3) when specifically required by the examiner.

In view of the shortened periods for prosecution leading to allowances, it is recommended that priority papers be filed as early as possible. Although rule 55 permits the filing of priority papers up to and including the date for payment of the issue fee, it is advisable that such papers be filed promptly after filing the application. Frequently, priority papers are found to be deficient in material respects, such as, for example, the failure to include the correct certified copy, and there is not sufficient time to remedy the defect. Occasionally a new oath or declaration may be necessary where the original oath or declaration omits the reference to the foreign filing date for which the benefit is claimed. The early filing of priority papers

would thus be advantageous to applicants in that it would afford time to explain any inconsistencies that exist or to supply any additional documents that may be necessary.

It is also suggested that a pencil notation of the serial number of the corresponding U.S. application be placed on the priority papers.

Priority papers filed after the date of payment of the base issue fee will be accepted and acknowledged only if a petition under rule 183 to suspend rule 55 is filed and granted. Such petitions are granted only in extraordinary situations, when justice requires and where the printing of the patent has not yet taken place. Ex parte Bueche-Roose, 100 USPQ 439; In re Inoue, 171 USPQ 634.

201.14(b) Rights of Priority, Papers Required [R–34]

The filing of the priority papers under 35 U.S.C. 119 makes the record of the file of the United States patent complete. The Patent Office does not examine the papers to determine whether the applicant is in fact entitled to the right of priority and does not grant or refuse the right of priority, except as described in § 201.15 and in cases of interferences.

The papers required are the claim for priority and the certified copy of the foreign application. The claim to priority need be in no special form, and may be made by the attorney or agent at the time of transmitting the certified copy if the foreign application is the one referred to in the oath or declaration of the U.S. application. No special language is required in making the claim for priority and any expression which can be reasonably interpreted as claiming the benefit of the foreign application is accepted as the claim for priority. The claim for priority may appear in the oath or declaration with the recitation of the foreign application.

The certified copy which must be filed is a copy of the original foreign application with a certification by the patent office of the foreign country in which it was filed. Certified copies ordinarily consist of a copy of the specification and drawings of the application as filed with a certificate of the foreign patent office giving certain information. "Application" in this connection is not considered to include formal papers such as a petition. A copy of the foreign patent as issued does not comply since the application as filed is required; however, a copy of the printed specification and drawing of the foreign patent is sufficient if the certification indicates that it corresponds to the application as filed. A French patent stamped "Service De La Propriété Industrielle—Conforme Aux Piéces Déposées A L' Appui de La Demande" and additionally bearing a signed seal is also acceptable in lieu of a certified copy of the French application.

When the claim to priority and the certified copy of the foreign application are received while the application is pending before the examiner, the examiner should make no examination of the papers except to see that they correspond in date and country to the application identified in the oath or declaration and contain no obvious formal defects. The subject matter of the application is not examined to determine whether the applicant is actually entitled to the benefit of the foreign filing date on the basis of the disclosure thereof.

During Interference

If priority papers are filed in an interference, it is not necessary to file an additional certified copy in the application file. The interference examiner will place them in the application file.

Later Filed Applications, Reissues

Where the benefit of a foreign filing date based on a foreign application is claimed in a later filed application (i.e., continuation, continuation-in-part, division) or in a reissue application and a certified copy of the foreign application as filed, has been filed in a parent or related application, it is not necessary to file an additional certified copy in the later application. The applicant when making such claim for priority may simply identify the application containing the certified copy. In such cases, the examiner should acknowledge the claim with a statement as follows:

[1] "Applicant's claim for priority, based on priority papers filed in application Serial No. --------, submitted under 35 U.S.C. 119, is acknowledged."

If the applicant fails to call attention to the fact that the certified copy is in the parent or related application and the examiner is aware of the fact that a claim for priority under 35 U.S.C. 119 was made in the parent or related application, the examiner should call applicant's attention to these facts in an Office action, so that if a patent issues on the later or reissue application, the priority data will appear in the patent. In such cases, the following exemplary language should be used:

[2] "Applicant is reminded that in order for a patent issuing on the instant application, to contain the priority data based on priority papers filed in parent application Serial No. ------ under 35 U.S.C. 119, a claim for such priority must be made in this application. In making such claim, applicant may simply identify the application containing the priority papers.

Where the benefit of a foreign filing date, based on a foreign application, is claimed in a later filed application or in a reissue application and a certified copy of the foreign application, as filed, has not been filed in a parent or related application, a claim for priority may be made in the later application. When such a claim is made in the later application and a certified copy of the foreign application is placed therein, the examiner should acknowledge the claim with a statement as follows:

[3] "Applicant's claim for priority under 35 U.S.C. 119 and priority papers filed in support thereof are hereby acknowledged."

201.14(c) Right of Priority, Practice [R-39]

Before going into the practice with respect to those instances in which the priority papers are used to overcome a reference, there will first be described the practice when there is no occasion to use the papers, which will be in the majority of cases. In what follows in this section it is assumed that no reference has been cited which requires the priority date to be overcome.

No Irregularities

When the papers under 35 U.S.C. 119 are received they are to be endorsed on the contents page of the file as "Letter (or amendment) and foreign application". Assuming that the papers are regular in form and that there are no irregularities in dates, the examiner in the next Office action will advise the applicant that the papers have been received. The form of acknowledgment may be as follows:

[1] "Receipt is acknowledged of papers submitted under 35 U.S.C. 119, which papers have been placed of record in the file."

The examiner will enter the information specified in § 202.03 on the face of the file wrapper.

If application is in interference when papers under 35 U.S.C. 119 are received see § 1111.10.

Papers Inconsistent

If the certified copy filed does not correspond to the application identified in the application oath or declaration, or if the application oath or declaration does not refer to the particular foreign application, the applicant has not complied with the requirements of the rule relating to the oath or declaration. In such instances the examiner's letter, after acknowledging receipt of the papers, should require the applicant to explain the inconsistency and to file a new oath or declaration stating correctly the facts concerning foreign applications required by rule 65. A letter in such cases may read:

[2] "Receipt is acknowledged of papers filed _____, based on an application filed in _____ on _____. Applicant has not complied with the requirements of rule 65(a), since the (*oath or declaration*) does not acknowledge the filing of any foreign application. A new (*oath or declaration*) is required."

Other situations requiring some action by the examiner are exemplified by the following sample letters.

No Claim for Priority

[3] "Receipt is acknowledged of a certified copy, filed _____, of the _____ application referred to in the (oath or declaration). If this copy is being filed to obtain the benefits of the foreign filing date under 35 U.S.C. 119, applicant should also file a claim for priority as required by said section."

Note: Where the accompanying letter states that the certified copy is filed for priority purposes or for the convention date, it is accepted as a claim for priority.

Foreign Applications All More Than a Year Before U.S. Filing

[4] "Receipt is acknowledged of the filing on _____, of a certified copy of the _____ application referred to in the (*oath or declaration*). A claim for priority can not be based on said application, since the United States application was filed more than twelve months thereafter." The papers are accordingly being returned."

Some Foreign Applications More Than a Year Before U.S. Filing

For example, British provisional specification filed more than a year before U.S. application, but British complete filed within the year, and certified copies of both submitted.

[5] "Receipt is acknowledged of papers filed on September 18, 1953, purporting to comply with the requirements of 35 U.S.C. 119. It is not seen how the claim for priority can be based on the British specification filed January 23, 1948, because the instant application was filed more than one year thereafter. However, the printed heading of the patent will note the claimed priority date based on the complete specification; i.e., November 1, 1948, for such subject matter as was not disclosed in the provisional specification."

Certified Copy Not the First Filed Foreign Application

[6] "Receipt is acknowledged of papers filed on _____ (date), purporting to comply with the requirements of 35 U.S.C. 119 and they have been placed of record in the file.

Attention is directed to the fact that the date for which priority is claimed is not the date of the first filed foreign application acknowledged in the oath or declaration. However, the priority date claimed which will appear in the printed heading of the patent will be _____ (date claimed)."

No Certified Copy

[7] "Acknowledgment is made of applicant's claim for priority based on an application filed in _____ on _____. It is noted, however, that applicant has not filed a certified copy of the _____ application as required by 35 U.S.C. 119."

The above letters are merely typical ones which have been used, and any unusual situation may be referred to the group director.

Application in Issue

When priority papers for applications which have been sent to the Patent Issue Division are received, the priority papers should be sent to the Patent Issue Division. The Patent Issue Division will acknowledge receipt of all such priority papers.

Return of Papers

It is sometimes necessary for the examiner to return papers filed under 35 U.S.C. 119 either upon request of the applicant, for example, to obtain a sworn translation of the certified copy of the foreign application, or because they fail to meet a basic requirement of the statute, such as where all foreign applications were filed more than a year prior to the U.S. filing date.

Where the papers have not been given a paper number and endorsed on the file wrapper, it is not necessary to secure approval of the Commissioner for their return but they should be sent to the group director for cancellation of the Office stamps. Where the papers have been made of record in the file (given a paper number and endorsed on the file wrapper), a request for permission to return the papers should be addressed to the Commissioner of Patents and Trademarks and forwarded to the group director for approval. Where the return is approved, the written approval should be placed in the file wrapper. Any questions relating to the return of papers filed under 35 U.S.C. 119 should be directed to the Office of the Deputy Assistant Commissioner for Patents. [R–43]

201.14(d) Proper Identification of Priority Application [R–43]

In order to help overcome problems in determining the proper identification of priority applications for patent documentation and printing purposes, the following tables have been prepared which set out for 43 countries the forms of acceptable presentation of application numbers.

The tables should enable applicants, examiners and others to extract from the various formats the minimum required data which comprises a proper citation.

Proper identification of priority applications is essential to establishing accurate and complete relationships among various patent documents which reflect the same invention. Knowledge of these relationships is essential to search file management, technology documentation and various other purposes.

The tables show the forms of presentation of application numbers as used in the records of the source or orginating patent office. They also show, under the heading "Minimum Significant Part of the Number", the simplified form of presentation which should be used in United States Patent and Trademark Office records.

Note particularly that in the simplified format that:

(1) Alpha symbols preceding numerals are eliminated in all cases except Hungary.

(2) A decimal character and numerical subset as part of a number is eliminated in all cases except France.

(3) Use of the dash (—) is reduced, but is still an essential element of application numbers, in the case of Czechoslovakia, Japan, and Venezuela.

MINIMUM SIGNIFICANT PART OF AN APPLICATION NUMBER PROVIDING UNIQUE IDENTIFICATION OF AN APPLICATION

TABLE I—*Countries Using Annual Application Number Series*

Country #	Example of application number at source	Minimum significant part of the number	Remarks
Austria [OE]	A 12116/69	12116/69	The letter A is common to all patent applications.
Czechoslovakia [CS]	PV3628-72	3628-72	PV is an abbreviation meaning "application of invention".
Denmark [DK]	2986/68	2986/68	
Egypt [ET]	487 1968	487 1968	
Finland [SF]	3032/69	3032/69	
France [FR]	69.38066	69.38066	
Germany, Fed. Rep. of [DT]	P 1940738.6-24	1940738	P=Patent. The first two digits of the number represent the last two digits of the year of Application less 50 (e.g., 1969 less 50=19; 1973 less 50=23). The first digit after the period is an error control digit. The two digits following the dash indicate the examining division.

See footnotes at end of table.

TABLE I.—*Countries Using Annual Application Number Series*—Continued

Country #	Example of application number at source	Minimum significant part of the number	Remarks
	G 6947580.5	*6947580	G=Gebrauchsmuster. The first two digits represent the last two digits of the year of the application. The difference in numbering scheme of the first two digits affords unique identification of this type of application. However, see note below (*). The digit after the period is for error control.
India [IN]	643/58	643/58	
Ireland [EI]	1152/69	1152/69	
Italy [IT]	28039-A/70	28039/70	Application numbers are not presented on published patent documents or given in an official gazette. An exclusive block of application numbers is given annually to each of 93 provincial bureaus where patent applications may be filed. In 1973, 90,000 numbers were allotted, whereas an estimated total of 30,000 applications are expected to be filed. While, as a consequence, gaps will exist in the ultimately used numbers, each application has a unique number. For this purpose, neither the dash nor the letter identifying the receiving bureau, which follow the application number, is needed.
Japan [JA]	46-69807	46-69807	The two digits before the dash indicate the year of the Emperor's reign in which the application was filed (46=1971). Patent and utility model applications are numbered in separate series. The examples given were filed on the same day.
	46-81864	*46-81864	
Netherlands [NL]	7015038	7015038	First two digits indicate year of application.
Norway [NO]	1748/70	1748/70	
Pakistan [PK]	1031/65	1031/65	
South Africa [ZA]	70/4865	70/4865	
Sweden [SW]	16414/70 (old system).	16414/70	The new numbering system was introduced January 1, 1973.
	7300001-0 (new system).	7300001	First two digits indicate year of application. The digit after the dash is used for computer control.
Switzerland [CH]	15978/70	15978/70	
United Kingdom [GB]	41352/70	41352/70	
Venezuela [VE]	2122-68	2122-68	
Yugoslavia [YU]	P1135/66	1135/66	
Zambia [ZB]	142/70	142/70	

#ICIREPAT Country Code is indicated in brackets; e.g., Austria [OE].

*In order to distinguish utility model applications from patent applications, it is necessary to identify them as to type of application in citations or references. This may be done either by using the name of the application type in conjunction with the number or by using the symbol "U" in brackets or other enclosure following the number.

TABLE II.—*Countries Using Other Than An Annual Application Number Series*

Country #	Example of application number at source	Minimum significant part of the number	Remarks
Argentina [AR]	231790	231790	
Australia [AU]	59195/69	59195/69	Long series spread over several years. New series started in 1970.
Belgium [BE]	96469	96469	Application numbers are not presented on published patent documents or given in an official gazette. A series of parallel numbers is provided to each of 10 offices which, respectively, may receive applications (control office +9 provincial bureaus) and assign application numbers. Present series was started in 1958. Since an application number does not uniquely identify a BE document, the patent number is often cited as the "priority application number".
Brazil [BR]	222986	222986	
Bulgaria [BG]	11572	11572	
Canada [CA]	103828	103828	
Colombia [CO]	126050	126050	
Cuba [CU]	33384	33384	
German (Dem. Rep.) [DL]	AP84c/137355.	137355	AP=Ausschliessungspatent;
	WP35b/147203	147203	WP=Wirtschaftspatent. The other symbols before the slash are classification symbols. A single numbering series covers both AP and WP applications.
Greece [GR]	44114	44114	
Hungary [HU]	OE 107	OE 107	The letters preceding the number are essential for identifying the application. They are the first letter and the first following vowel of the applicant's name. There is a separate numbering series for each pair of letters.
Israel [IL]	35691	35691	
Luxembourg [LU]	60093	60093	
Mexico [MX]	123723	123723	
Monaco [MC]	908	908	
New Zealand [NZ]	161732	161732	
OAMPI	52118	52118	
Philippines [RP]	11929	11929	
Poland [PO]	P144826	144826	
	44987	*44987	
Portugal [PT]	52555	52555	
	5607	*5607	
Romania [RU]	65211	65211	
Soviet Union [SU]	1397205/30-15	1397205	The numbers following the slash denote the examination division and a processing number.
United States [US]	889877	889877	The highest number assigned in the series of numbers started in January 1960. New series started January 1970.

#ICIREPAT Country Code is indicated in brackets; e.g. [AR].

*In order to distinguish utility model applications from patent applications, it is necessary to identify them as to type of application in citations or references. This may be done either by using the name of the application type in conjuction with the number or by using the symbol "U" in brackets or other enclosure following the number.

201.15 Right of Priority, Overcoming a Reference [R–24]

The only time during ex parte prosecution that the examiner considers the merits of an applicant's claim of priority is when a reference is found with an effective date between the date of the foreign filing and the date of filing in the United States. If at the time of making an action the examiner has found such a reference, he simply rejects whatever claims may be considered unpatentable thereover, without paying any attention to the priority date (assuming the papers have not yet been filed). The applicant in his response may argue the rejection if it is of such a nature that it can be argued, or he may present the foreign papers for the purpose of overcoming the date of the reference. If the applicant argues the reference, the examiner, in his next action in the case, may, if he so desires, specifically require the foreign papers to be filed in addition to repeating the rejection if it is still considered applicable, or he may merely continue the rejection. In those cases where the applicant files the foreign papers for the purpose of overcoming the effective date of a reference a translation is required, if the foreign papers are not in the English language. When the examiner requires the filing of the papers, the translation should also be required at the same time. This translation must be a sworn translation or a translation certified as accurate by a sworn or official translator. When the necessary papers are filed to overcome the date of the reference, the examiner's action, if he determines that the applicant is not entitled to the priority date, is to repeat the rejection on the reference, stating the reasons why the applicant is not considered entitled to the date. If it is determined that he is entitled to the date, the rejection is withdrawn in view of the priority date.

If the priority papers are already in the file when the examiner finds a reference with the intervening effective date, the examiner will study the papers, if they are in the English language, to determine if the applicant is entitled to their date. If the applicant is found to be entitled to the date, the reference is simply not used. If the applicant is found not entitled to the date, the unpatentable claims are rejected on the reference with an explanation. If the papers are not in the English language and there is no translation, the examiner may reject the unpatentable claims and at the same time require an English translation for the purpose of determining the applicant's right to rely on the foreign filing date.

The foreign application may have been filed by the assignee or legal representative or agent of the inventor, in his or its own name as applicant. In such cases, if the certified copy of the foreign application corresponds with the one identified in the oath or declaration as required by rule 65 and no discrepancies appear, it may be assumed that the inventors are the same. If there is disagreement as to inventors on the certified copy, the priority date should be refused until the inconsistency or disagreement is resolved.

The most important aspect of the examiner's action pertaining to a right of priority is the determination of the identity of invention between the U.S. and the foreign applications The foreign application may be considered in the same manner as if it had been filed in this country on the same date that it was filed in the foreign country, and the applicant is ordinarily entitled to any claims based on such foreign application that he would be entitled to under our laws and practice. The foreign application must be examined for the question of sufficiency of the disclosure under 35 U.S.C. 112, as well as to determine if there is a basis for the claims sought.

In applications filed from Great Britain there may be submitted a certified copy of the British "provisional specification," which may also in some cases be accompanied by a copy of the "complete specification." The nature and function of the British provisional specification is described in an article in the Journal of the Patent Office Society of November 1936, pages 770–774. According to British law the provisional specification need not contain a complete disclosure of the invention in the sense of 35 U.S.C. 112, but need only describe the general nature of the invention, and neither claims nor drawings are required. Consequently, in considering such provisional specifications, the question of completeness of disclosure is important. If it is found that the British provisional specification is insufficient for lack of disclosure, reliance may then be had on the complete specification and its date, if one has been presented, the complete specification then being treated as a different application.

In some instances the specification and drawing of the foreign application may have been filed at a date subsequent to the filing of the petition in the foreign country. Even though the petition is called the application and the filing date of this petition is the filing date of the application in a particular country, the date accorded here is the date on which the specification and drawing were filed.

It may occasionally happen that the U.S. application will be found entitled to the filing date of the foreign application with respect to some claims and not with respect to others. Occasionally an applicant may rely on two or more different foreign applications and may be entitled to the filing date of one of them with respect to certain claims and to another with respect to other claims.

201.16 Extension of Period of Priority, Public Law 690 [R–24]

On August 8, 1946, Congress passed an act, Public Law 690 (sometimes referred to as the Boykin Act), providing for extensions of the period to take care of delays during the war. Public Law 220, July 23, 1947, Public Law 380, August 6, 1947, and Public Law 619, November 16, 1954, supplement the original enactment. These laws are reprinted in the back of the Patent Laws pamphlet.

201.17 Government Cases [R–24]

The term "Act of 1883 application" was used in referring to applications of government employees filed without fee under an act dated March 3, 1883, which was amended April 30, 1928. This act became 35 U.S.C. 266, which was repealed October 25, 1965. Beginning with this date, there are no longer any applications which are exempt from the filing fee or issue fee. Such applications are not always owned by the government. Other applications, not inventions of government employees, may be assigned to and owned by the government. See § 607.01.

202 Cross-Noting

202.01 In Specification [R–31]

Rule 78. Cross-references to other applications. (a) When an applicant files an application claiming an invention disclosed in a prior filed copending application of the same applicant, the second application must contain or be amended to contain in the first sentence of the specification following the title and abstract a reference to the prior application, identifying it by serial number and filing date and indicating the relationship of the applications, if the benefit of the filing date of the prior application is to be claimed. Cross-references to other related applications may be made when appropriate. (See rule 14(b).)

See also rule 79 and § 201.11.

There is seldom a reason for one application to refer to the application of another applicant not assigned to a common assignee. Such reference ordinarily should not be permitted.

202.02 Notation on File Wrapper of a Divisional, Continuation, Continuation-in-Part, or Substitute Application [R–36]

The heading of a printed patent includes all identifying parent data of continuation-in-part, continuation, divisional, substitute, and reissue applications. Therefore, the identifying data of all parent or prior applications, when given in the specification must be inserted by the examiner in black ink on the file wrapper in the case of a DIVISION, a CONTINUATION, a CONTINUATION-IN-PART and, whether given in the specification or not, in the case of a SUBSTITUTE Application. The "None" boxes must be marked when no parent or prior application information is present on the file wrappers containing such boxes. This should be done no later than the first action.

The inclusion of parent or prior application information in the heading does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

See § 306 for work done by the Assignment Division pertaining to these particular types of applications.

In the unlikely situation that there has been no reference to a parent application because the benefit of its filing date is not desired, no notation as to the parent case is made on the face of the file wrapper.

202.03 On File Wrapper When Priority Is Claimed for Foreign Application [R–31]

In accordance with § 201.14(c) the examiner will fill in the spaces concerning foreign applications on the face of the older file wrappers.

The information to be written on the face of the file wrapper consists of the country, application date (filing date), and if available, the application and patent numbers. In some instances, the particular nature of the foreign application such as "utility model" (Germany (Gebrauchsmuster) and Japan) must be written in parentheses before the application number. For example: Application Number (utility model) B62854.

At the present time, the computer printed file wrapper labels include the prior foreign application information. However, the examiner must still indicate whether the conditions of 35 U.S.C. 119 have been met.

If the filing dates of several foreign applications are claimed (see § 201.15, last paragraph) and satisfactory papers have been received for each, information respecting each of the foreign applications is to be entered on the face of the file wrapper.

The front page of the patent when it is issued, and the listing in the Official Gazette, will refer to the claim of priority, giving the country, the filing date, and the number of the application in those cases in which the face of the file has been endorsed.

In the case of designs, only the country and filing date are to be used. [R–44]

202.04 In Oath or Declaration [R–44]

As will be noted by reference to § 201.14, rule 65 requires that the oath or declaration include certain information concerning applications filed in any foreign country. If no applications for patent or inventor's certificate have been filed in any foreign country, the oath or declaration should so state.

202.05 In Case of Reissues [R–31]

Rule 179 requires that a notice be placed in the file of an original patent for which an application for reissue has been filed. See § 1401.03.

203 Status of Applications

203.01 New

A "new" application is one that has not yet received an action by the examiner. An amendment filed prior to the first Office Action does not alter the status of a "new" application.

203.02 Rejected [R–22]

An application which, during its prosecution in the examining group and before allowance, contains an unanswered examiner's action is designated as a "rejected" application. Its status as a "rejected" application continues as such until acted upon by the applicant in response to the examiner's action (within the allotted response period), or until it becomes abandoned.

203.03 Amended

An "amended" or "old" application is one that, having been acted on by the examiner, has in turn been acted on by the applicant in response to the examiner's action. The applicant's response may be confined to an election, a traverse of the action taken by the examiner or may include an amendment of the application.

203.04 Allowed or in Issue [R–44]

An "allowed" application or an application "in issue" is one which, having been examined, is passed to issue as a patent, subject to payment of the issue fee. Its status as an "allowed" case continues from the date of the notice of allowance until it is withdrawn from issue or until it issues as a patent or becomes abandoned, as provided in rule 316. See § 712.

The files of allowed cases are kept in the Patent Issue Division, arranged numerically by serial number.

203.05 Abandoned [R–22]

An abandoned application is, *inter alia*, one which is removed from the Office docket of pending cases (1) through formal abandonment by the applicant (acquiesced in by the assignee if there is one) or by the attorney or agent of record, (2) through failure of applicant to take appropriate action at some stage in the prosecution of the case, or (3) for failure to pay the issue fee. (§§ 203.07, 711 to 711.05, 712)

203.06 Incomplete [R–23]

An application lacking some of the essential parts and not accepted for filing is termed an incomplete application. (§§ 506 and 506.01)

203.07 Abandonment for Failure to Pay Issue Fee [R–44]

An allowed application in which the Base Issue Fee is not paid within three months after the Notice of Allowance is abandoned for that reason. The issue fee may however be accepted by the Commissioner on a verified showing that the delay in payment was unavoidable, in which case the patent will issue as though no abandonment had occurred (§ 712).

203.08 Status Inquiries [R–31]

In an effort to sharply reduce the volume and need for status inquiries, the past policy that diligence must be established by making timely status requests in connection with petitions to revive has been discontinued.

When an application has been abandoned for an excessive period before the filing of a petition to revive, an appropriate terminal disclaimer may be required. It should also be recognized that a petition to revive must be accompanied by the proposed response unless it has been previ-

ously filed (rule 137). Also, under rule 113, "Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each claim so rejected and, if any claim stands allowed, compliance with any requirement or objection as to form."

New Application

Current examining procedures now provide for the routine mailing from the examining groups of Form POL–327 in *every* case of allowance of an application except where an Examiner's Amendment is promptly mailed. Thus, the separate mailing of a form POL–327 or an Examiner's Amendment in addition to a formal Notice of Allowance (POL–85) in all allowed cases would seem to obviate the need for status inquiries even as a precautionary measure where the applicant may believe his new application may have been passed to issue on the first examination. However, as an exception, a status inquiry would be appropriate where a Notice of Allowance is not received within three months from receipt of either a form POL–327 or an Examiner's Amendment.

Current examining procedures also aim to minimize the spread in dates among the various examiner dockets of each art unit and group with respect to actions on new applications. Accordingly, the dates of the "oldest new applications" appearing in the Official Gazette are fairly reliable guides as to the expected time frames of when the examiners reach the cases for action.

Therefore, it should be rarely necessary to query the status of a new application.

Amended Applications

Amended cases are expected to be taken up by the examiner and an action completed within two months of the amendment date. Accordingly, a status inquiry is not in order after response by the attorney until five or six months have elapsed with no response from the Office. A post card receipt for responses to Office actions, adequately and specifically identifying the papers filed, will be considered *prima facie* proof of receipt of such papers. Where such proof indicates the timely filing of a response, the submission of a copy of the post card with a copy of the response will ordinarily obviate the need for a petition to revive. Proof of receipt of a timely response to a final action will obviate the need for a petition to revive only if the response was in compliance with rule 113.

In General

Such status inquiries as may be still necessary may be more expeditiously processed by the Office if each inquiry includes the application Serial Number, filing date, name of the applicant, name of the examiner who prepared the most recent Office action, and group art unit (taken from the most recent Office communication) in addition to the last known status of the application, and is accompanied by a stamped return-addressed envelope.

Status replies will be made by the Office clerical support force and will only indicate whether the application is awaiting action by the examiner or the applicant's response to an Office action. In the latter instance the mailing date of the Office action will also be given.

Inquiries as to the status of applications, by persons entitled to the information, should be answered promptly. Simple letters of inquiry regarding the status of applications will be transmitted from the Correspondence and Mail Division, to the examining groups for direct action. Such letters will be stamped "Status Letters."

If the correspondent is not entitled to the information, in view of rule 14, he should be so informed.

For Congressional and other official inquiries see § 203.08(a).

The original letter of inquiry should be returned to the correspondent together with the reply. The reply to an inquiry which includes a self-addressed, postage-paid postcard should be made on the postcard without placing it in an envelope.

In cases of allowed applications, a memorandum should be pinned to the inquiry with a statement of date it was forwarded to the Patent Issue Division by way of the Security Group, and transmitted to the Patent Issue Division for its appropriate action. This Division will notify the inquirer of the date of the notice of allowance and the status of the application with respect to payment of the issue fee and abandonment for failure to pay the issue fee.

In those instances where the letter of inquiry goes beyond mere matters of inquiry, it should not be marked as a "status letter", or returned to the correspondent. Such letters must be entered in the application file as a permanent part of the record. The inquiry should be answered by the examiner, however, and in a manner consistent with the provisions of rule 14.

Another type of inquiry is to be distinguished from ordinary status letters. When a U.S. application is referred to in a foreign patent (for priority purposes, for example), inquiries as to the status of said application (abandoned, pending, patented) should be forwarded to the Application Division (§ 102).

Telephone inquiries regarding the status of applications, by persons entitled to the information, should be directed to the group clerical personnel and not to the examiners. Inasmuch as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners.

203.08(a) Congressional and Other Official Inquiries [R–44]

Correspondence and inquiries from the White House, Members of Congress, embassies, and heads of Executive departments and agencies normally are cleared through the Commissioner's Office.

When persons from the designated official sources request services from the Office, or information regarding the business of the Office, they should, under long-standing instructions, be referred, at least initially, to the Commissioner's Office.

This procedure is used so that there will be uniformity in the handling of contacts from the indicated sources, and also so that compliance with directives of the Department of Commerce is attained.

Inquiries referred to in this section, particularly correspondence from Congress or the White House, should immediately be transmitted to the Commissioner's Office by special messenger, and the Commissioner's Office should be notified by phone that such correspondence has been received.

Chapter 300 Ownership and Assignment

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301 Assignability of Patents and Applications [R–43]

35 U.S.C. 261. Ownership; assignment. Subject to the provisions of this title, patents shall have the attributes of personal property.

Applications for patent, patents, or any interest therein, shall be assignable in law by an instrument in writing. The applicant, patentee, or his assigns or legal representatives may in like manner grant and convey an exclusive right under his application for patent, or patents, to the whole or any specified part of the United States.

A certificate of acknowledgment under the hand and official seal of a person authorized to administer oaths within the United States, or, in a foreign country, of a diplomatic or consular officer of the United States or an officer authorized to administer oaths whose authority is proved by a certificate of a diplomatic or consular officer of the United States, shall be prima face evidence of the execution of an assignment, grant or conveyance of a patent or application for patent.

An assignment, grant, or conveyance shall be void as against any subsequent purchaser or mortgagee for valuable consideration, without notice, unless it is recorded in the Patent and Trademark Office within three months from its date or prior to the date of such subsequent purchase or mortgage.

35 U.S.C. 262. Joint owners. In the absence of any agreement to the contrary, each of the joint owners of a patent may make, use or sell the patented invention without the consent of and without accounting to the other owners.

Rule 331. Recording of assignments. (a) Assignments, including grants and conveyances, of patents or applications for patents under 35 U.S.C. 261, will be recorded in the Patent and Trademark Office. Other instruments affecting title to a patent or application for patent, and licenses, even though the recording thereof may not serve as constructive notice under 35 U.S.C. 261, will be recorded as provided in this rule or in the discretion of the Commissioner.

(b) No instrument will be recorded which is not in the English language and which does not amount to an assignment, grant, mortgage, lien, incumbrance, or license, or which does not affect the title of the patent or invention to which it relates, and which does not identify the patent or application to which it relates, except as ordered by the Commissioner.

(c) An instrument relating to a patent should identify the patent by number and date (the name of the inventor and title of the invention as stated in the patent should also be given); an instrument relating to an application should identify the application by serial number and date of filing (the name of the inventor and title of the invention as stated in the application should also be given) but if an assignment is executed concurrently with or subsequent to the execution of the application but before the application is filed or before its serial number and filing date are ascertained, it should adequately identify the application, as by its date of execution and name of the inventor and title of the invention; so that there can be no mistake as to the patent or application intended.

Rule 333. Conditional assignments. Assignments which are made conditional on the performance of certain acts or events, as the payment of money or other condition subsequent, if recorded in the Office are regarded as absolute assignments for Office purposes until cancelled with the written consent of both parties or by the decree of a competent court. The Office has no means for determining whether such conditions have been fulfilled.

301.01 Accessibility of Assignment Records [R–30]

Rule 12. Assignment records open to public inspection. The assignment records, relating to original or reissue patents, including digests and indexes, are open to public inspection and copies of any instrument recorded may be obtained upon payment of the fee therefor. Assignment records, digests and indexes, relating to any pending or abandoned application are not available to the public. Copies of any such assignment records and information with respect thereto shall be

obtainable only upon written authority of the applicant or his assignee or attorney or agent or upon a showing that the person seeking such information is a bona fide prospective or actual purchaser, mortgagee or licensee of such application, unless it shall be necessary to the proper conduct of business before the Office or as provided by these rules. An order for a copy of an assignment should give the identification of the record. If identified only by the name of the patentee and number of the patent, or in the case of a trademark registration by the name of the registrant and number of the registration, or by name of the applicant and serial number of the application, an extra charge will be made for the time consumed in making a search for such assignment.

Assignments relating to applications for registration of trademarks are open to public inspection.

The Office will not open certain parts only of an assignment document to public inspection. If such a document contains two or more items, any one of which, if alone, would be open to such inspection, then the entire document will be open. Thus, if an assignment covers either a trademark or a patent in addition to one or more patent applications, it will be available to the public ab initio; and if it covers a number of patent applications, it will be so available as soon as any one of them is patented. Assignments relating only to one or more pending applications for patent will not be open to public inspection.

If the application on which a patent was granted is a division or continuation of an earlier case, the assignment records of that case will be open to public inspection; similar situations involving continuation-in-part applications will be considered on their individual merits.

Assignment records relating to reissue applications are open to public inspection.

302 Effect of Recording [R–43]

Rule 332. Receipt and recording. Assignments are recorded in regular order as promptly as possible, and then transmitted with the date and identification of the record stamped thereon to the persons entitled to them. The date of record is the date of the receipt of the assignment at the Office in proper form and accompanied by the full legal fee for recording specified in 35 U.S.C. 41(a)10.

→ The Patent and Trademark Office will accept and record legible certified copies of original assignments or other instruments.

The certified copy, if not in the English language, will not be recorded unless accompanied by a translation signed by the translator.

Certification shall be to the fact that the instrument submitted is a true copy of the original and shall be made by a notary public or, if in a foreign country, by a consular officer of the United States or an officer authorized to administer oaths and authenticated by a consular officer of the United States. Certification may also be made in the form of a declaration (rule 68).

303 Endorsing Assignments on Pending Applications [R–43]

The file wrapper of an application ordinarily does *not* display the endorsement of an assignment during the period an application is before an examiner.

The name of the assignee is endorsed on the file of an application only when it is submitted to the Assignment Division for a title report. ← Therefore, the file wrapper *cannot be relied upon* to accurately reflect the assignment status of an application while it is pending before an examiner.

Certified copies of patent applications as filed, do not include an indication of assignments. Applicants desiring an indication of assignments of record should request separately certified copies of assignment documents.

When the determination of the assignment condition of an application is significant, as in the factual situations represented by §§ 304 and 305, or when forwarding a form PO–850 to the Board of Patent Interferences, it is necessary to submit the application to the Assignment Division for a title report. ←

304 Conflicting Subject Matter in Two Applications of Same Inventor, One of Which Is Assigned [R–43]

Where applicant has pending two applications with overlapping subject matter claimed therein, and assigns one of the applications in its entirety, which assignment is duly recorded in the Patent and Trademark Office, the assigned application at once may become a reference against the second application for all common subject matter disclosed, irrespective of the dates of filing of the two applications, and also of any subsequent assignment of the second case to another assignee.

305 Different Inventors, Common Ownership [R–30]

Where there is a common assignee of two or more applications by different inventors involving conflicting subject matter see § 804.03. Note, that in order to reject on the grounds of double patenting the cases must have the same inventive entity. See § 804.

305.02 Claimed Subject Matter the Same or Not Patentably Different [R–27]

Where the applications by different inventors but of common ownership claim the same subject matter or subject matter that is not patentably different, questions of interference therebetween and with third parties are handled as indicated in §§ 804.03 and 1101.01(b).

306 Assignment of Division, Continuation, Substitute and Continuation-in-Part in Relation to Parent Case [R–36]

After the payment of the issue fee, a divisional, continuation, or substitute application is sent to the Assignment Division where the assignment of the original application is applied without charge to the later application, provided the date of the assignment of the original application was before the filing of the later application.

In the case of a continuation-in-part, a prior assignment of the original application is not applied to the continuation-in-part application because the assignment of the original application gives the assignee only the subject matter common to both applications. Continuation-in-part applications require separate assignments if they are to be issued to an assignee.

The heading of the printed patent includes all identifying parent data of continuation-in-part, continuation, divisional, substitute, and reissue applications. It should be noted, however, that inclusion of this information in the heading does not necessarily indicate that the claims are entitled to the benefit of the earlier filing date.

The Assignment Division has discontinued mailing notification in cases where there is a conflict in assignment between an original application and its divisional, continuation, substitute, or continuation-in-part application. Where there are conflicting assignments, the patent will normally issue to the applicant.

307 Issue to Assignee [R–43]

35 U.S.C. 152. Issue of patent to assignee. Patents may be granted to the assignee of the inventor of record in the Patent and Trademark Office, upon the application made and the specification sworn to by the inventor, except as otherwise provided in this title.

Rule 334. Issue of patent to assignee. In case of an assignment of the entire interest in the invention and application, or of the entire interest in the patent to be granted, the patent will normally issue to the assignee. If the assignee should hold an undivided part interest, the patent will normally issue jointly to the inventor and the assignee. If it is desired that the patent so issue the assignment in either case must first have been recorded, and at a day not later than the date payment is made of the issue fee or portion thereof specified in the notice of allowance. At the time of payment of the issue fee, a statement must be furnished indicating whether or not an assignment has been filed with the Patent and Trademark Office. In the event an assignment has been filed, such statement must include the name of the assignee and indicate whether or not an acknowledgment of a recorded assignment has been received from the Patent and Trademark Office.

For the patent to normally issue to an assignee, the assignment must be recorded in the Patent and Trademark Office at a date not later than the day on which the issue fee is paid.

Irrespective of whether the assignee participates in the prosecution of the application, the patent issues to him unless there are conflicting assignments.

308 Notice of Allowance Where Application Is Assigned [R–43]

The Issue Fee Transmittal Form portion (POL–85b) of the Notice of Allowance as revised in December 1969 and May 1973, provides a space (item 2) for assignment data which should be completed in order to comply with rule 334 (37 CFR 1.334)). Unless an assignee's name and address are identified in item 2 of the Issue Fee Transmittal Form POL–85b, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for correction of error arising from incomplete or erroneous information furnished in item 2 of POL–85b will not be granted as a matter of course and will be subject to adherence to all the requirements of rule 323 (37 CFR 1.323).

309 Restrictions Upon Employees of Patent Office [R–43]

35 U.S.C. 4. Restrictions on officers and employees as to interest in patents. Officers and employees of the Patent and Trademark Office shall be incapable, during the period of their appointments and for one year thereafter, of applying for a patent and of acquiring, directly or indirectly, except by inheritance or bequest, any patent or any right or interest in any patent, issued or to be issued by the Office. In patents applied for thereafter they shall not be entitled to any priority date earlier than one year after the termination of their appointment.

Chapter 400 Representative of Inventor or Owner

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401 Patent Office Cannot Aid in Selection of Attorney [R–24]

Rule 31. Applicants May Be Represented by an Attorney or Agent. An applicant for patent may file and prosecute his own case, or he may be represented by an attorney or agent authorized to practice before the Patent Office in patent cases. The Patent Office cannot aid in the selection of an attorney or agent.

If patentable subject matter appears to be disclosed in a pro se application and it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications, the examiner may suggest to the applicant that it may be desirable to employ a registered patent attorney or agent. The following language is suggested for incorporation in an Office action:

[1] "Since the value of a patent is largely dependent upon the skillful preparation of the specification and claims, applicant may consider it desirable to employ the services of a registered patent attorney or agent. The Patent Office cannot aid in the selection of an attorney or agent."

402 Power of Attorney [R–37]

Rule 34. Recognition for representation. (a) When a registered attorney or agent acting in a representative capacity appears in person or signs a paper in practice before the Patent Office in a patent case, his personal appearance or signature shall constitute a representation to the Patent Office that, under the provisions of these rules and the law, he is authorized to represent the particular party in whose behalf he acts. In filing such a paper, the attorney or agent should specify his registration number with his signature. Further proof of authority to act in a representative capacity may be required.

(b) When an attorney or agent shall have filed his power of attorney, or authorization, duly executed by the person or persons entitled to prosecute the application, he is a principal attorney of record in the case. A principal attorney or agent so appointed, may appoint an associate attorney or agent who shall also then be of record.

The Patent Office will continue to give effect to powers of attorney and authorizations of agent naming firms filed, with respect to patent applications, before the effective date of the rules, July 2, 1971 and in all divisions and continuations thereof not requiring execution by the applicant. Powers of attorney or authorizations of agent naming firms of attorneys or

agents filed in patent applications after July 2, 1971 will not be recognized. However, the Patent Office will construe any such powers or authorizations as a direction to consider the address of the firm as the correspondence address for the application.

The privilege afforded by rule 34(a) as to recognition of registered attorneys and agents not of record will apply to all applications whether filed before or after the effective date. Attention is called to the requirement of rule 34(a) that a paper filed by a registered patent attorney or agent in an application in which he is not of record should include both his signature and registration number.

Powers of attorney and authorizations of agent under rule 34(b) naming one or more registered individuals may continue to be made.

As prior to July 2, 1971, where a paper is hand delivered to the Office and that paper has been properly signed by a registered attorney or agent whether or not of record in the particular case involved, a duplicate copy may be appropriately marked by the Patent Office employee receiving the original and returned to the person delivering the paper. As an example, a duplicate copy of a request for an extension of time to make a response may be marked approved, initiated or signed, and returned to the delivering person.

Acceptance of papers filed in patent applications by registered attorneys and agents upon a representation that the attorney or agent is authorized to act in a representative capacity is for the purpose of facilitating responses on behalf of applicants in patent applications, and, further, to obviate the need for filing powers of attorney or authorization of agent in individual applications when there has been a change in composition of law firms or corporate patent staffs. Interviews with a registered attorney or agent not of record will, in view of 35 U.S.C. 122, be conducted only on the basis of information and files supplied by the attorney or agent.

Usually a power of attorney is made a part of the application oath or declaration, see § 601.02. In order that this power may be valid, the attorney or agent appointed must be registered.

When an application for patent is filed accompanied by a power of attorney or authorization of agent to a person not registered to practice before the United States Patent Office, the Application Division will send the official filing receipt directly to the applicant, together with an explanatory letter. A copy of the letter will be sent to the person named in the power of authorization and a copy placed in the file without being given a paper number. The name of the unregistered person will not be placed on the face of the file, and the examiner will communicate only with the applicant directly unless and until the applicant appoints a recognized practitioner. An associate power of attorney or authorization from the unregistered person will not be recognized or accepted.

Rule 346. Signature and certificate of attorney. Every paper filed by an attorney or agent representing an applicant or party to a proceeding in the Patent Office must bear the signature of such attorney or agent, except papers which are required to be signed by the applicant or party in person (such as the application itself and affidavits or declarations required of applicants). The signature of an attorney or agent to a paper filed by him, or the filing or presentation of any paper by him, constitutes a certificate that the paper has been read; that its filing is authorized; that to the best of his knowledge, information, and belief, there is good ground to support it; and that it is not interposed for delay.

See also § 1702.

402.01 Exceptions as to Registration [R–37]

Rule 342. Limited recognition. Any person not registered and not entitled to be recognized under rule 341 as an attorney or agent to represent applicants generally may, upon a showing of circumstances which render it necessary or justifiable, be recognized by the Commissioner to prosecute as attorney or agent a specified application or applications, but this limited recognition shall not extend further than the application or applications specified.

Sometimes in a joint application one of the coinventors gives to the other the power of attorney in the case. Such power will be recognized even though the one to whom it is given is not registered.

If a request for special recognition accompanies the application, the Application Division will forward the file to the Chairman of the Committee on Enrollment.

402.02 Appointment of Associate Attorney [R–37]

The principal attorney (either original or substitute) may appoint an associate attorney as provided in rule 34. The associate attorney may not appoint another attorney. See also § 406.

402.05 Revocation [R–29]

Rule 36. Revocation of power of attorney or authorization; withdrawal of attorney or agent. A power of

attorney or authorization of agent may be revoked at any stage in the proceedings of a case, and an attorney or agent may withdraw, upon application to and approval by the Commissioner. An attorney or agent, except an associate attorney or agent whose address is the same as that of the principal attorney or agent, will be notified of the revocation of his power of attorney or authorization and the applicant will be notified of the withdrawal of the attorney or agent. An assignment will not of itself operate as a revocation of a power or authorization previously given, but the assignee of the entire interest may revoke previous powers and be represented by an attorney or agent of his own selection.

Upon revocation of the power of attorney, appropriate notification is sent by the clerk of the examining group.

Revocation of the power of the principal attorney revokes powers granted by him to other attorneys.

Revocation of the power of attorney becomes effective on the date that the revocation is RECEIVED in the Office (in contradistinction to the date of ACCEPTANCE).

402.06 Attorney Withdraws [R–41]

See rule 36 in § 402.05.

In the event that a notice of withdrawal is filed by the attorney or attorneys of record, the file will be forwarded to the Office of the Solicitor where appropriate procedure will be followed pertaining to the withdrawal. The withdrawal is effective when approved rather than when received.

To expedite the handling of requests for permission to withdraw as attorney, under rule 36, the request should be submitted in triplicate (original and two copies) and indicate thereon the present mailing address of the attorney who is withdrawing. The examining group number should also appear on all such requests.

402.07 Assignee Can Revoke Power of Attorney of Applicant [R–37]

The assignee of record of the entire interest can revoke the power of attorney of the applicant unless an "irrevocable" right to prosecute the case had been given as in some government owned applications.

Rule 32. Prosecution by assignee. The assignee of record of the entire interest in an application for patent is entitled to conduct the prosecution of the application to the exclusion of the inventor.

See rule 36 in § 402.05.

A power of attorney by the assignee of the whole interest, if the assignment is recorded in the Office, revokes all powers given by applicant and prior assignees.

402.08 Application in Interference [R–21]

While an application is involved in interference, no power of attorney of any kind should be entered in such application by the clerk of the group.

If a power of attorney or revocation is received for an application while in interference, it should be forwarded to the Interference Service Branch because all parties to the interference must be notified.

403 Correspondence—With Whom Held [R–37]

Rule 33. Correspondence respecting patent applications and proceedings. (a) The residence and post office address of the applicant must appear in the oath or declaration if not stated elsewhere in the application. The applicant may also specify and an attorney or agent of record may specify a correspondence address to which communications about the application are to be directed. All notices, official letters, and other communications in the case will be directed to the correspondence address or, if no such correspondence address is specified, to an attorney or agent of record (see rule 34(b)), or, if no attorney or agent is of record, to the applicant, or to any assignee of record of the entire interest if the applicant or such assignee so requests, or to an assignee of an undivided part if the applicant so requests, at the post office address of which the Office has been notified in the case. Amendments and other papers filed in the application must be signed: (1) By the applicant, or (2) if there is an assignee of record of an undivided part interest, by the applicant and such assignee, or (3) if there is an assignee of record of the entire interest, by such assignee, or (4) by an attorney or agent of record, or (5) by a registered attorney or agent not of record who acts in a representative capacity under the provisions of rule 34 (a). Double correspondence with an applicant and his attorney or agent, or with more than one attorney or agent, will not be undertaken. If more than one attorney or agent be made of record and a correspondence address has not been specified, correspondence will be held with the one last made of record.

(b) An applicant who has not made of record a registered attorney or agent may be required to state whether he received assistance in the preparation or prosecution of his application, for which any compensation or consideration was given or charged, and if so, to disclose the name or names of the person or persons providing such assistance. This includes the preparation for the applicant of the specification and amendments or other papers to be filed in the Patent Office, as well as other assistance in such matters, but does not include merely making drawings by draftsmen or stenographic services in typing papers.

Rule 33(a) provides for an applicant to supply an address to receive correspondence from the Patent Office concerning his application, in addition to his residence address, so that the Patent Office may direct mail to any address of applicant's selection, such as a corporate patent department, a firm of attorneys or agents, or an individual attorney, agent, or other person.

Rule 33 states that when an attorney has been duly appointed to prosecute an application correspondence will be held with the attorney. Double correspondence with an applicant and his attorney, or with two representatives, will not be undertaken. See §§ 403.01, 403.02 and 714.01(d).

In a joint application with no attorney, the applicant whose name first appears in the papers receives the correspondence, unless other instructions are given. All applicants must sign the responses. See § 714.01(a).

Powers of attorney to firms filed in executed applications filed after July 2, 1972 are not recognized by the Patent Office. However, the firm's address will be considered to be the correspondence address. The address should appear as follows:

John Doe (inventor)
In care of Able, Baker and Charlie (firm)
1234 Jefferson Davis Highway
Arlington, Virginia 22202

403.01 Correspondence Held With Associate Attorney

Where the attorneys bear relation of principal attorney and associate attorney, the correspondence will be had with the associate attorney unless the principal attorney directs otherwise. Ex parte Eggan, 1911 C.D. 213; 172 O.G. 1091.

403.02 Two Attorneys for Same Applications [R–24]

If applicant simultaneously appoints two principal attorneys he should indicate with which correspondence is to be conducted. If one is a local Washington Metropolitan area attorney and applicant fails to indicate either attorney, correspondence will be conducted with the local attorney.

If, after one attorney is appointed, a second attorney is later appointed without revocation of the power of the first attorney, the name of the second attorney is entered on the face of the file (Ex parte Eggan, 1911 C.D. 213; 172 O.G. 1091), with notation that the Office letters are to be sent to him. This applies also to associate attorneys.

404 Conflicting Parties Having Same Attorney [R–24]

See rule 208 in § 1101.01(k).

405 Attorney Not of Record [R–30]

Papers may be filed in patent applications by registered attorneys or agents not of record under rule 34(a). Filing of such papers is considered to be a representation that the attorney or agent is authorized to act in a representative capacity on behalf of applicant. However, interviews with a registered attorney or agent not of record will be conducted only on the basis of information and files supplied by the attorney or agent in view of 35 U.S.C. 122.

406 Death of Attorney [R–41]

Sole Attorney

If notification is received from the applicant or assignee of the death of the sole principal attorney and the application is up for action by the examiner, correspondence is held with the applicant or assignee who originally appointed the deceased attorney.

If notification is received from the office of the deceased attorney and the application is up for action, the examiner when preparing the Office action should add a paragraph such as:

[1] "In view of the notification of the death of the attorney of record, his power is terminated. Applicant (*or assignee if he originally appointed the deceased attorney*) may appoint a new attorney."

If notification of the death of the sole principal attorney is received from the Attorney's Roster or some outside source, there will be no paper of record in the file wrapper to indicate that the attorney is decreased. Correspondence therefore continues to be held with the office of the deceased attorney but a copy of the Office action is also mailed to the person who originally appointed the attorney. In such an Office action where the application is not ready for allowance the examiner should add a paragraph similar to the following:

[2] "Notice of the death of the attorney of record has come to the attention of this Office. Since his power of attorney is terminated, a copy of this action is being mailed to applicant (or assignee if he originally appointed the deceased attorney). Applicant (or assignee) may appoint a new attorney.

If notification of the death of the sole principal attorney is received from the Attorney's Roster or some outside source and the ap-

plication is ready for allowance, the examiner prepares the application for allowance and writes a letter to the office of the deceased attorney with a copy to the person who originally appointed the deceased attorney stating:

[3] "Notice of the death of the attorney of record has come to the attention of this Office. Since his power of attorney is thus terminated, and this application is now ready for allowance, the Notice of Allowance will be mailed to the office of the deceased attorney in the absence of a new power of attorney."

Note § 405.

407 Disbarred Attorney [R–24]

See § 105.

408 Telephoning Attorney [R–37]

Present Office policy places great emphasis on telephone interviews initiated by the examiner. For this reason, it is not necessary for an attorney to request a telephone interview. Examiners are not required to note or acknowledge requests for telephone calls or state reasons why such proposed telephone interviews would not be considered effective to advance prosecution. However, it is desirable for an attorney to call the examiner if the attorney feels the call will be beneficial to advance prosecution of the case. See §§ 713.01 and 713.05.

SPECIFIC TELEPHONE INTERVIEW SITUATIONS

Restriction of invention (§ 812.01).
Multiplicity (§ 706.03(l)).

Many attorneys have offices or representatives in the Washington area and it sometimes expedites business to interview them concerning an application. When the examiner believes the progress of the application would be advanced thereby, he may call the attorney in the case by telephone and ask him to come to the Office. Listings of Washington representatives of out-of-town attorneys are kept in each examining group.

Registered attorneys or agents not of record in a patent application and acting in a representative capacity under rule 34(a) should not be telephoned for restriction requirements, approval of examiner's amendments or given any information relative to such patent application by telephone unless the telephone number of such attorney or agent appears in a paper signed by applicant or an attorney or agent of record.

Examiners should place all long distance telephone calls through the FTS (Federal Telecommunications System), even though collect calls may have been authorized by the attorney.

To facilitate any telephone calls that may become necessary, it is strongly recommended that amendments, letters of transmittal and powers of attorney include the complete telephone number, with area code and extension, of the person with whom the interview should be held, preferably near the signature.

In new applications, the telephone number may appear on the letter of transmittal or in the power of attorney, oath or declaration, next to the attorney's name and address.

409 Death, Insanity, or Unavailability of Inventor [R–37]

If the inventor is dead, insane or otherwise legally incapacitated, refuses to execute an application, or cannot be found, an application may be made by someone other than the inventor, as specified in rules 42–47, §§ 409.01–409.03j.

409.01 Death of Inventor [R–30]

Unless a power of attorney is coupled with an interest (i.e., an attorney is assignee or part-assignee), the death of the inventor (or one of the joint inventors) terminates the power of attorney and a new power from the heirs, administrators, executors or assigns is necessary if the attorney is to remain of record (but see § 409.01 (f)).

409.01(a) Prosecution by Administrator or Executor [R–24]

35 U.S.C. 117 Death or incapacity of inventor

Legal representatives of deceased inventors and of those under legal incapacity may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor.

Rule 42. When the inventor is dead. In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may sign the application papers and make the necessary oath or declaration, and apply for and obtain the patent. Where the inventor dies during the time intervening between the filing of his application and the granting of a patent thereon, the letters patent may be issued to the legal representative upon proper intervention by him.

One who has reason to believe that he will be appointed legal representative of a deceased inventor may apply for a patent as legal representative in accordance with rule 42. Such

application will be considered as having been made on the date of receipt of all its required parts, or of the part which renders it complete (rules 51 and 53), provided proof of applicant's authority as legal representative is subsequently filed. The filing date corresponding to said date of receipt will be canceled if another person is appointed legal representative. In the latter case, the application will be given an application date no earlier than the date on which the properly appointed legal representative actually executed the papers. The foregoing applies to the legal representative of a deceased sole or deceased joint inventor.

Application may be made by the heirs of the inventor, as such, if accompanied by a certificate from the court that they are all the heirs and that the estate was under the sum required by state law for the appointment of an administrator.

409.01(b) Proof of Authority of Administrator or Executor [R–37]

Rule 44. Proof of authority. In the cases mentioned in rules 42 and 43, proof of the power or authority of the legal representative must be recorded in the Patent Office or filed in the application before the grant of a patent.

Whenever because of the death of an inventor, the right of applying for and obtaining a patent for an invention devolves upon an executor or administrator, or whenever an executor or administrator desires to intervene prior to the granting of a patent, proof of the authority of such executor or administrator should in all cases be made of record in the Patent Office by filing in the application or recording in the assignment records a certificate of the clerk of a competent court or the register of wills that his appointment is still in full force and effect. Such certificate shall be signed by an officer and authenticated by the seal of the court by which the same was issued. The authority of other legal representatives of the inventor must be similarly established.

Should such certificate of appointment be found to be insufficient for any reason, there may be required to be filed or recorded a certified and properly authenticated copy of the letters testamentary or of the letters of administration, in order that the scope of authority of the persons who seek to intervene may be a matter of record in this Office.

All applications filed by an executor or administrator are initially referred to the Assignment Division to ascertain whether proper authority has been recorded or "filed in the application" (rule 44) and for suitable endorsement on the file. If the authority is insufficient, correspondence is conducted by the Assignment Division. When a reply is received to such correspondence and also in cases where the executor or administrator intervenes (after filing) the case should be sent immediately to the Assignment Division.

In any case in which the Chief of the Assignment Division reports that the authority of the executor or administrator of record in the case is insufficient, the examiner will require the filing in the application or the recording in the Assignment Division of a certificate of such appointment or a certified copy of letters testamentary or of letters of administration in such case before finally passing the case to issue.

In the case of foreign executors or administrators, a consular officer of the United States may authenticate the signature of the foreign officer attesting to the papers submitted as proof of authority. Unusual situations may be referred to the Office of the Solicitor.

409.01(c) After Administrator or Executor Has Been Discharged [R–21]

When an administrator or executor has performed his functions and has been discharged and it is desired to make an application for an invention of the deceased, it is necessary for the administrator or executor to take out new letters of administration in order that he may file a new application of the deceased inventor.

409.01(d) Exception in Some Foreign Countries [R–21]

The terms "Executor" and "Administrator" do not find an exact counterpart in all foreign countries and the procedure is governed by the necessity of construing those terms to fit the circumstances of the case. Hence the person or persons having authority corresponding to that of executor or administrator are permitted to make application as, for example, the heirs in Germany. The authority of such persons must be proved by an appropriate certificate.

409.01(e) If Applicant of Assigned Application Dies

Where an applicant, carrying on the prosecution of an application after assignment, dies, his administrator may carry on the prosecution on filing letters of administration unless and until the assignee intervenes.

409.01(f) Intervention of Executor Not Compulsory [R–30]

When an inventor dies after filing an application the executor or administrator should intervene, but the allowance of the application will not be withheld nor the application withdrawn from issue if the executor or administrator does not intervene.

This practice is applicable to an application which has been placed in condition for allowance or passed to issue prior to notification of the death of the inventor. See § 409.01.

409.02 Insanity or Other Legal Incapacity [R–21]

Rule 43. When the inventor is insane or legally incapacitated. In case an inventor is insane or otherwise legally incapacitated, the legal representative (guardian, conservator, etc.) of such inventor may sign the application papers and make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(b) is also applicable in case of insanity or other legal incapacity of an inventor.

409.03 Unavailability of Inventor [R–37]

Rule 47. Filing by other than inventor. (a) If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. Such application must be accompanied by proof of the pertinent facts and must state the last known address of the omitted inventor. The Patent Office shall forward notice of the filing of the application to the omitted inventor at said address. Should such notice be returned to the Office undelivered, or should the address of the omitted inventor be unknown, notice of the filing of the application shall be published in the Official Gazette. The omitted inventor may subsequently join in the application on filing an oath or declaration of the character required by rule 65. A patent may be granted to the inventor making the application, upon a showing satisfactory to the Commissioner, subject to the same rights which the omitted inventor would have had if he had been joined.

(b) Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action may make application for patent on behalf of and as agent for the inventor. Such application must be accompanied by proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage, and must state the last known address of the inventor. The assignment, written agreement to assign or other evidence of proprietary interest, or a verified copy thereof, must be filed in the Patent Office. The Office shall forward notice of the filing of the application to the inventor at the address stated in the application. Should such notice be returned to the Office undelivered, or should the address of the inventor be unknown, notice of the filing of the application shall be published in the Official Gazette. The inventor may subsequently join in the application on filing an oath or declaration of the character required by rule 65. A patent may be granted to the inventor upon a showing satisfactory to the Commissioner.

35 U.S.C. 116. Joint inventors

When an invention is made by two or more persons jointly, they shall apply for patent jointly and each sign the application and make the required oath, except as otherwise provided in this title.

If a joint inventor refuses to join in an application for patent or cannot be found or reached after diligent effort, the application may be made by the other inventor on behalf of himself and the omitted inventor. The Commissioner, on proof of the pertinent facts and after such notice to the omitted inventor as he prescribes, may grant a patent to the inventor making the application, subject to the same rights which the omitted inventor would have had if he had been joined. The omitted inventor may subsequently join in the application.

Whenever a person is joined in an application for patent as joint inventor through error, or a joint inventor is not included in an application through error, and such error arose without any deceptive intention on his part, the Commissioner may permit the application to be amended accordingly, under such terms as he prescribes.

35 U.S.C. 118. Filing by other than inventor

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Commissioner may grant a patent to such inventor upon such notice to him as the Commissioner deems sufficient, and on compliance with such regulations as he prescribes.

Application papers submitted pursuant to rule 47 are forwarded by the Application Division to the Office of the Solicitor for determination whether the papers are proper, complete, and acceptable under rule 47.

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A *bona fide* attempt must be made to comply with the provisions of rule 47 at the time application papers are first submitted. If the application papers, and evidence submitted with the application papers, are not found acceptable, the rule 47 applicant will be notified by the Office of the Solicitor of the reasons why the papers are not acceptable. The rule 47 applicant may request reconsideration and file supplemental evidence in a case where a *bona fide* attempt was made to comply with rule 47 from the outset.

409.03(a) At Least One Joint Inventor Available [R–37]

Rule 47(a) and 35 U.S.C. 116, second paragraph, permit a joint inventor to file an application "on behalf of" himself and a joint inventor who "cannot be found or reached after diligent effort" or who refuses to sign application papers. The person making application pursuant to rule 47(a) is referred to as a "rule 47(a) applicant."

In addition to other requirements of law (35 U.S.C. §§ 111, 115), an application deposited in the Patent Office pursuant to rule 47(a) must meet the following requirements:

(1) The rule 47(a) applicant must (i) make oath on his own behalf as required by rule 65(a) or rule 175 (see §§ 602, 605.01, and 1401.08) and (ii) make oath on behalf of the omitted joint inventor as required by rule 65(b).

(2) The application must be accompanied by proof that the omitted inventor (i) cannot be found or reached after diligent effort or (ii) refuses to execute the application papers. See § 409.03(d).

(3) The last known address of the omitted joint inventor must be stated. See § 409.03(e).

409.03(b) No Inventor Available [R–37]

Rule 47(b) and 35 U.S.C. 118 allow a "person" with a demonstrated proprietary interest to make application "on behalf of and as agent for" an inventor who "cannot be found or reached after diligent effort" or who refuses to sign application papers. The word "person" has been construed by the Patent Office to include juristic entities, such as a corporation. The person making application pursuant to rule 47(b) is referred to as a "rule 47(b) applicant."

In addition to other requirements of law (35 U.S.C. §§ 111 and 115), an application deposited pursuant to rule 47(b) must meet the following requirements:

(1) The rule 47(b) applicant must make the oath required by rule 65(b) or 175. Where a corporation is the rule 47(b) applicant, an officer thereof should normally make the necessary oath or declaration and sign the application. A corporation may authorize any person, including an attorney or agent registered to practice before the Patent Office, to sign the application papers on its behalf. Where application papers are signed by a registered attorney or agent on behalf of a corporation, proof of the attorney's or agent's authority must be submitted. An inventor may not authorize another individual to act as his agent to sign application papers on his behalf.

(2) The rule 47(b) applicant must state his relationship to the inventor as required by rule 65(b).

(3) The application must be accompanied by proof that the inventor (i) cannot be found or reached after a diligent effort or (ii) refuses to execute the application papers. See § 409.03(d).

(4) The last known address of the inventor must be stated. See § 409.03(e).

(5) The rule 47(b) applicant must make out a *prima facie* case (i) that the invention has been assigned to him or (ii) that the inventor has agreed in writing to assign the invention to him or (iii) otherwise demonstrate a proprietary interest in the subject matter of the application. See § 409.03(f).

(6) The rule 47(b) applicant must prove that the filing of the application is necessary (i) to preserve the rights of the parties or (ii) to prevent irreparable damage. See 409.03.(g).

409.03(c) Legal Representatives of Deceased Inventor Not Available [R–37]

Rule 47 should not be considered an alternative to rule 42 or 35 U.S.C. 117, since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r. Pat. 1955). See rule 42 and § 409.01. However, rule 47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see § 409.03(e)), and proof of the power or authority of the legal representative must be established before the grant of a patent, rule 44. Also, in hardship situations where time or circumstances do not permit appointment of a legal representative to make application, rule 47 may apply. In re Schwarz, 147 USPQ 394

(Comm'r. Pat. 1960). In such situations, however, subsequent joinder of a properly authorized legal representative will normally be required before the grant of a patent.

409.03(d) Proof of Unavailability or Refusal [R–37]

Where inability to find or reach an omitted inventor "after diligent effort" is the reason for filing under rule 47, an affidavit or declaration should be submitted which fully describes the exact facts which are relied upon to establish that a diligent effort was made. The diligent effort must have been made before the application is deposited in the Patent Office.

The affidavit or declaration must be signed, where at all possible, by a person having first-hand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as letters, telegrams, etc., which support a finding that an omitted inventor could not be found or reached should be made part of the affidavit or declaration. It is important that the affidavit or declaration contain statements of fact as opposed to conclusions.

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of this refusal must be specified in an affidavit or declaration by the person to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Before a refusal can be alleged, it must be demonstrated that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the omitted inventor for signature.

When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the affidavit or declaration. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the affidavit or declaration.

When it is concluded by the rule 47 applicant that an omitted inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence should be submitted.

Whenever an omitted inventor gives a reason for refusing to sign application papers, that reason should be stated in the affidavit or declaration.

409.03(e) Statement of Last Known Address [R–37]

An application filed pursuant to rule 47 must state the last known address of the omitted inventor. That address should be the last known address at which the inventor customarily receives his mail. See § 605.03. Ordinarily, the last known address will be the last known residence of the omitted inventor.

Inasmuch as an omitted inventor is notified that an application pursuant to rule 47 has been filed on his behalf, other addresses at which the omitted inventor may be reached should also be given.

409.03(f) Proof of Proprietary Interest [R–37]

When an application is deposited pursuant to rule 47(b), the rule 47(b) applicant must prove, that, as of the date the application is deposited in the Patent Office, (1) the invention has been assigned to him or (2) the inventor has agreed in writing to assign the invention to him or (3) he otherwise has sufficient proprietary interest in the subject matter to justify the filing of the application.

If the application has been assigned, a copy of the assignment (in the English language) must be submitted. The assignment must clearly indicate that the invention described in the rule 47(b) application was assigned to the rule 47(b) applicant prior to the date the application is deposited in the Patent Office. An assignment of an application and any "reissue, division, or continuation of said application" does not itself establish an assignment of a continuation-in-part application. In re Gray, 115 USPQ 80 (Comm'r. Pat. 1956). An assignment to a rule 47(b) applicant for the sole purpose of obtaining a filing date for a rule 47(b) application is not considered an assignment within the meaning of 35 U.S.C. 118 and rule 47(b).

When an inventor has agreed in writing to assign an invention described in an application deposited pursuant to rule 47(b), a copy of that agreement should be submitted. If an agreement to assign is dependent on certain specified conditions being met, it must be established by affidavit or declaration that those conditions have been met. A typical agreement to assign is an employment agreement where an employee (omitted inventor) agrees to assign to his employer (rule 47(b) applicant) all inventions made during employment. When such an agreement is relied upon, it must be established by the affidavit or declaration of a person having first-hand knowledge of the facts that the in-

vention was made by the employee while he was employed by the rule 47(b) applicant.

If the invention has not been assigned, or if there is no written agreement to assign, the rule 47(b) applicant must demonstrate that he otherwise has a sufficient proprietary interest in the matter.

A proprietary interest obtained otherwise than by assignment or agreement to assign may be demonstrated by an appropriate legal memorandum to the effect that a court of competent jurisdiction (federal, state, or foreign) would by the weight of authority in that jurisdiction award title of the invention to the rule 47(b) applicant. The facts in support of any conclusion that a court would award title to the rule 47(b) applicant should be made of record by way of an affidavit or declaration of the person having first-hand knowledge of same. The legal memorandum should be prepared and signed by an attorney at law familiar with the law of the jurisdiction involved. A copy (in the English language) of a statute (other than the United States statute) or a court decision (other than a decision of a federal court or a decision reported in the United States Patents Quarterly) relied upon to demonstrate a proprietary interest should be made of record.

409.03(g) Proof of Irreparable Damage [R–37]

Irreparable damage may be established by showing that a filing date is necessary to (1) avoid an imminent statutory bar (35 U.S.C. 102) or (2) make a claim for priority (35 U.S.C. 119, 120, and 121). If a statutory bar is involved, the act or publication which is believed to constitute the bar should be identified. If a claim for priority is involved, the prior application or applications should be identified.

Preservation of the rights of the parties may be demonstrated by a showing that the inventor may reasonably be expected to enter into competition with the rule 47(b) applicant, or that a firm plan for commercialization of the subject matter of the application has been adopted.

409.03(h) Acceptance of a Rule 47 Application [R–37]

A filing date is not assigned to an application deposited pursuant to rule 47 until the application is found acceptable by the Office of the Solicitor.

When papers deposited pursuant to rule 47 are found acceptable, the Office of the Solicitor enters a memorandum or letter to that effect in the file, the Application Division, is authorized to assign the application a filing date, and notice is normally sent to the omitted inventor (inventor designee) at his last known address. If such a notice is returned to the Patent Office by the United States Postal Service as being undeliverable, and the application is thereafter determined to be allowable by the examiner, a notice will be published in the Official Gazette.

409.03(i) Rights of the Omitted Inventor [R–37]

The omitted inventor (also referred to as an "inventor designee") may protest his designation as an inventor. The omitted inventor is entitled to inspect the application, order copies of all or any part thereof (at a prepaid cost of 30 cents per page) and make his position of record in the file wrapper of the application. Alternatively, the omitted inventor may arrange to do any of the preceding through a registered patent attorney or agent.

While the Patent Office will grant the omitted inventor access to the application, inter partes proceedings will not be instituted in a rule 47 case, In re Hough, 108 USPQ 89 (Comm'r. Pat. 1955). An omitted inventor is not entitled to a hearing (Cogar v. Schuyler, 173 USPQ 389 (D.C. Cir. 1972)) and is not entitled to prosecute the application.

An omitted inventor may join in a rule 47 application. To join in the application, the omitted inventor should ordinarily file an appropriate rule 65(a) oath or declaration attached to a copy of the application as originally filed.

The rights of an omitted inventor are protected by the fact that in an application filed under rule 47(b) and 35 U.S.C. 118 the patent must issue to the inventor, and in an application filed under rule 47(a) and 35 U.S.C. 116, the inventor has the same rights that he would have if he had joined in the application, In re Hough, 108 USPQ 89 (Comm'r. Pat. 1955).

If an omitted inventor feels that he is the sole inventor of an invention claimed in a rule 47 application naming him as a joint inventor, the omitted inventor may file his own application and request that his application be placed in interference with the rule 47 application. If the claims in both the omitted inventor's application and the rule 47 application are otherwise found allowable, an interference may be declared.

409.03(j) Action Following Acceptance of a Rule 47 Application [R–37]

After an application deposited pursuant to rule 47 is found acceptable by the Office of the

Solicitor, the examiner will act on the application in the usual manner, except that papers filed by an inventor who did not originally join in the application, and papers relating to its rule 47 status, will be forwarded with the file wrapper to the Office of the Solicitor for consideration.

In the event joinder papers are filed, the Office of the Solicitor will determine whether such papers meet the requirements of rule 65, including the requirement implicit in that rule that the oath or declaration be made on the basis of actual knowledge of the application papers on file. This knowledge may be demonstrated by reference in the oath or declaration to an attached copy of the application, In re Bernard, 123 USPQ 387 (Comm'r Pat. 1959).

When the examiner determines that a rule 47 case is allowable, he should forward the file wrapper with a brief memorandum of that fact to the Office of the Solicitor. The rule 47 aspects of the case will then be reviewed. If it appears that the originally non-signing inventor has joined in the application, or has received notice and not replied in any way, the file wrapper is generally returned to the examiner for allowance without further rule 47 correspondence. On the other hand, if the inventor designee has shown some interest in the case short of proper joinder, he may be notified of imminent allowance and given a further opportunity to take any action he deems appropriate. Where there has been no proper joinder, a patent on a rule 47(b) application must be granted to the inventor, notwithstanding any recorded assignment by the inventor, In re Schuyler, 119 USPQ 97 (Comm'r Pat. 1957). Hence, it is generally advisable for an assignee to effect the inventor's proper joinder as soon as practicable. In many instances where the omitted inventor is temporarily unavailable, his joinder papers are best submitted as soon as possible, preferably before the rule 47 application is formally accepted. Such joinder papers should be filed with a brief explanatory letter, requesting that they be incorporated with the earlier rule 47 application papers. The later submission of joinder papers is not prejudicial to an earlier filing date under rule 47 if acceptance of the application under that rule would otherwise be warranted. The fact that the application was made under rule 47 will be indicated on the patent unless a proper joinder has been made.

Chapter 500 Receipt and Handling of Mail and Papers

501 Papers Received by Correspondence and Mail Division
502 Depositing Papers
503 Serial Number and Filing Receipt
504 Register of Applications
505 "Office Date" Stamp of Receipt
506 Completeness of Original Application
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507 Drafting Division
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501 Papers Received by Correspondence and Mail Division [R–35]

Rule 1. *All communications to be addressed to the Commissioner of Patents.* All letters and other communications intended for the Patent Office must be addressed to "Commissioner of Patents," Washington, D.C. 20231. When appropriate, a letter may be marked for the attention of a particular officer or individual.

The official mailing address for all communications sent to the Patent Office remains:

Commissioner of Patents
Washington, D.C. 20231

The physical location of the Office is 2021 Jefferson Davis Highway, Arlington, Virginia. This address should not be used on mail sent to the Patent Office.

All mailed communications are received by the Incoming-Mail Section of the Correspondence and Mail Division, which opens and distributes all official mail.

502 Depositing Papers [R–35]

Rule 5. *Identification of application, patent or registration.* (a) When a letter concerns an application for patent, it should state the name of the applicant, the title of the invention, the serial number of the application, the date of filing the same, and, if known, the group art unit and name of the examiner to which it has been assigned (see rule 55).

(b) When the letter concerns a patent, it should state the number and date of issue of the patent, the name of the patentee, and the title of the invention.

(c) A letter relating to a trademark application should identify it as such and by the name of the applicant and the serial number and filing date of the application. A letter relating to a registered trademark should identify it by the name of the registrant and by the number and date of the certificate.

Rule 6. *Receipt of letters and papers.* (a) Letters and other papers received in the Patent Office are stamped with the date of receipt. No papers are received in the Patent Office on Saturdays, Sundays or holidays within the District of Columbia.

(b) Mail placed in the Patent Office pouch up to midnight on weekdays, excepting Saturdays and holidays, by the post office at Washington, D.C., serving the Patent Office, is considered as having been received in the Patent Office on the day it was so placed in the pouch.

(c) In addition to being mailed or delivered by hand during office hours, letters and other papers may be deposited up to midnight in a box provided at the guard's desk at the lobby of building 3 of the Patent Office at Crystal Plaza, Arlington, Virginia and at the main entrance of the Department of Commerce building, Washington, D.C., on weekdays except Saturdays and holidays, and all papers deposited therein are considered as received in the Patent Office on the day of deposit.

Applications, amendments and other papers may be sent to the Patent Office by mail, or they may be deposited in the Correspondence and Mail Division or in a box which is kept in the lobby of building 3 of the Patent Office for this purpose.

The Patent Office ZIP Code designation "20231" should be used when writing the Patent Office for any matter. In addition, the sender's own ZIP Code designation should be given.

The Office often experiences difficulty in matching incoming papers with the application file to which they pertain because insufficient or erroneous information is given. This applies especially to amendments, powers of attorney, changes of address, status letters, requests for extension of time, and petitions.

Frequently, there are errors in the serial number or in the group art unit number, or the

incoming paper uses the old group art unit number where an application has been transferred and acted on by a different examining group.

Where the group art unit number is entirely omitted, the routine operations of the Application Division must be interrupted solely for the purpose of determining the location of the application so that the communication can be properly routed. Under these circumstances the efficiency of the Application Division is impaired and the incoming paper is delayed in reaching its proper destination. Where such papers are not essential to compliance with a statutory period or time limit for response, they may be returned for completion to identify the location of the files.

It would be of great assistance to the Office if *all* incoming papers pertaining to a filed application carried the following items:

1. Serial number (checked for accuracy).
2. Group art unit number (copied from filing receipt or most recent Office Action).
3. Filing date.
4. Name of the examiner who prepared the most recent Office Action.
5. Title of invention.

To further reduce the burden on the Application Division and the examining groups, it is also requested that the submission of additional or supplemental papers on a newly filed application be deferred until a filing receipt has been received. In the same vein, it would be appreciated if the filing of additional papers relating to an allowed application were deferred until a notice of allowance (POL–85) is received.

If the above suggestions are adopted the processing of both new and allowed applications could proceed more efficiently and promptly through the Patent Office.

Hand Delivery of Papers

Any paper which relates to a pending application may be personally delivered to an Examining Group. However, the Examining Group will accept the paper only if: (1) the paper is accompanied by some form of receipt which can be handed back to the person delivering the paper; and (2) the Examining Group being asked to receive the paper is responsible for acting on the paper.

The receipt may take the form of a duplicate copy of such paper or a card identifying the paper. The identifying data on the card should be so complete as to leave no uncertainty as to the paper filed. For example, the card should contain the applicant's name(s), Serial No., the filing date and a description of the paper being filed. If more than one paper is being filed for the same application, the card should contain a description of each paper or item.

Under this procedure, the paper and receipt will be date stamped with the Group date stamp. The receipt will be handed back to the person hand delivering the paper. The paper will be correlated with the application and made an official paper in the file, thereby avoiding the necessity of processing and forwarding the paper to the Examining Group via the Mail Room.

The Examining Group will accept and date stamp a paper even though the paper is accompanied by a check or the paper contains an authorization to charge a Deposit Account. However, in such an instance, the paper will be hand carried by Group personnel to the Office of Finance for processing and then made an official paper in the file.

All such papers, together with the cash, checks, or money orders, shall be hand carried to the Cashier's Window, Room 2–1BO1, between the hours of 3:00 p.m. and 4:00 p.m.

The papers shall be processed by the accounting clerk, Office of Finance, for pickup at the Cashier's Window by 3:00 p.m. the following work day. Upon return to the group, the papers will be entered in the application file wrappers.

A duplicate copy of officially date-stamped papers may be hand delivered. See §§ 104, 710.02(e) and 713.01.

503 Serial Number and Filing Receipt [R–35]

Serial Numbers are assigned in the Correspondence and Mail Division immediately after mail has been opened.

With the implementation of this new procedure, it is no longer necessary to submit two self-addressed post cards when early notification of the serial number is desired. If a self-addressed post card is submitted with a patent application, that post card will be stamped with both the receipt date and serial number prior to returning it to the addressee.

The identifying data on the post card should include: (1) applicant's name(s); (2) title of invention; (3) number of pages of specification, claims, and sheets of drawing; (4) whether oath or declaration used; and (5) amount and manner of paying the fee.

A return post card should be attached to *each* patent application for which a receipt is desired.

It should be recognized that the identification of an application by Serial Number does not necessarily signify that the Patent Office has accepted the application as complete. After the application has been reviewed for statutory com-

pliance and given an official filing date, the usual filing receipt will be mailed.

In the Application Division each application which meets the formal requirements as to completeness is given a filing date. It is important, when referring to application files, to identify them by their filing dates as well as by serial numbers.

The Application Division mails a receipt to the attorney or agent, if any, otherwise to the applicant, for each complete application filed, giving the serial number, filing date, and group to which assigned. See § 506.

In the Application Division the application papers are placed in a file wrapper and certain data placed thereon.

Return Post Card

If a receipt of any paper filed in the Patent Office is desired, it may be obtained by enclosing with the paper a self-addressed post card identifying the paper. The Patent Office will stamp the receipt date on the card and place it in the outgoing mail.

The identifying data on the card should be so complete as to match the paper with the application or other document to which it is to be associated. For example, the document should be identified by the applicant's name(s), serial number, filing date, interference number, etc., and the paper should be identified by specifying the type thereof, namely, affidavit, amendment, appeal, application papers, brief, drawings, fees, motions, supplemental oath or declaration, petition, etc.

When papers for more than one document are filed under a single cover a return addressed post card should be attached to the paper for *each* document for which a receipt is desired. [R–42]

504 Register of Applications [R–35]

The Application Division assigns the application to the examining group to which it appears to belong. A list of all applications arranged by serial numbers as well as an alphabetically arranged card index of the applicants is kept by the Application Division and the identification of the group to which each application is sent is made part of this record.

505 "Office Date" Stamp of Receipt [R–35]

In whatever manner an application or any part thereof, or an amendment, letter, or other paper is transmitted, the date of its receipt is stamped thereon by either the Correspondence and Mail Division or examining group. The stamp is referred to as the "Office Date" stamp and, if the application is complete (See rule 55), establishes the "filing date."

506 Completeness of Original Application [R–42]

Incomplete Applications

If the application papers are too informal to be given a filing date, the case is held in the Application Division as an *incomplete* application and the applicant, is informed of the shortcomings of the papers. No filing date is granted until the incompleteness is corrected.

Form PO–1123 (rev. 1–73), Notice of Incomplete Application Papers, is prepared and mailed by the Application Division when application papers are deemed incomplete under 35 U.S.C. 111.

Such informality may consist of the omission of any one of the component parts of an application. The component parts of an application are;

1. A declaration or oath, 35 U.S.C. 111.
2. A specification, 35 U.S.C. 112.
3. A claim, 35 U.S.C. 112.
4. A drawing, 35 U.S.C. 113.
5. Basic statutory filing fee of $65.

In the past the Application Division has reviewed the claimed subject matter of newly filed applications to determine whether a filing date should be granted. Such applications included those drawn to perpetual motion devices and methods of doing business and applications for reissue signed by assignees or filed more than two years after the grant of the patent which appear to contain broadened reissue claims.

Under the current practice, a filing date is normally granted in such cases if the application is otherwise complete, and then forwarded to the examiner for his consideration and decision during the regular course of examination.

Informal Applications

An application is *informal* if it is typed on both sides of the paper, or is not permanent, legible or reproducible. If such informalities are timely corrected, the application is given the filing date on which the original informal papers were filed.

Form PO–1094 (rev. 3–71), Notice of Insufficient Fee and/or Informal Drawings, is used when utility patent applications are filed with at least a $65 filing fee but more money is required, or patent applications are received with informal drawings. This form is mailed by the examining group prior to the examiner's examination of the application.

The Application Division accords a filing date, as of the date of receipt in the Office, to application papers which include all of the necessary components of a complete application required by statute, but are informal because they do not comply with the rules or notices. In such applications, the Application Division prepares form PO–152 (rev. 1–73), Notice of Informal Application indicating the informality and places it in the file wrapper. The examining group mails the letter to applicant. Failure to correct the informality within the specified time results in abandonment of the application.

An application too informal to be admitted for examination may receive as its filing date, the date it was originally presented only by petition under rule 183, and only when a satisfactory showing is made that a proper application could not be submitted originally and that applicant will suffer irreparable damage if the filing date sought is not accorded.

Inquiries directed to the Application Division, either in person or by telephone, concerning patent applications should not be made during the afternoon hours between 2:30 and 4:30.

The letter of transmittal accompanying the filing of continuing applications should include such additional information as the identification by serial number of the parent application, its status, and location in the Patent Office. The supplying of this information will simplify the processing of these applications.

When a new application is filed with a request to transfer drawings under rule 88, the application papers should include drawing prints to enable the Application Division to process the case before transfer of the formal drawings is effected.

506.01 Return of Incomplete Application [R–35]

If a request is made, the parts of an incomplete application are returned by the Application Division. They may be used by applicant as part of a complete application if the missing parts are later supplied. See rule 53.

507 Drafting Division [R–35]

The drawing is sent to the Drafting Division to be inspected for formal compliance with the rules. If the drawing is satisfactory, it is stamped "approved". If the drawing contains defects which are not so serious as to warrant holding the application to be incomplete, the Draftsman checks the appropriate notation on the "Notice of Informal Patent Drawing" form PO–948.

See § 608.02(a) for handling of photoprints filed in lieu of drawings.

508 Distribution [R–35]

The Application Division has permanent prints made of the drawings of all complete applications and secures the prints in the file wrappers. The drawings and files are then assembled and forwarded to the proper examining group.

When a new or substitute drawing is received, a print is made and forwarded to the group to be placed in the file as an official paper.

As to the procedure to be followed when a model is filed, see §§ 608.03 and 608.03(a).

508.01 Papers Sent to Wrong Group [R–39]

If there is no Serial Register card, storage card or transfer card in the group for drawings, amendments or other papers delivered to the group, Application Division should be telephoned to determine the current assignment of the application. The current group assignment should be placed on the paper and then forwarded to the appropriate group. The assignment indicated by Application Division may be verified by calling the group indicated before forwarding the paper.

The Patent Application Locator and Monitoring System (PALM) Control Office may also be called for assistance in locating a pending application.

A terminal disclaimer should not be routed directly to an examining group. If such a paper (without the file) is received, it should be promptly forwarded *without the file* to the Patent Issue Division. In some situations the Patent Issue Division may be holding a terminal disclaimer. This may be checked by calling the Chief of the Patent Issue Division by telephone.

508.02 Papers Received After Patenting or Abandonment [R–28]

After an application is patented or abandoned, any incoming communication which is not to become part of the record is sent to the Correspondence and Mail Division for handling with the status of the application indicated thereon.

508.03 Unmatched Papers [R–42]

These instructions set forth procedures for handling unmatched papers in the examining

groups. It is suggested that the unmatched papers within a group be frequently reviewed to determine which should be sent to the Paper Correlating Office (PCO).

Item 1 below treats the papers in the "Serial number too high" category. Items 2–6 below are directed to all other unmatched papers not in the "Serial number too high" category.

1. *Unmatched papers in the "Serial No. Too High" category*

This collection of papers being held by the group should be reviewed *at least* once a week. Any paper having a serial number which clearly should have already been received by the group should be removed from this collection. Where the group does not have a corresponding application for any of these papers, inquiry should be made of the Application Division and PALM to determine the group of record. If another group number is indicated, the paper should be forwarded to that group. If neither Application Division nor PALM yields a new group number for the indicated Serial No., the paper should be sent to the PCO.

2. *Unmatched papers having a serial number for which no serial register card is present in the group*

It can be assumed that either the group number or the serial number on these papers is incorrect. Inquiry should be made of the Application Division and PALM to determine the group of record and the procedure set out in item 1 above followed. An exception to this practice should be made where the paper has thereon the name of an examiner in the group. In these situations a careful check of the group records and files as well as consultation with the indicated examiner should be made to determine the correct serial number. If this does not yield a new serial number the paper should be sent to the PCO.

3. *Unmatched papers relating to cases abandoned from group*

The file should be ordered from Abandoned Files. If the file is not received therefrom, the paper should be forwarded to the PCO. Charge Card, PO–125, returned by Abandoned Files should be stapled to the paper when it is sent to the PCO.

4. *Papers for applications which have been sent to the Patent Issue Division*

All papers for applications which PALM indicates to be located in any of the locations 730 through 765 should be forwarded to the Query and Correspondence Section of the Patent Issue Division, room 2–3C13 via the Office of Publications messenger. Such papers may be left for pickup by the messenger in the "Allowed Files Pickup/Delivery" boxes which are located in each examining group.

The instructions of this section (4) apply to all files in Issue including those which have been assigned a Patent Number and Issue Date. Papers requiring examiner review and action will be returned to the examining group after the Patent Issue Division personnel have matched the paper to the appropriate file.

5. *Papers for applications which have been sent to the Record Room*

If PALM indicates that the application for a paper is in the Record Room (location code 810 or 820), the paper should be forwarded to the Paper Correlating Office for response.

6. *Unmatched papers for cases which are known to be pending in the group but cannot be located*

Generally these are applications for which a serial register card is present in the group, but the file is not immediately available. These papers should be retained in the group for processing.

Each paper sent to the PCO must have a PCO Transmittal Form *stapled* thereto. Each form attached to a paper should be filled out as completely as possible. Transmittal Forms attached to papers in categories 1 and 2 must have an indication of the information obtained from *both* Application Division and PALM. The PALM information should be inserted in the large space at the bottom of the Form. This will help eliminate duplication of effort by PCO personnel. Papers received without transmittal forms or with incompletely filled out transmittal forms may be returned to the originating group. Additional copies of the PCO transmittal can be obtained by calling extension 73251.

509 Payment of Fees [R–39]

Rule 22. Fees payable in advance. Fees and charges payable to the Patent Office are required to be paid in advance, that is, at the time of making application for any action by the Office for which a fee or charge is payable.

Rule 23. Method of payment. All payments of money required for Patent Office fees should be made in United States specie, Treasury notes, national bank notes, post office money orders, or by certified checks. If sent in any other form, the Office may delay or cancel the credit until collection is made. Money orders and checks must be made payable to the Commissioner of Patents. Remittances from foreign countries must be payable and immediately negotiable in the United States for the full amount of the fee required. Money sent by mail to the Patent Office will be at the risk of the sender; letters containing money should be registered.

Rule 24. Coupons. Coupons in denominations of twenty cents and fifty cents are sold by the Patent Office for the convenience of regular purchasers of U.S. patents, designs, and trademark registrations; these coupons may not be used for any other purpose. The 20-cent coupons are sold individually and in books of 50 with stubs for record for $10.00. The 50-cent coupons are sold individually and in pads of 10 for $5.00 and in books of 50 with stubs for record for $25.00. These coupons are good until used; they may be transferred but cannot be redeemed.

NOTE: Public document coupons issued by the Superintendent of Documents cannot be used in the Patent Office, nor can the coupons issued by the Patent Office be used at the Government Printing Office or elsewhere.

Rule 25. Deposit accounts. (a) For the convenience of attorneys, agents, and the general public in ordering services offered by the Office, copies of records, etc., special deposit accounts may be established in the Patent Office. A minimum deposit of $50.00 or more, depending on the activity of the individual account, is required. At the close of each month's business, a statement will be rendered. A remittance must be made promptly upon receipt of the statement to cover the value of items or services charged to the account and thus restore the account to its established normal deposit value. An amount sufficient to cover all services, copies, etc., requested must always be on deposit.

(b) Filing, issue, appeal, and petition fees may be charged against these accounts.

An overdrawn account will be immediately suspended and no charges will be accepted against it until a proper balance is restored, together with a payment of ten dollars to cover the work done by the Patent Office incident to suspending and reinstating the account and dealing with charges which may have been made in the meantime. It is expected, however, that reasonable precautions will be taken in all cases to avoid overdrafts, and if an account is suspended repeatedly it will be necessary to close it.

Similarly, because of the burden placed on the Patent Office incident to the operation of deposit accounts, a charge of ten dollars will be made for opening each new account.

The Patent Office will accept lists of fifty (50) or more patent numbers arranged in numerical sequence to be supplied and charged to deposit accounts. Service charges, such as Special Handling and Air Mail postage for these orders, may also be charged to Deposit Accounts.

Rule 26. Refunds. Money paid by actual mistake or in excess, such as a payment not required by law, will be refunded, but a mere change of purpose after the payment of money, as when a party desires to withdraw his application or to withdraw an appeal, will not entitle a party to demand such a return. Amounts of ten cents or less will not be returned unless specifically demanded, within a reasonable time, nor will the payer be notified of such amount; amounts over ten cents but less than one dollar may be returned in postage stamps, and other amounts by check.

510 Patent Office Business Hours [R–39]

This procedure is being published to bring to the attention of the public security provisions concerning the Patent Office premises and Patent Office files.

The public is reminded that the Patent Office working hours are 8:30 a.m. to 5:00 p.m., Monday through Friday, excluding legal holidays in the District of Columbia. Outside these hours, only Patent Office employees are authorized to be in areas of the Patent Office other than the Public Search Rooms.

The hours for the Public Search Room are 8:00 a.m. to 8:00 p.m., and the hours for the Trademark Search Room are 8:00 a.m. to 6:00 p.m., Monday through Friday, excluding legal holidays in the District of Columbia.

During working hours, all applicants, attorneys, and other members of the public should announce their presence to the Office personnel in the area of their visit. In the examining groups, visitors should inform the group receptionist of their presence before visiting other areas of the group.

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601 Content of Application [R–29]

Rule 51. General requisites of an application. Applications for patents must be made to the Commissioner of Patents. A complete application comprises:

(a) A specification, including a claim or claims, see rules 71 to 77.

(b) An oath or declaration, see rules 65 and 68.

(c) Drawings, when necessary, see rules 81 to 88.

(d) The prescribed filing fee. (See 35 U.S.C. 41 for filing fees.)

35 U.S.C. 111. *Application for patent.* Application for patent shall be made by the inventor, except as otherwise provided in this title, in writing to the Commissioner. Such application shall include: (1) a specification as prescribed by section 112 of this title; (2) a drawing as prescribed by section 113 of this title; and (3) an oath by the applicant as prescribed by section 115 of this title. The application must be signed by the applicant and accompanied by the fee required by law.

Guidelines for Drafting A Model Patent Application

The following guidelines illustrate the preferred layout and content for patent applications. These guidelines are suggested for the applicant's use.

Arrangement and Contents of the Specification

The following order of arrangement is preferable in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated.

(a) Title of the Invention.
(b) Abstract of the Disclosure.
(c) Cross-References to Related Applications (if any).
(d) Background of the Invention.
1. Field of the Invention.
2. Description of the Prior Art.
(e) Summary of the Invention.
(f) Brief Description of the Drawing.
(g) Description of the Preferred Embodiment(s).
(h) Claim(s).

(a) *Title of the Invention:* (See rule 72(a).) The title of the invention should be placed at the top of the first page of the specification. It should be brief but technically accurate and descriptive.

(b) *Abstract of the Disclosure:* (See rule 72(b), and § 608.01(b).)

(c) *Cross-References to Related Applications:* (See rule 78 and § 201.11).

(d) *Background of the Invention:* The specification should set forth the Background of the Invention in two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

(2) Description of the Prior Art: A paragraph(s) describing to the extent practical the state of the prior art known to the applicant, including references to specific prior art where appropriate. Where applicable, the problems involved in the prior art, which are solved by the applicant's invention, should be indicated.

(e) *Summary:* A brief summary or general statement of the invention as set forth in rule 73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

(f) *Brief Description of the Drawing:* A reference to and brief description of the drawing(s) as set forth in rule 74.

(g) *Description of the Preferred Embodiment(s):* A description of the preferred embodiment(s) of the invention as required in rule 71. The description should be as short and specific as is necessary to adequately and accurately describe the invention.

Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field to which the invention pertains, form a part of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements,

compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.

(h) *Claim(s):* (See rule 75.) A claim may be typed with the various elements subdivided in paragraph form. There may be plural indentations to further segregate subcombinations or related steps.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Claims should preferably be arranged in order of scope so that the first claim presented is the broadest. Where separate species are claimed, the claims of like species should be grouped together where possible and physically separated by drawing a line between claims or groups of claims. (Both of these provisions may not be practical or possible where several species claims depend from the same generic claim.) Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

The form of claim required in rule 75(e) is particularly adapted for the description of improvement type inventions. It is to be considered a combination claim and should be drafted with this thought in mind.

In drafting claims in accordance with rule 75(e), the preamble is to be considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

Oath or Declaration

(See rules 65 and 68.) Where one or more previously filed foreign applications are cited or mentioned in the oath or declaration, complete identifying data, including the application or serial number as well as the country and date of filing, should be provided.

The Application

The specification and oath or declaration must be in the English language and must be legibly typewritten, written or printed in permanent ink or its equivalent in quality. See rule 52 and § 608.01.

The parts of the application may be included in a single document, and an approved single-signature form may be used.

Determination of completeness of an application is covered in § 506.

The specification and oath or declaration are secured together in a file wrapper, bearing appropriate identifying data including the serial number and filing date (§ 717).

Note

Division applications § 201.06.
Continuation applications § 201.07.
Reissue applications § 1401.
Design applications, Chapter 1500.
Plant applications, Chapter 1600.

A model, exhibit or specimen is not required as part of the application as filed, although it may be required in the prosecution of the application (rules 91–93, § 608.03).

Rule 59. Papers of complete application not to be returned. Papers in a complete application, including the drawings, will not be returned for any purpose whatever. If applicants have not preserved copies of the papers, the Office will furnish copies at the usual cost.

See, however, § 604.04(a).

The Patent and Trademark Office has initiated a program for expediting newly filed application papers through pre-examination steps. This program requires the cooperation of applicants in order to attain the desired result—a reduction in processing time.

Therefore, all applicants are requested to include a preliminary classification on newly filed patent applications. The preliminary classification, preferably class and subclass designations, should be identified in the upper right-hand corner of the letter of transmittal accompanying the application papers, for example "Proposed class 2, subclass 129."

This program is voluntary and the classification submitted will be accepted as advisory in nature. The final class and subclass assignment remains the responsibility of the Office. [R–44]

601.02 Power of Attorney or Authorization of Agent [R–35]

The attorney's or agent's full post office address (including ZIP code number) must be given in every power of attorney or authority of agent. The telephone number of the attorney or agent should also be included in the power. The prompt delivery of communications will thereby be facilitated.

Usually a power of attorney or authorization of agent is incorporated in the single signature form. (See §§ 402 and 605.04(a).)

602 Original Oath or Declaration [R–44]

35 U.S.C. 25. Declaration in lieu of oath

(a) The Commissioner may by rule prescribe that any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration in such form as the Commissioner may prescribe, such declaration to be in lieu of the oath otherwise required.

(b) Whenever such written declaration is used, the document must warn the declarant that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001).

35 U.S.C. 26. Effect of defective execution

Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be executed in a specified manner may be provisionally accepted by the Commissioner despite a defective execution, provided a properly executed document is submitted within such time as may be prescribed.

35 U.S.C. 115. Oath of applicant

The applicant shall make oath that he believes himself to be the original and first inventor of the process, machine, manufacture, or composition of matter, or improvement thereof, for which he solicits a patent; and shall state of what country he is a citizen. Such oath may be made before any person within the United States authorized by law to administer oaths, or, when made in a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by certificate of a diplomatic or consular officer of the United States, and such oath shall be valid if it complies with the laws of the state or country where made. When the application is made as provided in this title by a person other than the inventor, the oath may be so varied in form that it can be made by him.

Rule 65. Statement of Applicant. (a)(1) The applicant, if the inventor, must state that he verily believes himself to be the original and first inventor or discoverer of the process, machine, manufacture, composition of matter, or improvement thereof, for which he solicits a patent; that he does not know and does not believe that the same was ever known or used in the United States before his invention or discovery thereof, and shall state of what country he is a citizen and where he resides, and whether he is a sole or joint inventor of the invention claimed in his application. In every original application the applicant must distinctly state that to the best of his knowledge and belief the invention has not been in public use or on sale in the United States more than one year prior to his application or patented or described in any printed publication in any country before his invention or more than one year prior to his application, or patented or made the subject of an inventor's certificate in any foreign country prior to the date of his application on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in this country. He shall state whether or not any application for patent or inventor's certificate on the same invention has been filed in any foreign country, either by himself or by his legal representatives or assigns. If any such application has been filed, the applicant shall name the country in which the earliest such application was filed, and shall give the day, month, and year of its filing; he shall also identify by country and by day, month, and year of filing, every such foreign application filed more than twelve months before the filing of the application in this country.

(2) This statement (i) must be subscribed to by the applicant, and (ii) must either (a) be sworn to (or affirmed) as provided in rule 66, or (b) include the personal declaration of the applicant as prescribed in rule 68. See rule 153 for design cases and rule 162 for plant cases.

(b) If the application is made as provided in rules 42, 43, or 47, the applicant shall state his relationship to the inventor and, upon information and belief, the facts which the inventor is required by this rule to state.

(c) An additional statement may be required if the application has not been filed in the Patent and Trademark Office within a reasonable time after execution of the original statement.

Rule 68. Declaration in Lieu of Oath. Any document to be filed in the Patent and Trademark Office and which is required by any law, rule, or other regulation to be under oath may be subscribed to by a written declaration with the exception of testimony relating to interferences and other contested cases covered by rules 271 to 286. Such declaration may be used in lieu of the oath otherwise required, if, and only if, the declarant is on the same document, warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of his own knowledge are true and that all statements made on information and belief are believed to be true.

18 U.S.C. 1001. Statements or entries generally

Whoever, in any matter within the jurisdiction of any department or agency of the United States knowingly and willfully falsifies, conceals or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be fined not

more than $10,000 or imprisoned not more than five years, or both.

Oaths and declarations submitted in applications filed after May 1, 1975 must make reference to the prior filing or non-filing of applications for inventor's certificates.

A rule 68 declaration need not be ribboned to the other papers, even if signed in a country foreign to the United States. When a declaration is used, it is unnecessary to appear before any official in connection with the making of the declaration. It must, however, since it is an integral part of the application, be maintained together therewith. Suggested forms for declarations are located in Part 3 of Title 37, Code of Federal Regulations.

By statute, 35 U.S.C. 25, the Commissioner has been empowered to prescribe instances when a written declaration may be accepted in lieu of the oath for "any document to be filed in the Patent and Trademark Office".

The filing of a written declaration is acceptable in lieu of an original application oath that is informal.

The applicant must state that no foreign applications have been filed, if such is the case. If all foreign applications have been filed within twelve months of the U.S. filing date, he is required only to recite the first such foreign application, and it should be clear that the foreign application referred to is the first filed foreign application. The applicant is required to recite all foreign applications filed more than twelve months prior to the U.S. filing. It is desirable to give the foreign serial number as well as the filing date of the first filed foreign application, especially if the inventor's name will not appear in a certified copy of said foreign application.

The single signature forms mentioned in § 605.04(a) includes the oath or declaration.

In the oath, the jurat must be filled out, and the word "sole" or "only" must appear if there

is but one inventor, and "joint" if two or more inventors.

When joint inventors execute separate oaths or declarations, each oath or declaration should make reference to the fact that the affiant is a joint inventor together with each of the other inventors indicating them by name. This may be done by stating that he does verily believe himself to be the original, first and joint inventor together with "A or A & B, etc." as the facts may be.

→ A seal is usually impressed on an oath. See §§ 604 and 604.01 and rule 66. However oaths executed in many states including Alabama, Louisiana, Maryland, Massachusetts, New Jersey, New York, Rhode Island, South Carolina and Virginia need not be impressed with a seal.

If a claim is presented for matter not originally claimed or embraced in the original statement of invention in the specification a supplemental oath is required. Rule 67, § 603.

602.01 Oath Cannot Be Amended [R–25]

The wording of an oath or declaration cannot be amended. If the wording is not correct or if all of the required affirmations have not been made or if it has not been properly subscribed to, a new oath or declaration must be required. However, in some cases a deficiency in the oath or declaration can be corrected by a supplemental paper and a new oath or declaration is not necessary.

For example, if the oath does not set forth evidence that the notary was acting within his jurisdiction at the time he administered the oath a certificate of the notary that the oath was taken within his jurisdiction will correct the deficiency. See §§ 602 and 604.02.

602.02 New Oath or Substitute for Original [R–25]

In requiring a new oath or declaration, the examiner should always give the reason for the requirement and call attention to the fact that the application of which it is to form a part must be properly identified in the body of the new oath or declaration, preferably by giving the serial number and the date of filing. This is done in the first action by means of attachment Form PO–152 (see § 707.07(a)).

Where neither the original oath or declaration, nor the substitute oath or declaration is complete in itself, but the two taken together give all the required data, no further oath or declaration is needed.

602.03 Defective Oath or Declaration [R–40]

In the first Office action the examiner must point out, making use of attachment Form PO–152 (see § 707.07(a)), every deficiency in a declaration or oath and require that the same be remedied. However, when an application is otherwise ready for issue, an examiner with full signatory authority may waive the following minor deficiencies:

1. A delay of somewhat more than five weeks plus mailing time in filing after the time of making the declaration, or the time of execution in the case of an oath.
2. Residence of an applicant if a post office address is given.
3. Minor deficiencies in the execution of an oath.
4. Minor deficiencies in the body of the oath where the deficiencies are self-evidently cured in the rest of the oath, as in an oath of plural inventors couched in plural terms except for use of "sole" for "joint," particularly where "sole inventors" is asserted. In re Searles, 164 USPQ 623.

If any of the above are waived, the examiner should write in the margin of the declaration or oath a notation such as "Stale date of declaration (oath) waived; application ready for issue" and his initials and the date.

602.04 Foreign Executed Oath [R–25]

An oath executed in a foreign country must be properly authenticated. See § 604 and rule 66.

602.04(a) Foreign Executed Oath Is Ribboned to Other Application Papers [R–21]

Extract from Rule 66. (b) When the oath is taken before an officer in a country foreign to the United States, all the application papers, except the drawings, must be attached together and a ribbon passed one or more times through all the sheets of the application, except the drawings, and the ends of said ribbon brought together under the seal before the latter is affixed and impressed, or each sheet must be impressed with the official seal of the officer before whom the oath is taken. If the papers as filed are not properly ribboned or each sheet impressed with the seal, the case will be accepted for examination but before it is allowed, duplicate papers, prepared in compliance with the foregoing sentence, must be filed.

Note that a declaration in lieu of application oath (rule 68) need not be ribboned to the other papers. It must, however, be maintained together therewith.

602.05 Oath or Declaration—Date of Execution [R–40]

The time elapsed between the date of execution of the oath or declaration and the filing date of the application should be checked for compliance with rule 65(c). If an unreasonable time has elapsed, the examiner should call for a new oath or declaration. What constitutes a reasonable time is a question of judgment to be determined by all the circumstances in the particular case. (Five weeks plus time of transmission in the mails was considered reasonable under the circumstances of Ex parte Heinze, 1919 C.D. 67; 265 O.G. 145). The "Notice of informal Patent Application" attachment form PO–152 is used to notify applicant that his oath or declaration is stale.

If no date of execution appears, applicant is required to file either a new oath or declaration or a certificate from the notary giving the actual date when the oath or declaration was made.

602.05(a) Oath or Declaration in Division and Continuation Cases [R–40]

Where the date of filing the application is not the date that determines the statutory twelve months' period, as in divisional and continuation cases, it is immaterial, so far as concerns the acceptability of the oath or declaration, how long a time intervenes between the execution of the oath or declaration and the filing of the application.

When a divisional application is identical with the original application as filed, signing and execution of the oath in the divisional case may be omitted. (See rule 60, § 201.06(a).)

603 Supplemental Oath or Declaration [R–44]

Rule 67. Supplemental oath or declaration for matter not originally claimed. (a) When an applicant presents a claim for matter originally shown or described but not substantially embraced in the statement of invention or claim originally presented, he shall file a supplemental oath or declaration to the effect that the subject matter of the proposed amendment was part of his invention; that he does not know and does not believe that the same was ever known or used in the United States before his invention or discovery thereof, or patented or described in any printed publication in any country before his invention or discovery thereof, or more than one year before his application, or in public use or on sale in the United States for more than one year before the date of his application, that said invention has not been patented or made the subject of an inventor's certificate in any foreign country prior to the date of his application in this country on an application filed by himself or his legal representatives or assigns more than twelve months prior to his application in the United States, and has not been abandoned. Such supplemental oath or declaration should accompany and properly identify the proposed amendment, otherwise the proposed amendment may be refused consideration.

(b) In proper cases the oath or declaration here required may be made on information and belief by an applicant other than inventor.

Rule 67 requires in the supplemental oath or declaration substantially all the data called for in rule 65 for the original oath or declaration. As to the purpose to be served by the supplemental oath or declaration, the examiner should bear in mind that it cannot be availed of to introduce new matter into an application.

603.01 Supplemental Oath or Declaration Filed After Allowance [R–40]

Since the decision in Cutter Co. v. Metropolitan Electric Mfg. Co., 275 Fed. 158, many supplemental oaths and declarations covering the claims in the case have been filed after the case is allowed. Such oaths and declarations may be filed as a matter of right and when received they will be placed in the file by the Patent Issue Division, but their receipt will not be acknowledged to the party filing them. They should not be filed or considered as amendments under rule 312, since they make no change in the wording of the papers on file. See § 714.16.

604 Administration or Execution of Oath [R–21]

Extract From Rule 66. Officers authorized to administer oaths. (a) The oath or affirmation may be made before any person within the United States authorized by law to administer oaths, or, when made in

a foreign country, before any diplomatic or consular officer of the United States authorized to administer oaths, or before any officer having an official seal and authorized to administer oaths in the foreign country in which the applicant may be, whose authority shall be proved by a certificate of a diplomatic or consular officer of the United States, the oath being attested in all cases in this and other countries, by the proper official seal of the officer before whom the oath or affirmation is made. Such oath or affirmation shall be valid as to execution if it complies with the laws of the state or country where made. When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal.

See § 602.04(a) for foreign executed oath.

604.01 Seal [R–21]

When the person before whom the oath or affirmation is made in this country is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal, except as noted in § 604.03(a), in which situations no seal is necessary. When the issue concerns the authority of the person administering the oath, the examiner should require proof of authority. Depending on the jurisdiction, the "seal" may be either embossed or rubber stamped. The latter should not be confused with a stamped legend indicating only the date of expiration of the notary's commission.

See also § 602.04(a) on foreign executed oath and seal. In some jurisdictions, the seal of the notary is not required but the official title of the officer must be on the oath. This applies to Alabama, California (certain notaries), Louisiana, Maryland, Massachusetts, New Jersey, New York, Ohio, Puerto Rico, Rhode Island, South Carolina and Virginia.

604.02 Venue [R–31]

That portion of an oath or affidavit indicating where the oath is taken is known as the venue. Where the county and state in the venue agree with the county and state in the seal, no problem arises. If the venue and seal do not correspond in county and state, the jurisdiction of the notary must be determined from statements by the notary appearing on the oath, or from the listing at § 604.03. Venue and notary jurisdiction must correspond or the oath is improper. The oath should show on its face that it was taken within the jurisdiction of the certifying officer or notary. This may be given either in the venue or in the body of the jurat. Otherwise, a new oath or declaration, or a certificate of the notary that the oath was taken within his jurisdiction, must be required. Ex parte Delavoye, 1906 C.D. 320; 124 O.G. 626; Ex parte Irwin, 1928 C.D. 13; 367 O.G. 701.

The following language may be used in an Office action where the venue is not shown:

[1] The oath in this application lacks the statement of venue. To correct this defect, applicant is required to furnish either a new oath or declaration in proper form, identifying the application by serial number and date of filing, or a certificate by the officer before whom the original oath was taken stating that he was within his jurisdiction when he administered that oath.

Where the seal and venue differ the appropriate statement on the "Notice of Informal Patent Application" form PO–152 should be checked.

604.03 Notaries and Extent of Jurisdiction

The extent of the jurisdiction of the notaries in the various states is given below.

COUNTY ONLY

Louisiana
Mississippi
Texas

VARIABLE JURISDICTION

(See explanatory paragraphs below)

Alabama (a)
Florida (b)
Hawaii (c)
Iowa (d)
Kansas (e)
Kentucky (d)
Missouri (e)
Nebraska (a)
Ohio (f)
Tennessee (g)
Virginia (h)
West Virginia (d)

STATEWIDE

All other states

(a) Alabama and Nebraska notaries are appointed for counties and for state at large.

(b) Florida notary commissions are customarily for state at large but may be restricted by commission to less than the state at large.

(c) In Hawaii it is generally limited to the judicial circuit.

(d) In Iowa, Kentucky and West Virginia it is limited to county for which appointed, but notary in any county may qualify and act as notary in any other county.

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(e) The jurisdiction of Kansas and Missouri notaries is coextensive with county of appointment and adjoining counties.

(f) In Ohio, notaries other than attorneys are appointed by the Governor for a term of 5 years and have power to act only in county for which appointed. An attorney or any person certified by a judge of the court of common pleas of the county in which he resides as qualified for the duties of official stenographic reporter of such state, may, however be commissioned for the entire state. The extent of jurisdiction is stated near the notary's signature.

(g) Tennessee notary publics commissioned in one county may file in county court of any other county and thereupon may exercise the function of his office in such other county. In such cases, however, notary must attach to his certificate a statement that he is qualified in the county in which he acts. Notaries at large are commissioned by the Secretary of the State. Notary's signature must indicate that he is so qualified. Special seal is prescribed by the Secretary of State.

(h) In Virginia, notaries are limited to city or county for which appointed except that notary for city may act in county or city contiguous thereto, and a notary for a county may act in city contiguous thereto. Notaries may be appointed for two or more counties and cities or for the state at large.

The notary does not have to state when his commission expires but if he does so state, the oath should be inspected to determine whether or not the notary's commission had expired at the date of execution of the oath.

604.03(a) Notarial Powers of Some Military Officers

Public Law 506 (81st Congress, Second Session) Article 136: (a) The following persons on active duty in the armed forces . . . shall have the general powers of a notary public and of a consul of the United States, in the performance of all notarial acts to be executed by members of any of the armed forces, wherever they may be, and by other persons subject to this code [Uniform Code of Military Justice] outside the continental limits of the United States:

(1) All judge advocates of the Army and Air Force;

(2) All law specialists;

(3) All summary courts-martial;

(4) All adjutants, assistant adjutants, acting adjutants, and personnel adjutants;

(5) All commanding officers of the Navy and Coast Guard;

(6) All staff judge advocates and legal officers, and acting or assistant staff judge advocates and legal officers; and

(7) All other persons designated by regulations of the armed forces or by statute.

(d) The signature without seal of any such person acting as notary, together with the title of his office, shall be prima facie evidence of his authority.

604.04 Consul [R–31]

When the oath is made in a foreign country, the authority of any officer other than a diplomatic or consular officer of the United States authorized to administer oaths must be proved by certificate of a diplomatic or consular officer of the United States. See rule 66, § 604. This proof may be through an intermediary; e.g., the consul may certify as to the authority and jurisdiction of another official who, in turn, may certify as to the authority and jurisdiction of the officer before whom the oath is taken.

604.04(a) Consul-Omission of Certificate [R–31]

Where the oath is taken before an officer in a foreign country other than a diplomatic or consular officer of the United States and whose authority is not authenicated, the application is nevertheless given a filing date for purposes of examination. The examiner, in his first Office action, should note this informality and require either authentication of the oath by an appropriate diplomatic or consular officer or a declaration (rule 68). The following language is suggested:

[1] "The oath is objected to as being informal in that it lacks authentication by a diplomatic or consular officer of the United States; rule 66(a). This informality can be overcome either by forwarding the original oath to the appropriate officer for authentication or by filing a declaration (rule 68), if applicant wishes to preserve his original filing date. If authentication is desired, applicant should request return of the oath for this purpose. Such request must be accompanied by an order for a copy of the oath to be retained in the file until the properly authenticated oath is returned. After the oath has been authenticated, it should be returned promptly to the Patent Office."

At the time of the next Office action the request for return of the oath, together with the application file and the copy of the oath, is submitted to the group director. If the request is approved by him, the oath will be

returned to the applicant by the examining group.

604.05 Consular Fee Stamp

All papers executed on or after June 28, 1955, that formerly required the consular fee stamp, are acceptable without such stamp.

604.06 By Attorney in Case

The language of rule 66 and 35 U.S.C. 115 is such that an attorney in the case is no longer barred from administering the oath as notary. The Office presumes that an attorney acting as notary is cognizant of the extent of his authority and jurisdiction and will not know-

ingly jeopardize his client's rights by performing an illegal act. If such practice is permissible under the law of the jurisdiction where the oath is administered, then the oath is a valid oath.

The law of the District of Columbia prohibits the administering of oaths by the attorney in the case and hence the old bar still applies in the case of oaths administered in the District of Columbia. If the oath is known to be void because of being administered by the attorney in a jurisdiction where the law holds this to be invalid, the proper action for the Office to take is to strike the application since there is in effect no proper application before the Office and the examiner will refer the file to the solicitor's office to initiate such action. (Riegger v. Beierl, 1910 C.D. 12; 150 O.G. 826). See rule 66 and § 604. [R–24]

605 Applicant [R–29]

Rule 41. Applicant for patent. (a) A patent must be applied for and the application papers must be signed and the necessary oath or declaration executed by the actual inventor in all cases, except as provided by rules 42, 43, and 47. (See rule 60)

(b) Unless the contrary is indicated, the word "applicant" when used in these rules refers to the inventor, joint inventors who have applied for a patent, or to the person mentioned in rules 42, 43, or 47 who has applied for a patent in place of the inventor.

Extract from Rule 45. Joint inventors. (a) Joint inventors must apply for a patent jointly and each must sign the application papers and make the required oath or declaration; neither of them alone, nor less than the entire number, can apply for a patent for an invention invented by them jointly, except as provided in rule 47.

For convertibility from a joint to sole or sole to joint application, see § 201.03.

Rule 46. Assigned inventions and patents. In case the whole or a part interest in the invention or in the patent to be issued is assigned, the application must still be made by the inventor or one of the persons mentioned in rules 42, 43, or 47. However, the patent may be issued to the assignee or jointly to the inventor and the assignee as provided in rule 334.

This section concerns filing by the actual inventor. If filed by other, see § 409.03.

NOTE

Disposition of application by inventor, § 301. Inventor dead or insane, § 409.

605.01 Applicant's Citizenship

The statute (35 U.S.C. 115) requires an applicant to state his citizenship. Where an applicant is not a citizen of any country, a statement to this effect is accepted as satisfying the statutory requirement; but a statement as to citizenship applied for or first papers taken out looking to future citizenship in this (or any other) country does not meet the requirement.

605.02 Applicant's Residence [R–35]

Applicant's place of residence (not to be confused with his Post Office address) can be furnished by the attorney. In the case of an applicant who is in the U.S. Army or U.S. Navy, a statement to that effect is sufficient as to residence. For change of residence see § 717.02(b).

When the post office address is supplied but the residence is omitted, the post office address is presumed to be the city and state of his residence. Applicant should be so notified by using language similar to that suggested below.

[1] "Applicant's residence has been omitted from the papers. The city and state of his post office address will be presumed to be the city and state of his residence. If the above is incorrect, applicant should submit a statement of his place of residence no later than at the time of payment of the issue fee."

If both the post office address and residence are incomplete, not uniform or omitted, the "Notice of Informal Patent Application" form PO–152 should be used. Note rule 33(a).

605.03 Applicant's Post Office Address [R–35]

Applicant's post office address means that address at which he customarily receives his mail. The post office address should include the ZIP Code designation.

The object of requiring applicant's post office address is to enable the Office to communicate directly with the applicant if desired; hence, the address of the attorney with instructions to send communications to applicant in care of the attorney is not sufficient.

If the post office address is entirely omitted it must be supplied by a letter over the applicant's own signature. Where, however, having given complete data as to his residence, the applicant identifies his post office address only by street and number, it is assumed and so accepted, that the city and state of his residence are the city and state of his post office address.

Any amendment of the post office address requires the signature of the applicant himself.

The "Notice of Informal Patent Application" attachment form PO–152 is used to notify appli-

cant that the post office address is incomplete or omitted. Note rule 33(a).

605.04 Applicant's Signature and Name [R–29]

Rule 57. Signature. The application must be signed by the applicant in person. The signature of the oath or declaration will be accepted as the signature to the application provided the oath or declaration is attached to and refers to the specification and claims to which it applies. Otherwise the signature must appear at the end of the specification after the claims. Full names must be given, including at least one given name without abbreviation together with any other given name or initial.

The signing and execution by the applicant of certain applications may be omitted. §§ 201.06 and 201.07.

NOTE: Signature to response see §§ 714.01(a) to (e).

605.04(a) Single Signature Form [R–24]

The single signature form should be executed only when attached to a complete application as the last page thereof. Such forms are shown as 16 and 16a in the List of Forms in the Rules of Practice booklet.

605.04(b) One Full Given Name Required [R–35]

All applications which disclose the full first and last names with middle initial or name, if any, of the applicant at any place in the application papers will be received and considered as a sufficient compliance with rule 57 of the Rules of Practice.

When *a full given name* of the applicant does not appear either in the signature or elsewhere in the papers the examiner will, in the first official action, require an amendment over applicant's signature supplying the omission, and he will not pass the application to issue until the omission has been supplied unless a statement be filed over the applicant's own signature setting forth that his name as signed contains at least one given name without abbreviation or what is in fact his full first name.

No affidavit should be required.

The requirement should be made only when all of the given names in the signature appear as mere initials or as what can be only an abbreviation of a name.

Rule 57 requires "full names". One given name without abbreviation, together with any other given name or initial must appear somewhere in the papers as filed. Otherwise, appropriate amendment is required.

In an application where the name is typewritten with a *middle name or initial*, but the signature is without such middle name or initial, action should be taken as follows:

In the first Office letter, call attention to the lack of uniformity and request information over the applicant's signature as to the correct form of his name, together with any necessary amendment.

If applicant, in reply, gives the name without the middle name or initial unaccompanied by any instructions to amend the typewritten name, the reply may be interpreted as a direction to cancel the middle name or initial from the application. It is necessary however, that such surplus portion of the name, if it appears printed on the drawing, should be removed therefrom. This can be done by the Office draftsman.

If applicant gives the name with the middle name or initial, interpret the reply as a direction that the middle name or initial is to be used in the name on the printed patent. As the printer takes the name from the face of the file wrapper, the middle name or initial should be added thereto in red ink.

If applicant fails to answer the request and the case is otherwise ready for issue, prepare an examiner's amendment indicating that the name on the drawing has been corrected to correspond with the signature or signatures, have the draftsman correct the drawing, and pass the case to issue. This cannot be done if there are inconsistencies in the signatures of the same applicant.

There should be uniformity notwithstanding that lack of it is not sufficient to affect the validity of the patent.

When the name on the file wrapper is corrected, the file should be sent to the Application Division for correction of its records.

605.04(c) Applicant Changes Name [R–35]

In cases where an applicant's name has been changed after his application has been filed and the applicant desires that the patent when issued carry an endorsement as to the change in his name, he must submit a recording fee accompanied by either an affidavit signed with both names and setting forth the procedure whereby the change of name was effected, or a certified copy of the court order, such papers are recorded by the Assignment Division where the new name is added on the file wrapper.

The Assignment Division forwards the file to the Application Division for a change in their records.

No change is made on the face of the file by the clerk of the examining group. A suitable endorsement being made by the Assignment Division. When ready for allowance, the case should be sent to the Drafting Division for the addition of the new name to the drawing if there is already a name on the drawing.

Where the change of name is merely by amendment, such as the addition of a full first name or a middle initial and no affidavit is required, the file is sent to the Application Division for a change in their records and if the application is assigned it will be forwarded by the Application Division to the Assignment Division for a change in assignment record.

605.04(d) Applicant Unable to Write

If the applicant is unable to write, his mark as affixed to the application must be attested to by a witness. In the case of the oath, the notary's signature to the jurat is sufficient to authenticate the mark.

605.04(e) May Use Title With Signature

It is permissible for an applicant to use a title of nobility or other title, such as "Dr.", in connection with his signature. The title will not appear in the printed patent.

605.04(f) Signature on Joint Applications—Order of Names [R–24]

It is not essential that the names appear in the same order in the signatures to the petition, specification, oath or declaration, and drawing.

The order of names of joint patentees in the heading of the patent is taken from the order in which the typewritten names appear in the original oath or declaration accompanying the application papers. Care should therefore be exercised in selecting the preferred order of the typewritten names of the joint inventors, before filing, as requests for subsequent shifting of the names would entail changing numerous records in the Office. Since the particular order in which the names appear is of no consequence insofar as the legal rights of the joint applicants are concerned, no changes will be made except for good reasons. A request to change the order of names must be signed by either the attorney or agent of record or all the applicants. It is suggested that all typewritten and signed names appearing in the application papers should be in the same order as the typewritten names in the oath or declaration.

In those instances where the joint applicants file separate oaths or declarations, the order of names is taken from the order in which the several oaths or declarations appear in the application papers unless a different order is requested at the time of filing.

605.04(g) When Name Is Corrected, Send to Application Division [R–35]

When the name is corrected by amendment or the order of the names is changed, the file should be sent to the Application Division for correction of the name in its record. When the name is changed, see § 605.04(c).

605.04(h) Signature to Drawing [R–29]

Signatures and names are not permitted within the sight space of a drawing prepared under rule 84 as amended on May 28, 1971. All drawings filed after January 1, 1972 must comply with the amended rules. The name of the applicant and other identifying information may be placed at the top center of the drawing. See § 608.02.

605.05 Administrator, Executor, or Other Legal Representative [R–24]

In an application filed by a legal representative of the inventor, the specification should not be written in the first person. Instead of the usual "I have found," the wording should be "it was found."

For prosecution by administrator or executor, see § 409.01(a).

For prosecution by heirs, see §§ 409.01(a) and 409.01(d).

For prosecution by representative of legally incapacitated inventor, see § 409.02.

For prosecution by other than inventor, see § 409.03.

605.05(a) Signature of Legal Representative

If the drawing is signed by the legal representative it must follow this form:

John A. Jones, deceased,
by Mary A. Jones, Administratrix.

The other signatures must either be in the above form or:

Mary A. Jones
Administratrix of Estate of
John A. Jones, deceased.

If the drawing is signed by the attorney, this form must be used:

John A. Jones, deceased,
by Mary A. Jones, Administratrix,
by William A. Smith, Atty.

If the specification bears the *signature* of the administrator or executor but omits the matter, "administrator of the Estate of John Jones, deceased," the matter can be added by amendment. The examiner may make the amendment if the case is otherwise ready for issue.

605.06 Filing by Other Than Inventor [R–24]

See § 409.03.

606 Title of Invention

Rule 72(a). The title of the invention, which should be as short and specific as possible, should appear as a heading on the first page of the specification, if it does not otherwise appear at the beginning of the application.

606.01 Examiner May Require Change in Title [R–29]

Where the title is not descriptive of the invention claimed, the examiner should require the substitution of a new title that is clearly indicative of the invention to which the claims are directed. This may result in slightly longer titles, but the loss in brevity of title will be more than offset by the gain in its informative value in indexing, classifying, searching, etc. If a satisfactory title is not supplied by the applicant, the examiner may change the title by examiner's amendment on or after allowance.

If a change in title is the only change being made by the examiner at the time of allowance a separate examiner's amendment need not be prepared. The change in title will be incorporated in the notice of allowance. This will be accomplished by placing an "X" in the designated box on the notice of allowance form and entering thereunder the title as changed by the examiner who should initial the face of the file wrapper.

However, if an examiner's amendment must be prepared for other reasons any change in title will be incorporated therein.

Inasmuch as the words "improved", "improvement of" and "improvement in" are not considered as part of the title of an invention, the Patent Office does not include these words at the beginning of the title of the invention.

607 Filing Fee [R–35]

Applications filed before October 25, 1965, required only a basic filing fee. That part of the Fee Act, effective October 25, 1965, pertaining to claims presented after an application is filed, does not apply to these applications. See § 714.10.

Applications filed on or after October 25, 1965, are subject to the following fees and practice:

When filing an application, a basic fee of $65 entitles applicant to present (10) claims including not more than (1) in independent form. If claims in excess of the above are included at the time of filing, an additional fee of $10 is required for each independent claim in excess of one, and a $2 fee for each claim in excess of ten (10) claims (whether independent or dependent).

Upon submission of an amendment (whether entered or not) affecting the claims, payment of the following additional fees is required in a pending application:

$10--for each independent claim pending in excess of the number of independent claims already paid for.

$2--for each claim pending in excess of the total number already paid for. (It should be recognized that the basic $65 fee pays for ten (10) claims, one of which may be independent, regardless of the number actually filed.)

The Application Division has been authorized to accept all applications, otherwise acceptable, if the basic fee of $65 is submitted, and to require payment of the deficiency within a stated period upon notification of the deficiency.

Rule 22. Fees payable in advance. Fees and charges payable to the Patent Office are required to be paid in advance, that is, at the time of making application for any action by the Office for which a fee or charge is payable.

Amendments before the first action, or not filed in response to an Office action, presenting additional claims in excess of the number already paid for, not accompanied by the full additional fee due, will not be entered in whole or in part and applicant will be so advised. Such amendments filed in reply to an Office action will be regarded as not responsive thereto and the practice set forth in § 714.03 will be followed.

The additional fees, if any, due with an amendment are calculated on the basis of the

claims (total and independent) which would be present, if the amendment were entered. The amendment of a claim, unless it changes a dependent claim to an independent claim, and the replacement of a claim by a claim of the same type do not require any additional fees.

For purposes of determining the fee due the Patent Office, a claim will be treated as dependent if it contains reference to one other claim in the application. A claim determined to be dependent by this test will be entered if the fee paid reflects this determination.

Any claim which is in dependent form but which is so worded that it, in fact is not, as for example it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

After a requirement for restriction, nonelected claims will be included in determining the fees due in connection with a subsequent amendment unless such claims are canceled.

An amendment accompanying the papers constituting the separate application under rule 60 canceling claims from the certified copy will be effective to diminish the number of claims to be considered in calculating the filing fees to be paid.

The additional fees, if any, due with an amendment are required prior to any consideration of the amendment by the examiner.

Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment.

Amendments affecting the claims cannot serve as the basis for granting any refund.

Forms 51 and 52, located in the back of the Rule Book, may be used as an aid in determining the required fee. Copies of these forms are available from the Correspondence and Mail Branch and from the receptionist in the lobby of building 3 of the Patent Office.

607.01 Fee Exempt [R–22]

There were two types of Fee Exempt applications: (a) those filed under 35 U.S.C. 266, repealed as of October 25, 1965 and (b) those filed under a ruling of the Comptroller General's Opinion B–111,648 also abrogated as of the same date:

Beginning October 25, 1965, there are no longer any applications which are exempt from the filing fee or the issue fee. Applications filed before this date without the filing fee under the provisions previously in effect are subject to payment of the issue fee.

607.02 Returnability of Fees

All questions pertaining to the return of fees are referred to the Refund Unit of the Finance Branch of the Budget and Finance Division. No opinions should be expressed to attorneys or applicants as to whether or not fees are returnable in particular cases.

608 Disclosure [R–35]

In return for a patent, the inventor gives as consideration a complete revelation or disclosure of the invention for which he seeks protection. All amendments or claims must find basis in the original disclosure, or they involve new matter. Applicant may rely for disclosure upon the specification with original claims and drawings, all as filed complete. See rule 118 and § 608.04.

If during the course of examination of a patent application, an examiner notes the use of language that could be deemed offensive to any race, religion, sex, ethnic group, or nationality, he should object to the use of the language as failing to comply with the Rules of Practice. Rule 3 proscribes the presentation of papers which are lacking in decorum and courtesy. There is a further basis for objection in that the inclusion of such proscribed language in a Federal Government publication would not be in the public interest. Also, the inclusion in application drawings of any depictions or caricatures that might reasonably be considered offensive to any group should be similarly objected to, on like authority.

The examiner should not pass the application to issue until such language or drawings have been deleted, or questions relating to the propriety thereof fully resolved.

608.01 Specification [R–29]

35 U.S.C. 22. Printing of papers filed. The Commissioner may require papers filed in the Patent Office to be printed or typewritten.

Rule 71. Detailed description and specification of the invention. (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

(c) In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

Certain cross notes to other related applications may be made. References to foreign applications or to applications identified only by the attorney's docket number should be required to be cancelled. See rule 78 and § 202.01.

Rule 52. Language, paper, writing, margins. (a) The specification and oath or declaration must be in the English language. All papers which are to become a part of the permanent records of the Patent Office must be legibly written or printed in permanent ink or its equivalent in quality. All of the application papers must be presented in a form having sufficient clarity and contrast between the paper and the writing or printing thereon to permit the production of readily legible copies in any number by use of photographic, electrostatic, photo-offset, and microfilming processes. If the papers are not of the required quality, substitute typewritten or printed papers of suitable quality may be required.

(b) The application papers (specification, including claims, oath, or declaration, papers as provided for in rules 42, 43, 47, etc.) and also papers subsequently filed, must be plainly written on but one side of the paper. The size of all sheets of paper should be 8 to 8½ by 10½ to 13 inches (20.3 to 21.6 cm. by 26.6 to 33.0 cm.). A margin of 1½ inches (3.8 cm.) must be reserved on the left-hand side and on the top of each page of the specification, including claims. The lines must not be crowded too closely together; typewritten lines should be double spaced. The pages of the specification, including claims, should be numbered consecutively, starting with 1, the numbers being placed in the center of the bottom margins.

(c) Any interlineation, erasure, or cancellation or other alteration of the application papers as filed must have been made before the application was signed and sworn to or declaration made, and should be dated and initialed or signed by the applicant in a marginal note or footnote on the same sheet of paper to indicate such fact. No such alterations are permissible after execution of the application papers. (See rule 56.)

Rule 58. Chemical and mathematical formulas and tables. (a) The specification, including the claims, may contain chemical and mathematical formulas, but shall not contain drawings or flow diagrams. The description portion of the specification may contain tables; claims may contain tables only if necessary to conform to 35 U.S.C. 112.

(b) All tables and chemical and mathematical formulas in the specification, including claims, and amendments thereto, must be on pure white durable paper, the surface of which is calendered and smooth, in order to permit use as camera copy when printing any patent which may issue. A good grade of bond paper is acceptable; watermarks should not be prominent. India ink or its equivalent, or solid black typewriter ribbon must be used to secure perfectly black solid lines.

(c) To facilitate camera copying when printing, the width of formulas and tables as presented should be limited normally to 5 inches (12.7 cm.) so that it may appear as a single column in the printed patent. If it is not possible to limit the width of a formula or table to 5 inches (12.7 cm.), it is permissible to present the formula or table with a maximum width of 10¾ inches (27.3 cm.) and to place it sideways on the sheet, in which case the formula or table will appear printed across both columns of the page in the printed patent. Typewritten characters used in such formulas and tables must be from a block (nonscript) type font or lettering style having capital letters which are at least 0.085 inch (2.2 mm.) high (elite type). Hand lettering must be neat, clean, and have a minimum character height of 0.085 inch (2.2 mm.). A space at least ¼ inch (6.4 mm.) high should be provided between the formulas and tables and the text. Tables should have the lines and columns of data closely spaced to conserve space, consistent with high degree of legibility.

In order that specifications may be expeditiously handled by the Office, page numbers should be placed at the center of the bottom of each page. It is a common practice and a commendable one, to consecutively number all the lines of each page (and the lines of each claim). A top margin of at least 1½ inches should be reserved on each page to prevent possible mutilation of text when the papers are punched for insertion in a file wrapper.

Applicants should make every effort to file patent applications in a form that is clear and reproducible. The Office may accept for filing date purposes papers of reduced quality but will require that acceptable copies be supplied for further processing. Typed, mimeographed, xeroprinted, multigraphed or non-smearing carbon copy forms of reproduction are acceptable.

Legibility includes ability to be photocopied and photomicrographed so that suitable reprints can be made. This requires a high contrast, with black lines and a white background.

Gray lines and/or a gray background sharply reduce photo reproduction quality. Legibility of some application papers may become impaired due to abrasion or aging of the printed material during examination and ordinary handling of the file. It may be necessary to require that legible and permanent copies be furnished at later stages after filing, particularly when preparing for issue.

Some of the patent application papers received by the Patent Office are copies of the original, ribbon copy. These are acceptable if, in the opinion of the Office, they are legible and permanent.

The paper used must have a surface such that amendments may be written thereon in ink. So-called "Easily Erasable" paper having a special coating so that erasures can be made more easily may not provide a "permanent" copy. Rule 52 (a). If a light pressure of an ordinary (pencil) eraser removes the imprint, the examiner should, as soon as this becomes evident, notify applicant that it will be necessary for him to order a copy of the specification and claims to be made by the Patent Office at his expense for incorporation in the file. It is *not* necessary to return this copy to applicant for signature.

See in re Benson, 1959 C.D. 5; 744 O.G. 353. Reproductions prepared by heat-sensitive, hectographic or spirit duplication processes are also not satisfactory.

As stated in rule 52 the specification as well as oath or declaration must be in the English language.

The specification is sometimes in such faulty English that a new specification is necessary, but new specifications encumber the record and require additional reading, and hence should not be required or accepted except in extreme cases.

The specification does not require a date.

If a newly filed application obviously fails to disclose an invention with the clarity required by 35 U.S.C. 112, revision of the application should be required. See § 702.01.

As the specification is never returned to applicant under any circumstance, he should retain a line for line copy thereof, each line, preferably, having been consecutively numbered on each page. In amending, the attorney or the applicant requests insertions, cancellations, or alterations, giving the page and the line.

Rule 52(c) relating to interlineations and other alterations is strictly enforced. See in re Swanberg, 129 USPQ 364.

Use of Metric System of Measurements in Patent Applications

In order to minimize the necessity in the future for converting dimensions given in the English system of measurements to the metric system of measurements when using printed patents as research and prior art search documents, all patent applicants are strongly encouraged to use *either* (1) only metric (S.I.) units, or (2) English units together with their metric system equivalents, when describing their inventions in the specifications of patent applications. This practice, however, is not being made mandatory at this time.

The initials S.I. stand for "Systeme International d'Unites", the French name for the International System of Units, a modernized metric system adopted in 1960 by the International General Conference of Weights and Measures based on precise unit measurements made possible by modern technology.

This request is made as part of the long-range program for conversion to metric units currently being conducted by the Federal Government. [R–41]

608.01(a) Arrangement of Application [R–29]

Rule 77. Arrangement of application. The following order of arrangement should be observed in framing the application:

(a) Title of the invention; or an introductory portion stating the name, citizenship, and residence of the applicant, and the title of the invention may be used.

(b) Abstract of the disclosure.

(c) Cross-references to related applications, if any.

(d) Brief summary of the invention.

(e) Brief description of the several views of the drawing, if there are drawings.

(f) Detailed description.

(g) Claim or claims.

(h) Signature. (See rule 57.)

Note

Design patent specification, § 1503.01.

Plant patent specification, § 1605.

Reissue patent specification, § 1401.06.

The following order of arrangement is preferable in framing the specification and, except for the title of the invention, each of the lettered items should be preceded by the headings indicated.

(a) Title of the Invention.

(b) Abstract of the Disclosure.

(c) Cross-References to Related Applications (if any).

(d) Background of the Invention.

1. Field of the Invention.
2. Description of the Prior Art.

(e) Summary of the Invention.

(f) Brief Description of the Drawing.
(g) Description of the Preferred Embodiment(s).
(h) Claim(s).

608.01(b) Abstract of the Disclosure [R–41]

Rule 72(b). A brief abstract of the technical disclosure in the specification must be set forth immediately following the title and preceding the disclosure in a separate paragraph under the heading "Abstract of the Disclosure". The purpose of the abstract is to enable the Patent Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure, and the abstract shall not be used for interpreting the scope of the claims.

In all cases which lack an abstract, the examiner in the first Office action should re-

quire the submission of a brief abstract of the technical disclosure in the specification, the abstract to appear immediately after the title of the invention and preceding the disclosure in a separate paragraph under the heading "Abstract of the Disclosure." Responses to such actions should be treated under rule 111(b) practice like any other formal matter.

Under current practice, in all instances where the application contains an abstract when sent to issue, the abstract will be printed on the patent.

Upon passing the case to issue, the examiner should see that the abstract is an adequate and clear statement of the contents of the disclosure and generally in line with the guidelines. The abstract shall be changed by the examiner's amendment in those instances where deemed necessary.

Guidelines for the Preparation of Patent Abstracts

Background

The Rules of Practice in Patent Cases require that each application for patent include an abstract of the disclosure, rule 72(b).

The content of a patent abstract should be such as to enable the reader thereof, regardless of his degree of familiarity with patent documents, to ascertain quickly the character of the subject matter covered by the technical disclosure and should include that which is new in the art to which the invention pertains.

The abstract is not intended nor designed for use in interpreting the scope or meaning of the claims, rule 72(b).

Content

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is *new* in the art to which the invention pertains.

If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure.

If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement.

In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or a use thereof.

If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following: (1) if a machine or apparatus, its organization and operation; (2) if an article, its method of making; (3) if a chemical compound, its identity and use; (4) if a mixture, its ingredients; (5) if a process, the steps. Extensive mechanical and design details of apparatus should not be given.

With regard particularly to chemical patents, for compounds or compositions, the general nature of the compound or composition should be given as well as the use thereof, e.g., "The compounds are of the class of alkyl benzene sulfonyl ureas, useful as oral anti-diabetics." Exemplification of a species could be illustrative of members of the class. For processes, the type reaction, reagents and process conditions should be stated, generally illustrated by a single example unless variations are necessary.

Language and Format

The abstract should be in narrative form and generally limited to a single paragraph within the range of 50 to 250 words. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should sufficiently describe the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "This disclosure concerns," "The disclosure defined by this invention," "This disclosure describes," etc.

Responsibility

Preparation of the abstract is the responsibility of the applicant. Background knowledge of the art and an appreciation of the applicant's contribution to the art are most important in the preparation of the abstract. The review of the abstract, for compliance with these guidelines, with any necessary editing and revision on allowance of the application is the responsibility of the examiner.

Sample Abstracts

A heart valve with an annular valve body defining an orifice and having a plurality of struts forming a pair of cages on opposite sides of the orifice. A spherical closure member is captively held within the cages

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and is moved by blood flow between open and closed positions in check valve fashion. A slight leak or backflow is provided in the closed position by making the orifice slightly larger than the closure member. Blood flow is maximized in the open position of the valve by providing an inwardly convex contour on the orifice-defining surfaces of the body. An annular rib is formed in a channel around the periphery of the valve body to anchor a suture ring used to secure the valve within a heart.

A method for sealing, by application of heat, overlapping closure panels of a folding box made from paperboard having an extremely thin coating of moisture-proofing thermoplastic material on opposite surfaces. Heated air is directed at the surfaces to be bonded, the temperature of the air at the point of impact on the surfaces being above the char point of the board. The duration of application of heat is made so brief, by a corresponding high rate of advance of the boxes through the air stream, that the coating on the reverse side of the panels remains substantially non-tacky. The bond is formed immediately after heating within a period of time for any one surface point less than the total time of exposure to heated air of that point. Under such conditions the heat applied to soften the thermoplastic coating is dissipated after completion of the bond by absorption into the board acting as a heat sink without the need for cooling devices.

Amides are produced by reacting an ester of a carboxylic acid with an amine, using as catalyst an alkoxide of an alkali metal. The ester is first heated to at least 75° C. under a pressure of no more than 500 mm. of mercury to remove moisture and acid gases which would prevent the reaction, and then converted to an amide without heating to initiate the reaction.

608.01(c) Background of the Invention [R-41]

The Background of the Invention ordinarily comprises two parts:

(1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions. The statement should be directed to the subject matter of the claimed invention.

(2) Description of the Prior Art: A paragraph(s) describing to the extent practical the state of the prior art known to the applicant, including references to specific prior art where appropriate. Where applicable, the problems involved in the prior art, which are solved by the applicant's invention, should be indicated. See also §§ 608.01(a), 608.01(p) and 707.05(b).

608.01(d) Brief Summary of Invention [R-21]

Rule 73. Summary of the invention. A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, should precede the detailed description. Such summary should, when set forth, be commensurate with the invention as claimed and any object recited should be that of the invention as claimed.

Since the purpose of the brief summary of invention is to apprise the public, and more especially those interested in the particular art to which the invention relates, of the nature of the invention, the summary should be directed to the specific invention being claimed, in contradistinction to mere generalities which would be equally applicable to numerous preceding patents. That is, the subject matter of the invention should be described in one or more clear, concise sentences or paragraphs. Stereotyped general statements that would fit one case as well as another serve no useful purpose and may well be required to be canceled as surplusage, and, in the absence of any illuminating statement, replaced by statements that are directly in point as applicable exclusively to the case in hand.

The brief summary, if properly written to set out the exact nature, operation and purpose of the invention will be of material assistance in aiding ready understanding of the patent in future searches. See § 905.04. The brief summary should be more than a mere statement of the objects of the invention, which statement is also permissible under rule 73.

The brief summary of invention should be consistent with the subject matter of the claims. Note final review of application and preparation for issue, § 1302.

608.01(e) Reservation Clauses Not Permitted

Rule 79. Reservation clauses not permitted. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, but an application disclosing unclaimed subject matter may contain a reference to a later filed application of the same applicant or owned by a common assignee disclosing and claiming that subject matter.

608.01(f) Brief Description of Drawings

Rule 74. Reference to drawings. When there are drawings, there shall be a brief description of the

several views of the drawings and the detailed description of the invention shall refer to the different views by specifying the numbers of the figures, and to the different parts by use of reference letters or numerals (preferably the latter).

The examiner should see to it that the figures are correctly described in the brief description of the drawing, that all section lines used are referred to, and that all needed section lines are used.

608.01(g) Detailed Description of Invention [R–22]

A detailed description of the invention and drawings follows the general statement of invention and brief description of the drawings. This detailed description, required by rule 71, § 608.01, must be in such particularity as to enable any person skilled in the pertinent art or science to make and use the invention without involving extensive experimentation. An applicant is ordinarily permitted to use his own terminology, as long as it can be understood. Necessary grammatical corrections, however, should be required by the examiner, but it must be remembered that an examination is not made for the purpose of securing grammatical perfection.

The reference characters must be properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. In the latter case, the reference character, applied to the "given part," with a prime affixed may advantageously be applied to the modification. Every feature specified in the claims must be illustrated, but there should be no superfluous illustrations.

The description is a dictionary for the claims and should provide clear support or antecedent basis for all terms used in the claims. See rule 75, §§ 608.01(i), 608.01(o), and 1302.01.

NOTE.—Completeness, § 608.01(p).

608.01(h) Mode of Operation of Invention [R–44]

The best mode contemplated by the inventor of carrying out his invention must be set forth in the description. The Office practice is to accept an operative example as sufficient to meet this requirement of the Statute in the absence of information to the contrary.

The question of whether an inventor has or has not disclosed what he feels is his best mode is a question separate and distinct from the question of sufficiency of his disclosure, In re Gay, 135 USPQ 311 (C.C.P.A. 1962); In re Glass, 181 USPQ 31 (C.C.P.A. 1974). See 35 U.S.C. 112 and rule 71(b).

In chemical cases, complete data necessary for the preparation and use of at least one example of the invention should be presented.

NOTE.—Completeness, § 608.01(p).

608.01(i) Claims [R–35]

Rule 75. Claim(s). (a) The specification must conclude with a claim particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention or discovery.

(b) More than one claim may be presented provided they differ substantially from each other and are not unduly multiplied.

(c) When more than one claim is presented, they may be placed in dependent form in which a claim may refer back to and further restrict a single preceding claim. Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

(d) (1) The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. (See rule 58(a).)

(2) See rules 141 to 146 as to claiming different inventions in one application.

(e) Where the nature of the case admits, as in the case of an improvement, any independent claim should contain in the following order, (1) a preamble comprising a general description of all the elements or steps of the claimed combination which are conventional or known, (2) a phrase such as "wherein the improvement comprises," and (3) those elements, steps and/or relationships which constitute that portion of the claimed combination which the applicant considers as the new or improved portion.

NOTE

Numbering of Claims, § 608.01(j).
Form of Claims, § 608.01(m).

Dependent claims, § 608.01(n).
Examination of claims, § 706.
Claims in excess of fee, § 714.10.

608.01(j) Numbering of Claims

Rule 126. Numbering of claims. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with rule 121(b), they must be numbered by the applicant consecutively beginning with the number next following the highest numbered claim previously presented (whether entered or not). When the application is ready for allowance, the examiner, if necessary, will renumber the claims consecutively in the order in which they appear or in such order as may have been requested by applicant.

In a single claim case, the claim is not numbered.

608.01(k) Statutory Requirement of Claims [R–22]

35 U.S.C. 112 requires that the applicant shall particularly point out and distinctly claim the subject matter which he regards as his invention. The portion of the application in which he does this forms the claim or claims. This is an important part of the application, as it is the definition of that for which protection is granted.

608.01(l) Original Claims

In establishing a disclosure, applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it.

Where subject matter not shown in the drawing or described in the specification is claimed in the case as filed, and such original claim itself constitutes a clear disclosure of this subject matter, then the claim should be treated on its merits, and requirement made to amend the drawing and specification to show this subject matter. The claim should not be attacked either by objection or rejection because this subject matter is lacking in the drawing and specification. It is the drawing and specification that are defective; not the claim.

It is of course to be understood that this disclosure in the claim must be sufficiently specific and detailed to support the necessary amendment of the drawing and specification.

608.01(m) Form of Claims [R–22]

While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the clerk. Each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. A claim may be typed with the various elements subdivided in paragraph form.

There may be plural indentations to further segregate subcombinations or related steps. In general, the printed patent copies will follow the format used but printing difficulties or expense may prevent the duplication of unduly complex claim formats.

Reference characters corresponding to elements recited in the detailed description and the drawings may be used in conjunction with the recitation of the same element or group of elements in the claims. The reference characters, however, should be enclosed within parentheses so as to avoid confusion with other numbers or characters which may appear in the claims. The use of reference characters is to be considered as having no effect on the scope of the claims.

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first response, claims varying from the broadest to which he believes he is entitled to the most detailed that he is willing to accept.

Claims should preferably be arranged in order of scope so that the first claim presented is the broadest. Where separate species are claimed, the claims of like species should be grouped together where possible and physically separated by drawing a line between claims or groups of claims. (Both of these provisions may not be practical or possible where several species claims depend from the same generic claim.) Similarly, product and process claims should be separately grouped. Such arrangements are for the purpose of facilitating classification and examination.

The form of claim required in rule 75(e) is particularly adapted for the description of improvement type inventions. It is to be considered a combination claim. The preamble of this form of claim is considered to positively and clearly include all the elements or steps recited therein as a part of the claimed combination.

For rejections not based on prior art see § 706.03.

608.01(n) Dependent Claims [R–22]

Rule 75(c), reads as follows:

When more than one claim is presented, they may be placed in dependent form in which a claim may refer

back to and further restrict a single preceding claim. Claims in dependent form shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

For applications filed on or after October 25, 1965, the initial determination, for fee purposes, as to whether a claim is dependent must be made by persons other than examiners; it is necessary, at that time, to accept as dependent virtually every claim which refers to another claim, without determining whether there is actually a true dependent relationship. Such acceptance does not, however, preclude a subsequent holding by the examiner that a claim is not a proper dependent claim. Any claim which is in dependent form but which is so worded that it, in fact is not, as for example it does not include every limitation of the claim on which it depends, will be required to be canceled as not being a proper dependent claim; and cancellation of any further claim depending on such a dependent claim will be similarly required. The applicant may thereupon amend the claims to place them in proper dependent form, or may redraft them as independent claims, upon payment of any necessary additional fee.

An essential characteristic of a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112) or in other words that it shall not conceivably be infringed by anything which would not also infringe the basic claim. Thus, for example, if claim 1 recites the combination of elements *a*, *b*, *c* and *d*, a claim reciting the structure of claim 1 in which *d* was omitted or replaced by *e* would not be a proper dependent claim, even though it placed further limitations on the remaining elements or added still other elements.

The fact that a dependent claim which is otherwise proper might require a separate search or be separately classified from the claim on which it depends would not render it an improper dependent claim, although it might result in a requirement for restriction.

The fact that the independent and dependent claims are in different statutory classes does not, in itself, render the latter improper. Thus, if claim 1 recites a specific product, a claim for the method of making the product of claim 1 in a particular manner would be a proper dependent claim since it could not be infringed without infringing claim 1. Similarly, if claim 1 recites a method of making a product, a claim for a product made by the method of claim 1 could be a proper dependent claim. On the other hand, if claim 1 recites a method of making a specified product, a claim to the product set forth in claim 1 would not be a proper dependent claim if the product might be made in other ways. Note, that since rule 75(c) requires the dependent claim to "further restrict" the preceding claim, this rule does not apply to product-by-process claims.

Claim Form and Arrangement

A dependent claim 2 could read as follows:

2. The product of claim 1 in which . . .

A dependent claim cannot directly refer back to two or more preceding claims. For example, a claim reading as follows:

7. A machine as specified in claims 5 or 6 (or, 5 and 6) in which . . .

is not permitted. Such a claim disguises the true number of claims, since it is in reality two claims. It is also alternative.

However, a series of dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a *dependent* claim should not be separated therefrom by any claim which does not also depend from said "dependent" claim. It should be kept in mind that a dependent claim may refer back to *any* preceding *independent* claim. These are the only restrictions with respect to the sequence of claims and, in general, applicant's sequence should not be changed. See § 608.01(j).

Rejection and Objection

If the base claim has been cancelled, a claim which is directly or indirectly dependent thereon should be rejected as incomplete. If the base claim is rejected, the dependent claim should be *objected to* rather than rejected, if it is otherwise allowable.

Examiners are reminded that a dependent claim is directed to a combination including everything recited in the base claim *and* what is recited in the dependent claim. It is this combination that must be compared with the prior art, exactly as if it were presented as one independent claim.

The numbering of dependent claims and the numbers of preceding claims referred to in dependent claims should be carefully checked when claims are renumbered upon allowance.

608.01(o) Basis for Claim Terminology in Description [R–22]

The meaning of every term used in any of the claims should be apparent from the descriptive portion of the specification with clear disclosure as to its import, and in mechanical cases it should be identified in the descriptive portion of the specification by reference to the drawing, designating the part or parts therein

to which the term applies. A term used in the claims may be given a special meaning in the description. No term may be given a meaning repugnant to the usual meaning of the term.

Usually the terminology of the original claims follows the nomenclature of the specification, but sometimes in amending the claims or in adding new claims, new terms are introduced that do not appear in the specification. The use of a confusing variety of terms for the same thing should not be permitted.

New claims and amendments to the claims already in the case should be scrutinized not only for new matter but also for new terminology. While an applicant is not limited to the nomenclature used in the application as filed, yet whenever by amendment of his claims, he departs therefrom, he should make appropriate amendment of his specification so as to have therein clear support or antecedent basis for the new terms appearing in the claims. This is necessary in order to insure certainty in construing the claims in the light of the specification. Ex parte Kotler 1901 C.D. 62; 95 O.G. 2684. See rule 75, §§ 608.01(i) and 1302.01.

608.01(p) Completeness [R–22]

Newly filed applications obviously failing to disclose an invention with the clarity required are discussed in § 702.01.

A disclosure in an application, to be complete, must contain such description and details as to enable any person skilled in the art or science to which the invention pertains to make and use the invention.

While the prior art setting may be mentioned in general terms, the essential novelty, the essence of the invention, must be described in such details, including proportions and techniques where necessary, as to enable those persons skilled in the art to make and utilize the invention.

Specific operative embodiments or examples of the invention must be set forth. Examples and description should be of sufficient scope as to justify the scope of the claims. Markush claims must be provided with support in the disclosure for each member of the Markush group. Where the constitution and formula of a chemical compound is stated only as a probability or speculation, the disclosure is not sufficient to support claims identifying the compound by such composition or formula.

A complete disclosure should include a statement of utility. This usually presents no problem in mechanical cases. In chemical cases, varying degrees of specificity are required.

A disclosure involving a new chemical compound or composition must teach persons skilled in the art how to make the compound or composition. Incomplete teachings may not be completed by reference to subsequently filed applications.

Guidelines for Considering Disclosures of Utility in Drug Cases

General

These guidelines are set down to provide uniform handling of applications disclosing drug or pharmaceutical utility. They are intended to guide patent examiners and patent applicants as to criteria for utility statements. They deal with fundamental questions and are subject to revision and amendment if future case law indicates this to be necessary.

The following two basic principles shall be followed in considering matters relating to the adequacy of disclosure of utility in drug cases:

(1) The same basic principles of patent law which apply in the field of chemical arts shall be applicable to drugs, and

(2) The Patent Office shall confine its examination of disclosure of utility to the application of patent law principles, recognizing that other agencies of the Government have been assigned the responsibility of assuring conformance to the standards established by statute for the advertisement, use, sale or distribution of drugs.[1]

A drug is defined by 21 U.S.C. 321(g)

> The term "drug" means (A) articles recognized in the official United States Pharmacopeia, official Homeopathic Pharmacopeia of the United States, or official National Formulary, or any supplement to any of them; and (B) articles intended for use in the diagnosis, cure, mitigation, treatment, or prevention of disease in man or other animals; and (C) articles (other than food) intended to affect the structure or any function of the body of man or other animals; and (D) articles intended for use as a component of any articles specified in clause (A), (B), or (C); but does not include devices or their components, parts, or accessories.

In addition, compositions adapted to be applied to or used by human beings, e.g., cosmetics, dentifrices, mouthwashes, etc., may be treated in the same manner as drugs subject to the conditions stated.

Any proof of a stated utility or safety required pursuant to these guidelines may be

[1] *In re Krimmel*, 48 CCPA 1116, 292 F.2d 948, 130 USPQ 215; *In re Hartop et al.*, 50 CCPA 780, 311 F.2d 249, 135 USPQ 419.

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incorporated in the application as filed, or may be subsequently submitted by affidavit if and when required. The Patent Office, in reaching its own independent decisions on questions of utility and how to use under 35 U.S.C. 101 and 112, will continue to avail itself of assistance and information from the Secretary of Health, Education, and Welfare as authorized by 21 U.S.C. 372(b), when necessary.

In accordance with the basic principles set forth above, the following procedures shall be followed in examining patent applications in the drug field with regard to disclosures relating to utility.

35 U.S.C. 101

Utility must be definite and in currently available form,[2] not merely for further investigation or research but commercial availability is not necessary. Mere assertions such as "therapeutic agents," [3] "for pharmaceutical purposes," [4] "biological activity," [5] "intermediates," [6] and for making further unspecified preparations are regarded as insufficient.

If the asserted utility of a compound is believable on its face to persons skilled in the art in view of the contemporary knowledge in the art, then the burden is upon the examiner to give adequate support for rejections for lack of utility under this section.[7] On the other hand, incredible statements [8] or statements deemed unlikely to be correct by one skilled in the art [9] in view of the contemporary knowledge in the art will require adequate proof on the part of applicants for patents.

Proof of utility under this section may be established by clinical or *in vivo* or *in vitro* data, or combinations of these, which would be convincing to those skilled in the art.[10] More particularly, if the utility relied on is directed *solely* to the treatment of humans, evidence of utility, if required, must generally be clinical evidence,[11] although animal tests may be adequate where the art would accept these as appropriately correlated with human utility.[12] If there is no assertion of human utility,[13] or if there is an assertion of animal utility,[14] operativeness for use on standard test animals is adequate for patent purposes.

Exceptions exist with respect to the general rule relating to the treatment of humans. For example, compositions whose properties are generally predictable from a knowledge of their components, such as laxatives, antacids and certain topical preparations, require little or no clinical proof.[15]

Although absolute safety is not necessary to meet the utility requirement under this section, a drug which is not sufficiently safe under the conditions of use for which it is said be be effective will not satisfy the utility requirement.[16] Proof of safety shall be required only in those cases where adequate reasons can be advanced by the examiner for believing that the drug is unsafe, and shall be accepted if it establishes a reasonable probability of safety.

35 U.S.C. 112

A mere statement of utility for pharmacological or chemotherapeutic purposes may raise a question of compliance with section 112, particularly ". . . as to enable any person skilled in the art to which it pertains . . . to use the same." If the statement of utility contains within it a connotation of how to use, and/or the art recognizes that standard modes of administration are contemplated, section 112 is satisfied.[17] If the use disclosed is of such nature that the art is unaware of successful treatments with chemically analogous compounds, a more complete statement of how to use must be supplied than if such analogy were not present.[18] It is not necessary to specify the dosage or method of use if it is obvious to one skilled in the art that such information could be obtained without undue experimentation.[17]

With respect to the adequacy of disclosure that a claimed genus possesses an asserted utility representative examples together with a statement applicable to the genus as a whole will ordinarily be sufficient if it would be deemed likely by one skilled in the art, in view of contemporary knowledge in the art, that the claimed genus would possess the asserted

[2] *Brenner* v. *Manson*, 383 U.S. 519, 148 USPQ 689.
[3] Cf. *In re Lorenz et al.*, 49 CCPA 1227, 305 F.2d 875, 134 USPQ 312; cf. *Ex parte Brockmann et al.*, 127 USPQ 57.
[4] *In re Diedrich*, 50 CCPA 1355, 318 F.2d 946, 138 USPQ 128.
[5] *In re Kirk et al.*, 54 CCPA 1119, 153 USPQ 48; *Ex parte Lanham*, 135 USPQ 106.
[6] *In re Joly et al.*, 54 CCPA 1159, 153 USPQ 45; *In re Kirk et al.*, 54 CCPA 1119; 153 USPQ 48.
[7] *In re Gazave*, 54 CCPA 1524, 154 USPQ 92.
[8] *In re Citron*, 51 CCPA 852, 325 F.2d 248, 139 USPQ 516; *In re Oberweger*, 28 CCPA 749, 115 F.2d 826, 47 USPQ 455; *Ex parte Moore et al.*, 128 USPQ 8.
[9] *In re Ruskin*, 53 CCPA 872, 354 F.2d 395, 148 USPQ 221; *In re Pottier*, 54 CCPA 1293, 153 USPQ 407; *In re Novak et al.*, 49 CCPA 1283, 306 F.2d 924, 134 USPQ 335. See also, *In re Irons*, 52 CCPA 938, 340 F.2d 974, 144 USPQ 351.
[10] *In re Irons*, 52 CCPA 938, 340 F.2d 924, 144 USPQ 351; *Ex parte Paschall*, 88 USPQ 131; *Ex parte Pennell et al.*, 99 USPQ 56; *Ex parte Ferguson*, 117 USPQ 229; *Ex parte Timmis*, 123 USPQ 581.
[11] *Ex parte Timmis*, 123 USPQ 581.
[12] *In re Hartop et al.*, 50 CCPA 780, 311 F.2d 249, 135 USPQ 419; *Ex parte Murphy*, 134 USPQ 134.
[13] Cf. *Blicke* v. *Treves*, 44 CCPA 753, 241 F.2d 718, 112 USPQ 472; *In re Krimmel*, 48 CCPA 1116, 292 F.2d 948, 130 USPQ 215; *In re Dodson*, 48 CCPA 1125, 292 F.2d 943, 130 USPQ 224; *In re Hitchings*, 52 CCPA 1141, 342 F.2d 80, 144 USPQ 637.
[14] *In re Bergel et al.*, 48 CCPA 1102, 292, F.2d 955, 130 USPQ 206; *Ex parte Melvin*, 155 USPQ 47.
[15] *Ex parte Harrison et al.*, 129 USPQ 172; *Ex parte Lewin*, 140 USPQ 70.
[16] *In re Hartop et al.*, 50 CCPA 780, 311 F.2d 249, 135 USPQ 419.
[17] Cf. *In re Johnson*, 48 CCPA 733, 282 F.2d 370, 127 USPQ 216; *In re Hitchings et al.*, 52 CCPA 1141, 342 F.2d 80, 144 USPQ 637.
[18] *In re Mourca et al.*, 52 CCPA 1363, 345 F.2d 595, 145 USPQ 452; *In re Schmidt et al.*, 54 CCPA 1577, 153 USPQ 640.

utility.[19] Proof of utility will be required for other members of the claimed genus only in those cases where adequate reasons can be advanced by the examiner for believing that the genus as a whole does not possess the asserted utility. Conversely, a sufficient number of representative examples, if disclosed in the prior art will constitute a disclosure of the genus to which they belong.

In the case of mixtures including a drug as an ingredient, or mixtures which are drugs, or methods of treating a specific condition with a drug, whether old or new, a specific example should ordinarily be set forth, which should include the organism treated. In appropriate cases, such an example may be inferred from the disclosure taken as a whole and/or the knowledge in the art (e.g., gargle).

Where the claimed compounds are capable of several different utilities and one use is adequately described in accordance with these guidelines, additional utilities will be investigated for compliance with sections 101 and 112 only if not believable on their face to those of ordinary skill in the art in view of the contemporary knowledge of the art. Failure to meet these standards may result in a requirement to cancel such additional utilities.[20]

Incorporation By Reference

An application for a patent when filed may incorporate "essential material" by reference to (1) a United States patent, or (2) an allowed U.S. application, subject to the conditions set forth below. "Essential material" is defined as that which is necessary to (1) support the claims, or (2) for adequate disclosure of the invention (35 U.S.C. 112). "Essential material" may not be incorporated by reference to (1) patents issued by foreign countries, to (2) nonpatent publications, to (3) a patent or application which itself incorporates "essential material" by reference or to (4) a foreign application. See In re Fouche, 169 USPQ 429.

Nonessential subject matter may be incorporated by reference to (1) patents issued by the United States or foreign countries, (2) prior filed, commonly owned U.S. applications or (3) nonpatent publications, for purposes of indicating the background of the invention or illustrating the state of the art.

The referencing application must include (1) an abstract, (2) a brief summary of the invention, (3) an identification of the referenced patent or application, (4) at least one view in the drawing in those applications admitting of a drawing, and (5) one or more claims. Where appropriate it would be advisable to direct particular attention to specific portions of the referenced patent or application.

Complete Disclosure Filed

If an application is filed with a complete disclosure, essential material may be cancelled by amendment and the *same* material substituted by reference to a patent or a pending and commonly owned allowed application in which the issue fee has been paid. The amendment must be accompanied by an affidavit or declaration executed by the applicant or his attorney or agent stating that the material cancelled from the application is the *same* material that has been incorporated by reference.

Issue Fee Paid

If an application incorporates essential material by reference to a U.S. patent or a pending and commonly owned allowed U.S. application for which the issue fee has been paid, applicant will be required prior to examination to furnish the Patent Office with a copy of the referenced material together with an affidavit or declaration executed by the applicant or his attorney or agent stating that the copy consists of the *same* material incorporated by reference in the referencing application. However, if a soft copy of a U.S. patent is furnished, no affidavit or declaration is required.

Issue Fee Not Paid

If an application incorporates essential material by reference to a pending and commonly owned application other than one in issue with the fee paid, applicant will be required prior to examination to amend the disclosure of the referencing application to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant or his attorney or agent stating that the amendatory material consists of the *same* material incorporated by reference in the referencing application.

Improper Incorporation

The filing date of any application wherein essential material is improperly incorporated

[19] *In re Oppenauer*, 31 CCPA 1248, 143 F.2d 974, 62 USPQ 297; *In re Cavallito et al.*, 48 CCPA 711, 282 F.2d 357, 127 USPQ 202; *In re Cavallito et al.*, 48 CCPA 720, 282 F.2d 363, 127 USPQ 206; *In re Schmidt*, 48 CCPA 1140, 293 F.2d 274, 130 USPQ 404; *In re Cavallito*, 49 CCPA 1335, 306 F.2d 505, 134 USPQ 370; *In re Surrey*, 54 CCPA 855, 370 F.2d 349, 151 USPQ 724; *In re Lund et al.*, 54 CCPA 1361, 153 USPQ 625.

[20] *Ex parte Lanham*, 121 USPQ 223; *Ex parte Moore et al.*, 128 USPQ 8; *In re Citron*, 51 CCPA 852, 325 F.2d 248, 139 USPQ 516; *In re Gottlieb et al.*, 51 CCPA 1114, 328 F.2d 1016, 140 USPQ 665.

by reference to a foreign application or patent or to a publication will not be affected because of the presence of such reference. In such a case, the applicant will be required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or his attorney or agent, stating that the amendatory material consists of the *same* material incorporated by reference in the referencing application. In re Hawkins, 179 USPQ 157; In re Hawkins, 179 USPQ 163; In re Hawkins, 179 USPQ 167, (CCPA, 1973).

Reliance upon a commonly assigned copending application by a different inventor may ordinarily be made for the purpose of completing the disclosure. See In re Fried et al, 141 USPQ 27; 51 CCPA 1118 and General Electric Company v. Brenner, 159 USPQ 335; 407 F. 2d 1258.

Since a disclosure must be complete as of the filing date, subsequent publications or subsequently filed applications cannot be relied upon to establish a constructive reduction to practice.

DEPOSIT OF MICROORGANISMS

Some inventions which are the subject of patent applications depend on the use of microorganisms which must be described in the specification in accordance with 35 U.S.C. 112. No problem exists when the microorganisms used are known and readily available to the public. When the invention depends on the use of a microorganism which is not so known and readily available, applicants must take additional steps to comply with the requirements of § 112.

In re Argoudelis, et al., 168 USPQ 99 (CCPA, 1970), accepted a procedure for meeting the requirements of 35 U.S.C. 112. Accordingly, the Patent Office will accept the following as complying with the requirements of § 112 for an adequate disclosure of the microorganism required to carry out the invention:

(1) the applicant, no later than the effective U.S. filing date of the application, has made a deposit of a culture of the microorganism in a depository affording permanence of the deposit and ready accessibility thereto by the public if a patent is granted, under conditions which assure (a) that access to the culture will be available during pendency of the patent application to one determined by the Commissioner to be entitled thereto under rule 14 of the Rules of Practice in Patent Cases and 35 U.S.C. 122, and (b) that all restrictions on the availability to the public of the culture so deposited will be irrevocably removed upon the granting of the patent;

(2) such deposit is referred to in the body of the specification as filed and is identified by deposit number, name and address of the depository, and the taxonomic description to the extent available is included in the specification; and

(3) the applicant or his assigns has provided assurance of permanent availability of the culture to the public through a depository meeting the requirements of (1). Such assurance may be in the form of an averment under oath or by declaration by the applicant to this effect.

A copy of the applicant's contract with the depository may be required by the examiner to be made of record as evidence of making the culture available under the conditions stated above.

NOTE.—For problems arising from the designation of materials by trademarks and trade names, see § 608.01(v). [R–39]

608.01(q) Substitute or Rewritten Specification [R–26]

Rule 125. Substitute specification. If the number or nature of the amendments shall render it difficult to consider the case, or to arrange the papers for printing or copying, the examiner may require the entire specification or claims, or any part thereof, to be rewritten. A substitute specification will ordinarily not be accepted unless it has been required by the examiner.

The specification is sometimes in such faulty English that a new specification is necessary, but new specifications cumber the record and require additional reading, and hence should not be required or accepted except in extreme cases.

A substitute specification that has not been required, and is not needed, is not entered. See § 714.20.

New matter in amendment, see § 608.04.

Application prepared for issue, see § 1302.02.

608.01(r) Derogatory Remarks About Prior Art in Specification

The applicant may refer to the general state of the art and the advance thereover made by his invention, but he is not permitted to make derogatory remarks concerning the inventions of others.

608.01(s) Restoration of Canceled Matter [R–26]

Canceled text in the specification or a canceled claim can be restored only by presenting

the cancelled matter as a new insertion. See rule 124, § 714.24.

608.01(t) Use in Subsequent Application [R–29]

A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application, rule 79, § 608.01(e).

While a specification cannot be transferred to another application, drawings may be transferred from a prior application to a later case by the same inventor if they are no longer needed in the prior application, note §§ 608.02(i) to 608.02(k).

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608.01(u) Use of Formerly Filed Incomplete Application [R–26]

Parts of an incomplete application which have been retained by the Office may be used as part of a complete application if the missing parts are later supplied. See §§ 506 and 506.01.

608.01(v) Trademarks and Names Used in Trade [R–26]

The expressions "trademarks" and "names used in trade" as used below have the following meanings:

Trademark: a word, letter, symbol or device adopted by one manufacturer or merchant and used to identify and distinguish his product from those of others. It is a proprietary word pointing distinctly to the product of one producer.

Names Used in Trade: a nonproprietary name by which an article or product is known and called among traders or workers in the art, although it may not be so known by the public generally. Names used in trade do not point to the product of one producer, but they identify a single article or product irrespective of producer.

Names used in trade are permissible in patent applications if:

(1) Their meanings are established by an accompanying definition which is sufficiently precise and definite to be made a part of a claim, or

(2) In this country, their meanings are well known and satisfactorily defined in the literature.

Condition (1) or (2) must be met at the time of filing of the complete application.

Trademarks

The relationship between a trademark and the product it identifies is sometimes indefinite, uncertain and arbitrary. The formula or characteristics of the product may change from time to time and yet it may continue to be sold under the same trademark. In patent specifications, every element or ingredient of the product should be set forth in positive, exact, intelligible language, so that there will be no uncertainty as to what is meant. Arbitrary trademarks which are liable to mean different things at the pleasure of manufacturers do not constitute such language.

However, if the product to which the trademark refers is otherwise set forth in such language that its identity is clear the examiners are authorized to permit the use of the trademark if it is distinguished from common descriptive nouns by capitalization. If the trademark has a fixed and definite meaning it constitutes sufficient identification unless some physical or chemical characteristic of the article or material is involved in the invention. In that event as also in those cases where the trademark has no fixed and definite meaning, identification by scientific or other explanatory language is necessary.

The matter of sufficiency of disclosure must be decided on an individual case by case basis. In re Metcalfe and Lowe, 161 USPQ 789; 869 O.G. 691.

Where the identification of a trademark is introduced by amendment it must be restricted to the characteristics of the product known at the time the application was filed to avoid any question of new matter.

If proper identification of the product sold under a trademark, or a product referred to only by a name used in trade, is omitted from the specification and such identification is deemed necessary under the principles set forth above, the examiner should hold the disclosure insufficient and reject on the ground of insufficient disclosure any claims based on the identification of the product merely by trademark or by the name used in trade. If the product cannot be otherwise defined, an amendment defining the process of its manufacture may be permitted. Such amendments must be supported by satisfactory showings establishing that the specific nature or process of manufacture of the product as set forth in the amendment was known at the time of filing of the application.

Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks. The examiner should not permit the use of language such as "the product X (a descriptive name) commonly known as Y (trademark)" since such language does not bring out the fact that the latter is a trademark. Language such as "the product X (a descriptive name) sold under the trademark Y" is permissible.

The use of a trademark in the title of an application should be avoided as well as the use of a trademark coupled with the word "type"; i.e., "Band-Aid type bandage."

The owner of a trademark may be identified in the specification.

Examiners should reply to all trademark misuse complaint letters and forward a copy to the editor of this manual.

See appendix I for a partial listing of trademarks and the particular goods to which they apply.

608.02 Drawing [R–40]

35 U.S.C. 113. Drawings. When the nature of the case admits, the applicant shall furnish a drawing.

Rule 81. Drawings required. The applicant for patent is required by statute to furnish a drawing of his invention whenever the nature of the case admits of it; this drawing must be filed with the application. Illustrations facilitating an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views) may also be furnished in the same manner as drawings and may be required by the Office when considered necessary or desirable.

Rule 84. Standards for drawings.

(a) *Paper and ink.* Drawings must be made upon pure white paper of a thickness corresponding to two-ply or three-ply bristol board. The surface of the paper must be calendered and smooth and of a quality which will permit erasure and correction with India ink. India ink, or its equivalent in quality, must be used for pen drawings to secure perfectly black solid lines. The use of white pigment to cover lines is not acceptable.

(b) *Size of sheet and margins.* The size of a sheet on which a drawing is made must be exactly 8½ by 14 inches (21.6 by 35.6 cm.). One of the shorter sides of the sheet is regarded as its top. The drawing must include a top margin of 2 inches (5.1 cm.) and bottom and side margins of one-quarter inch (6.4 mm.) from the edges, thereby leaving a "sight" precisely 8 by 11¾ inches (20.3 by 29.8 cm.). Margin border lines are not permitted. All work must be included within the "sight". The sheets may be provided with two ¼-inch (6.4 mm.) diameter holes having their centerlines spaced eleven-sixteenths inch (17.5 mm.) below the top edge and 2¾ inches (7.0 cm.) apart, said holes being equally spaced from the respective side edges.

(c) *Character of lines.* All drawings must be made with drafting instruments or by a process which will give them satisfactory reproduction characteristics. Every line and letter must be absolutely black and permanent; the weight of all lines and letters must be heavy enough to permit adequate reproduction. This direction applies to all lines however fine, to shading, and to lines representing cut surfaces in sectional views. All lines must be clean, sharp, and solid, and fine or crowded lines should be avoided. Solid black should not be used for sectional or surface shading. Freehand work should be avoided wherever it is possible to do so.

(d) *Hatching and shading.* (1) Hatching should be made by oblique parallel lines, which may be not less than about one-twentieth inch (1.3 mm.) apart.

(2) Heavy lines on the shade side of objects should be used except where they tend to thicken the work and obscure reference characters. The light should come from the upper left hand corner at an angle of 45°. Surface delineations should be shown by proper shading, which should be open.

(c) *Scale.* The scale to which a drawing is made ought to be large enough to show the mechanism without crowding when the drawing is reduced in reproduction, and views of portions of the mechanism on a larger scale should be used when necessary to show details clearly; two or more sheets should be used if one does not give sufficient room to accomplish this end, but the number of sheets should not be more than is necessary.

(f) *Reference characters.* The different views should be consecutively numbered figures. Reference numerals (and letters, but numerals are preferred) must be plain, legible and carefully formed, and not be encircled. They should, if possible, measure at least one-eighth of an inch (3.2 mm.) in height so that they may bear reduction to one twenty-fourth of an inch (1.1 mm.); and they may be slightly larger when there is sufficient room. They must not be so placed in the close and complex parts of the drawing as to interfere with a thorough comprehension of the same, and therefore should rarely cross or mingle with the lines. When necessarily grouped around a certain part, they should be placed at a little distance, at the closest point where there is available space, and connected by lines with the parts to which they refer. They should not be placed upon hatched or shaded surfaces but when necessary, a blank space may be left in the hatching or shading where the character occurs so that it shall appear perfectly distinct and separate from the work. The same part of an invention appearing in more than one view of the drawing must always be designated by the same character, and the same character must never be used to designate different parts.

(g) *Symbols, legends.* Graphical drawing symbols and other labeled representations may be used for conventional elements when appropriate, subject to approval by the Office. The elements for which such symbols and labeled representations are used must be adequately identified in the specification. While descriptive matter on drawings is not permitted, suitable legends may be used, or may be required, in proper cases, as in diagrammatic views and flowsheets or to show materials or where labeled representations are employed to illustrate conventional elements. Arrows may be required, in proper cases, to show direction of movement. The lettering should be as large as, or larger than, the reference characters.

(h) [Revoked]

(i) *Views.* The drawing must contain as many figures as may be necessary to show the invention; the figures should be consecutively numbered if possible in the order in which they appear. The figures may be plan, elevation, section, or perspective views, and detail views of portions or elements, on a larger scale if necessary, may also be used. Exploded views, with the separated parts of the same figure embraced by a bracket, to show the relationship or order of assembly of various parts are permissible. When necessary, a

view of a large machine or device in its entirety may be broken and extended over several sheets if there is no loss in facility of understanding the view (the different parts should be identified by the same figure number but followed by the letters, *a*, *b*. *c*. etc., for each part). The plane upon which a sectional view is taken should be indicated on the general view by a broken line, the ends of which should be designated by numerals corresponding to the figure number of the sectional view and have arrows applied to indicate the direction in which the view is taken. A moved position may be shown by a broken line superimposed upon a suitable figure if this can be done without crowding, otherwise a separate figure must be used for this purpose. Modified forms of construction can only be shown in separate figures. Views should not be connected by projection lines nor should centerlines be used.

(j) *Arrangement of views.* All views on the same sheet must stand in the same direction and should, if possible, stand so that they can be read with the sheet held in an upright position. If views longer than the width of the sheet are necessary for the clearest illustration of the invention, the sheet may be turned on its side so that the two-inch (5.1 cm.) margin is on the right-hand side. One figure must not be placed upon another or within the outline of another.

(k) *Figure for Official Gazette.* The drawing should, as far as possible, be so planned that one of the views will be suitable for publication in the Official Gazette as the illustration of the invention.

(l) *Extraneous matter.* An inventor's, agent's, or attorney's name, signature, stamp, or address, or other extraneous matter, will not be permitted upon the face of a drawing, within or without the margin, except that identifying indicia (attorney's docket number, inventor's name, number of sheets, etc.) should be placed within three-fourths inch (19.1 mm.) of the top edge and between the hole locations defined in paragraph (b) of this rule. Authorized security markings may be placed on the drawings provided they be outside the illustrations and are removed when the material is declassified.

(m) *Transmission of drawings.* Drawings transmitted to the Office should be sent flat, protected by a sheet of heavy binder's board, or may be rolled for transmission in a suitable mailing tube; but must never be folded. If received creased or mutilated, new drawings will be required. (See rule 152 for design drawings, 165 for plant drawings, and 174 for reissue drawings.)

Rule 86. Draftsman to make drawings. (a) Applicants are advised to employ competent draftsmen to make their drawings.

(b) The Office may furnish the drawings at the applicant's expense as promptly as its draftsmen can make them, for applicants who cannot otherwise conveniently procure them. (See rule 21.)

Design patent drawings, rule 152, § 1503.02.
Plant patent drawings, rule 165, § 1606.

Reissue application drawings, §§ 608.02(k) and 1401.05.

Each sheet of drawing must bear the "Approved" stamp of the Draftsman before the application is allowed.

The Record Services Branch of the Office Services Division has charge of the drawings in patented cases. Canceled sheets, however, are not retained with the patented drawings but are filed with the abandoned files and drawings in the Abandoned Files Unit.

See: Correction of drawings, § 608.02(p). Prints, preparation and distribution, §§ 508 and 608.02(m). Prints, Return of drawing, § 608.02 (y). Signature to the drawing is treated in § 605.04(h). For pencil notations of classification and name or initials of assistant examiner to be placed on drawings see § 717.03.

The filing of a divisional case under the provisions of rule 60 (unexecuted case), does not obviate the need for formal bristolboard drawings. See § 608.02(b).

Drawing Symbols

Rule 84(g) indicates that graphic drawing symbols and other labeled representations may be used for conventional elements where appropriate, subject to approval by the Office. Also, suitable legends may be used, or may be required, in proper cases.

The "Rules of Practice" and Title 37, Code of Federal Regulations pamphlets include a section entitled "Symbols for Draftsman" which shows various symbols which may be used in patent application drawings. Since this set of symbols is rather limited in scope, attention is called to the below listed publications.

These publications have been reviewed by the Office and the symbols therein are considered to be generally acceptable in patent drawings. Although the Office will not "approve" all of the listed symbols as a group because their use and clarity must be decided on a case-by-case basis, these publications may be used as guides when selecting graphic symbols. Overly specific symbols should be avoided. Symbols with unclear meanings should be labeled for clarification.

These publications are available from the American National Standards Institute Inc., 1430 Broadway, New York, New York 10018.

The publications reviewed are the following:

Y32.2–1970 Graphic Symbols for Electrical & Electronics Diagrams

Y32.10–1967 Graphic Symbols for Fluid Power Diagrams

Y32.11–1961 Graphic Symbols for Process Flow Diagrams in the Petroleum & Chemical Industries

Y32.14–1962 Graphic Symbols for Logic Diagrams
Z32.2.3–1949 (R1953) Graphic Symbols for Pipe Fittings, Valves and Piping
Z32.2.4–1949 (R1953) Graphic Symbols for Heating, Ventilating & Air Conditioning
Z32.2.6–1950 Graphic Symbols for Heat-Power Apparatus

Applications Filed Without Drawings

Applications filed without drawing are initially inspected to determine whether or not a drawing, under the statute, is necessary before the applicant can be given a filing date. Doubtful cases are referred to the group director for decision as to the need for such a drawing. If, after an application without a drawing has been received in the group, it is clear that a drawing is required, the application should be returned to the Application Division along with a memorandum indicating that a drawing is required. It has long been the practice to accept a process case (that is, a case having only process or method claims) which is filed without a drawing. The same practice has been followed in composition cases. Other situations where drawings are usually not considered essential for a filing date are:

I. *Coated articles or products.* Where the invention resides solely in coating or impregnating a conventional sheet, e.g., paper or cloth, or an article of known and conventional character with a particular composition, the application containing claims to the coated or impregnated sheet or article, unless significant details of structure or arrangement are involved in the article claims.

II. *Articles made from a particular material or composition.* Where the invention consists in making an article of a particular material or composition, unless significant details of structure or arrangement are involved in the article claims.

III. *Laminated structures.* Where the claimed invention involves only laminations of sheets (and coatings) of specified material unless significant details of structure or arrangement (other than the mere order of the layers) are involved in the article claims.

IV. *Articles, apparatus or systems where sole distinguishing feature is presence of a particular material.* Where the invention resides solely in the use of a particular material in an otherwise old article, apparatus or system recited broadly in the claims; for example,

a. Hydraulic system distinguished solely by the use therein of a particular hydraulic fluid;

b. Packaged sutures wherein the structure and arrangement of the package are conventional and the only distinguishing feature is the use of a particular fluid.

Illustration Subsequently Required

The acceptance of an application without a drawing does not preclude the examiner from requiring an illustration in the form of a drawing under the second sentence of rule 81. In requiring such a drawing, the examiner should clearly indicate that the requirement is made under the second sentence of rule 81, and be careful not to state that he is doing so "because the nature of the case admits" of a drawing, as that might give rise to an erroneous impression as to the completeness of the application when filed. Examiners making such requirements are to specifically require, as a part of the applicant's next response, at least an ink sketch or permanent print of any drawing proposed in response to the requirement, even though no allowable subject matter is yet indicated. This will afford the examiner an early opportunity to determinee the sufficiency of the illustration and the absence of new matter. See rule 118. The description should of course be amended to contain reference to the new illustration. This may obviate further correspondence where an amendment places the case in condition for allowance, except for the formal requirement relating to the drawing. In the event of a final determination that there is nothing patentable in the case, the sketch and authorization for entry will not be forwarded to the Drafting Division.

Photographs

Photographs are not considered to be drawings. Photographs are not acceptable for a filing date nor for any purpose except as exhibits unless they come within the special categories set forth in the paragraph immediately below. Photolithographs of photographs and photographs mounted on proper size bristol-board are never acceptable. See In re Taggart et al., 1957 C.D. 6; 725 O.G. 397 and In re Myers, 1959 C.D. 2; 738 O.G. 947.

Special Categories

The Patent Office is willing to accept black and white photographs or photomicrographs (not photolithographs or other reproductions of photographs) printed on sensitized paper in lieu of India ink drawings, to illustrate inventions which are incapable of being accurately or adequately depicted by India ink drawings, restricted to the following categories: crystalline structures, metallurgical microstructures, textile fabrics, grain structures and ornamen-

tal effects. The photographs or photomicrographs must show the invention more clearly than they can be done by India ink drawings and otherwise comply with the rules concerning drawings.

Such photographs to be acceptable must be made on photographic paper having the following characteristics which are generally recognized in the photographic trade: double weight paper with a surface described as smooth; tint, white.

Notifying Applicant

If the drawings are informal, but may be admitted for examination purposes the draftsman indicates on 2-part form, PO–948, what the informalities are and whether they can be corrected or whether new drawings are required. In either case the drawings are accepted as satisfying the requirements of rule 51.

The examiners are directed to advise the applicants (see § 707.07(a)) in the first Office action of the conditions which render the drawing informal, and when indicated, that such drawings can be corrected so as to be acceptable, but will not, in any case, require new drawings because of their execution unless the necessity therefor shall have been indicated by the draftsman.

As soon as allowable subject matter is found, or an appeal is filed, the requirement for new drawings should be insisted upon. Before writing the action, the draftsman should be consulted to ascertain if, at that time, the new drawing could be prepared by the Patent Office on request and, if so, the estimate of cost should be included in the action. Otherwise, the action should state:

> "Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the Drafting Division of the Patent Office does not have the facilities at the present time, for preparing new drawings".

This procedure, by avoiding a fruitless request to have the Drafting Division prepare the new drawing, will promote earlier issuance of the patent.

ADDITIONAL ILLUSTRATION

The examiner may require additional drawings for the purpose of illustrating the disclosure.

When a necessary additional illustration is small and may be added to the drawings on file, an additional sheet of drawing should not be required, but the examiner will ask that the proposed illustration be shown in a sketch, which showing will be transferred to one of the sheets of the drawings.

For the handling of additional, duplicate, or substitute drawing, see § 608.02(h). [R-36]

608.02(a) New Drawing—When Required [R-41]

PHOTOPRINTS AS DRAWINGS

To expedite filing, applicants sometimes submit applications with photoprints in lieu of formal drawings. Such applications are accepted by Application Division for filing only, provided the photoprints are readable and reproducible. Applicant is notified on form letter POL-1094 that formal drawings, in compliance with rule 84, together with a minimum comparison fee of ten dollars, are required within two months, to avoid abandonment. This charge may be applied against deposit accounts and authorization to charge such accounts should be included when the formal drawings are filed. For those who have no deposit account, acceptance of the formal drawings will be contingent upon payment of the comparison charge within the set period. A copy of form POL-1094 is placed in the file wrapper by the Application Division. When the file wrapper is received in the properly assigned examining group, the POL-1094 is promptly mailed. The application will not be examined until the formal drawings are received.

In those situations where an application is filed with informal drawings, applicants are requested to wait until they receive their "Notice of Informal Drawings" form, PO-1094 from the group art unit before submitting the formal drawings and the comparison charge. The letter of transmittal accompanying the formal drawings should identify the group art unit indicated on form PO-1094. Also, each sheet of drawing should include the serial number and group art unit in the upper right margin. In the past, some drawings have been misdirected because the group art unit indicated on the filing receipt was used rather than that indicated on form PO-1094.

In the event the drawings are not timely furnished, the application becomes abandoned after expiration of the two-month period referred to in form letter POL-1094. The group clerk prepares a letter of abandonment but the examiner is not credited with a disposal.

New applications with photoprints in lieu of drawings are identified by a pink "Special R. 84" tag on the file wrapper.

The draftsman is the judge of drawings, as to the execution of the same, and the arrangement of the views thereon, while the examiner is the judge as to the sufficiency of the showing. The drawings, upon receipt of an application, are sent from the Application Division to be inspected by the draftsman. If satisfactory, he stamps on each sheet "Approved by Draftsman." See also § 608.02.

HANDLING OF NEW DRAWINGS

If the new drawings are timely filed, the clerk should immediately send the new drawings with the file wrapper to the Draftsman for approval as to form. If the drawings are approved as to form by the Draftsman, the clerk checks to see if the $10 comparison fee has been paid or charged to a deposit account. If the fee has been paid, this fact should be noted on form PO-948 or PO-1094 in the left margin thereof opposite the comparison fee requirement and initialed by the clerk. A simple phrase such as "fee O.K." is sufficient. If the fee has not been paid, the applicant or his attorney should be so notified. This should be done by the clerk by either telephone or a short letter. The following language may be used:

"Formal drawings have been received in this application. However, the response is incomplete because a comparison fee of $10 has not been paid. Applicant is given 30 days to complete his response in order to avoid any question of abandonment."

If the minimum $10 comparison fee has been paid, the examiner compares the content of the new drawing to the informal drawing to determine if the illustration is sufficient and whether new matter has been added. The examiner should state in his next Office action his conclusions. These conclusions could merely state that upon comparison, the new drawings were acceptable or why they were not acceptable.

If the application is allowed on the first action, the examiner should state that the new drawings were acceptable in the examiner's amendment or on form POL-327.

608.02(b) Informal Drawings [R-41]

Rule 85. Informal drawings. The requirements of rule 84 relating to drawings will be strictly enforced. A drawing not executed in conformity thereto, if suit-

able for reproduction, may be admitted but in such case the drawing must be corrected or a new one furnished, as required. The necessary corrections or mounting will be made by the Office upon applicant's request or permission and at his expense. (See rules 21 and 165.)

In instances where the drawing is such that the prosecution can be carried on without the corrections, applicant is informed of the reasons why the drawing is objected to on Form PO–948, and that the drawing is admitted for examination purposes only (see § 707.07(a)). To be fully responsive, an amendment must include a request for drawing corrections when there is an indication of allowable subject matter or an appeal is filed. See rule 111(b).

608.02(c) Drawings or Print Kept in Examining Group [R–36]

The photocopies of the drawings must always be kept on top of the papers on the right of the file wrapper so as to be visible upon opening the wrapper and easily detached. This photocopy (or "print") is placed in the drawing cabinet when the corresponding large size (10 by 15 inches) drawing is removed during prosecution.

No application should be sent to issue or to the Abandoned Files Unit unless the original drawing, if any, accompanies it.

Rule 84 was amended on May 28, 1971 (887 O.G. 1840) to require the drawings in patent applications to be 8½ by 14 inches in size and to prohibit names within the illustration area of the drawing.

Although the rule was changed in May 1971, filing of the smaller size drawings did not become mandatory until January 1, 1972.

The small size formal bristolboard drawings are placed in the center portion of the application file wrapper underneath the application papers by the Customer Services Division. The bristolboard drawing should be retained in this position for filing in the examining groups in all applications filed after January 1, 1972.

608.02(d) Complete Illustration in Drawings

Rule 83. Content of drawing. (a) The drawing must show every feature of the invention specified in the claims. However, conventional features disclosed in the description and claims, where their detailed illustration is not essential for a proper understanding of the invention, should be illustrated in the drawing in the form of a graphical drawing symbol or a labeled representation (e.g. a labeled rectangular box).

(b) When the invention consists of an improvement on an old machine the drawing must when possible exhibit, in one or more views, the improved portion itself, disconnected from the old structure, and also in another view, so much only of the old structure as will suffice to show the connection of the invention therewith.

Likewise, any structural detail that is of sufficient importance to be described should be shown in the drawing. (Ex parte Good, 1911 C.D. 43; 164 O.G. 739.)

608.02(e) Examiner Determines Completeness of Drawings

The examiner should see to it that the figures are correctly described in the brief description of the specification and that the reference characters are properly applied, no single reference character being used for two different parts or for a given part and a modification of such part. Every feature covered by the claims must be illustrated, but there should be no superfluous illustrations.

608.02(f) Modifications in Drawings

Modifications may not be shown in broken lines on figures which show in solid lines another form of the invention. Ex parte Badger, 1901 C.D. 195; 97 O.G. 1596.

All modifications described must be illustrated, or the text canceled. (Ex parte Peck, 1901 C.D. 136; 96 O.G. 2409.) This requirement does not apply to a mere reference to minor variations nor to well-known and conventional parts.

608.02(g) Illustration of Prior Art

Figures showing the prior art are usually unnecessary and should be canceled. Ex parte Elliott, 1904 C.D. 103; 109 O.G. 1337. However, where needed to understand applicant's invention, they may be retained if designated by a legend such as "Prior Art."

608.02(h) Additional, Duplicate or Substitute Drawings [R–36]

When an amendment is filed stating that at the same time substitute or additional sheets of drawings are filed and such drawings have not been transmitted to the examining group, the docket clerk in the examining group should call the Application Division before entering the amendment to ascertain if the drawing was not received. In the next communication of the examiner the applicant is notified if the drawings have not been received.

Additional and substitute drawings, together with the file wrapper, are routed through the

Drafting Division where any defects in execution will be noted. If there are none, they will be stamped, "APPROVED BY DRAFTSMAN". When such drawings are considered by the examiner, it should be kept in mind that the "APPROVED" stamp applies only to the size and quality of paper, lines rough and blurred and other details of execution. The Draftsman will automatically forward all such cases to the Customer Services Division for preparation of the paper prints. The Customer Services Division will return the cases to the examining groups.

The examiner should not overlook such factors as new matter, the necessity for the additional sheets and consistency with other sheets. Clerks will routinely "enter" all additional and substitute sheets on the file wrapper. If the examiner decides that the sheets should not be entered, applicant is so informed, giving the reasons. The entries made by the clerk will be marked "(N.E.)".

If an additional sheet of drawing is considered unnecessary and the original drawing requires alterations which are taken care of in the proffered additional sheet, the latter may be used in lieu of the usual sketch required in making the correction of the original drawing.

If an old, large size drawing is to be transferred to an application filed after January 1, 1972, the drawing together with the file wrapper, should be forwarded to the Draftsman. He will cut down the size of the drawing and forward the case for preparation of prints. Only the Draftsman may cut the oversize drawings to size.

For return of drawing, see § 608.02(y).

608.02(i) Transfer of Drawings From Prior Applications [R–44]

Rule 88. Use of old drawings. If the drawings of a new application are to be identical with the drawings of a previous application of the applicant on file in the Office, or with part of such drawings, the old drawings or any sheets thereof may be used if the prior application is, or is about to be, abandoned, or if the sheets to be used are canceled in the prior application. The new application must be accompanied by a letter requesting the transfer of the drawings, which should be completely identified.

Transfer of all drawings from a first pending application to another will be made only after a written declaration of abandonment has been filed in the first application.

NEWLY SUBMITTED APPLICATION

The transfer of drawings to newly submitted applications that have not been forwarded to the examining group will be effected by the Application Division if no drawing prints are filed and the application is otherwise entitled to receive a filing date. The transfer of the drawings between applications under rule 88 is processed in the examining groups if informal prints are filed with the application papers. A new application filed without drawings but having a request for transfer of drawings from a pending application must be accompanied by a written declaration of abandonment under rule 138. In order to insure copendency, such an abandonment may be worded as to become effective only after the transfer of the drawings has taken place. When a new application is filed with a request to transfer drawings under rule 88, the application papers should include drawing prints to enable the Application Division to process the case before transfer of the formal drawings is effected.

The above practice applies to transfer of drawings from any application except where the issue fee has been paid, in which case an express abandonment (rule 138) must be filed together with a showing why the proposed action was not taken earlier. See rule 313.

The name of the attorney on the drawing being transferred is not changed. See § 608.02(u).

When an application is sent to issue, any canceled sheet of drawing then in the case is sent to the Abandoned Files Unit. Such canceled sheet is available for applicant's use in another application directed to its subject matter. It follows that, except as provided in rule 174, drawings printed in a patent may not be transferred to a subsequent case.

608.02(j) Transfer of Canceled Sheets of Drawings to Divisional Application [R–44]

In the case of a divisional application, if the drawing and descriptive matter pertaining thereto have been canceled from the parent case, the canceled sheet or sheets of drawing may be withdrawn and used as the original drawing of the divisional case. The sheets involved should be taken to the Drafting Division for erasure of the "CANCEL per" stamp.

608.02(k) Transfer of Drawings to Reissue [R–32]

In a reissue application, the prints of the original or patented drawing may be used for examination purposes, and the formal transfer of the original drawing to the reissue application made when the reissue application is ready for issue, *provided* no change whatever, even so much as the priming of a reference character, or correction of an obvious error, is made in the drawing. If there is to be any change whatsoever in the drawing, a new drawing for the reissue must be filed.

If there is more than one sheet of original drawing, a required change on any sheet will preclude the use of the original drawings which must be kept in the condition existing at the time of issue of the original patent. See § 1401.05.

Transfer of the drawing is made as set forth in § 608.02(i), notation thereof being entered on the file wrapper of the original application.

The letter of transmittal in a reissue application should request transfer of the drawings, if such transfer is desired.

608.02(m) Drawing Prints [R–44]

Preparation and distribution of drawing prints is discussed in § 508.

Prints are made of the drawings of an acceptable application. Prints of the drawings as filed are entered in the application, given a paper number and kept on top of the papers on the right side of the file wrapper, see § 717.01(b).

All prints and inked sketches subsequently filed to be part of the record are endorsed with the date of their receipt in the Office and given their appropriate paper number.

The print being thus an official paper in the record should not be marked or in any way altered. The bristolboard drawing, of course, should not be marked up by the examiner. Where, as in an electrical wiring case, it is desirable, to identify the various circuits by different colors, or in any more or less complex case, it is advantageous to apply legends, arrows or other indicia, an additional print for such use should be ordered by the examiner and placed unofficially in the file.

Prints remain in the file at all times except as provided in § 608.02(c).

Heavy Paper Prints

A second print on heavy weight, colored paper is prepared of each drawing in all applications having a filing date after January 1, 1972. The print on colored paper is in addition to the white paper print.

Pink paper was used from January 1, 1972 to January 1, 1974. Buff colored paper has been used since January 1, 1974.

Primary examiners should place the classification and the name of the examiner on the colored print.

The colored prints are located above the white paper prints on the right hand portion of the file wrapper, when initially received in the examining group.

After the application has been classified and assigned to an examiner, the colored prints should be removed and placed in the drawing cabinets.

If an application has several sheets of drawings, the colored prints should be stapled together at their bottom edges before being filed. If the number of sheets of prints is too large to be stapled, a fastener should be placed through the holes at the top.

The time when the colored prints are removed from the drawing cabinets is determined by the group director.

The formal bristolboard drawings submitted by applicant in cases filed after January 1, 1972 remain in the file wrapper.

608.02(n) Duplicate Prints in Patentability Report Cases [R–29]

In patentability report cases having drawings, the examiner to whom the case is assigned obtains a duplicate set of prints of the drawing for filing in the group to which the case is referred.

When a case that has had patentability report prosecution, is passed for issue or becomes abandoned, notification of this fact is given by the group having jurisdiction of the case to each group that submitted a patentability report. The examiner of each such reporting group notes the date of allowance or abandonment on his duplicate set of prints. At such time as these prints become of no value to the reporting group, they may be destroyed.

608.02(o) Dates Entered on Drawing [R–44]

The Incoming Mail Section (mail room) stamp and the "Corrected" stamp applied by the Drafting Division are impressed on the back of the drawings.

The only date entered on the front of the drawings is the date of mailing of the Notice of Allowance, which is done by the Patent Issue Division. Under current practice, the clerk of the examining group does NOT enter any date when the case is "sent to issue".

Approval of the Drafting Division is indicated by a legend associated with the "O.G. Fig. Cl. . . . Sub. . . ." stamp on the front of each sheet.

608.02(p) Correction of Drawings [R–29]

Rule 123. Amendments to the drawing. (a) No change in the drawing may be made except by permission of the Office. Permissible changes in the construction shown in any drawing may be made only by the Office. A sketch in permanent ink showing proposed changes, to become part of the record, must be filed. The paper requesting amendments to the drawing should be separate from other papers.

(b) Substitute drawings will not ordinarily be admitted in any case unless required by the Office.

Note.—Correction is deferrable, see § 608.02(b), correction at allowance and issue, see §§ 608.02(w) and 1302.05.

A canceled figure may be reinstated. An amendment should be made to the specification adding the brief description if a canceled figure is reinstated.

608.02(q) Conditions Precedent to Amendment of Drawing [R–44]

Correction and alterations in the disclosure of the drawings of a pending application may be made only under the supervision of, or by the Chief Draftsman.

No alterations will be permitted unless required by an examiner's letter in each case, or proposed in writing by applicant or his attorney or agent. In either case the alterations or corrections as indicated in the sketches filed with the request of the applicant or his attorney or agent must be given written approval by the examiner before the case is sent to the Drafting Division.

In those cases filed after January 1, 1972, which contain oversize drawings (larger than 8½ by 14 inches), the Draftsman will cut down the edges of the drawing in order to allow it to be placed in the file wrapper. The Draftsman will place two copies of a form letter in each application in which the drawings were cut. One copy should be mailed with the first Office letter as an attachment thereto and the other copy should be retained in the file wrapper.

The Draftsman will also place two copies of the form in all applications having drawings with names within the illustration area. Names must be removed from the illustration area of all drawings in cases filed after January 1, 1972. The names will be removed from the drawing by the Draftsman upon payment of the appropriate fee. Estimates of the fee may be obtained from the Draftsman. Removal of the border lines will not be required since the printer can easily mask them out when printing the drawing.

NOTE.—Disposition of orders for amendment of drawing, § 608.02(x).

608.02(r) Separate Letter to Draftsman [R–44]

Any request by the applicant for amendment of the drawing to cure defects must be embodied in a *separate* letter to the Chief Draftsman. Otherwise the case, unless in other respects ready for issue, will not be forwarded by the examiner to the Drafting Division, and applicant will be so advised in the next action by the examiner.

NOTE.—Changes which may require sketches, § 608.02(v).

608.02(s) Estimating Cost of Correcting Drawings [R–44]

The Draftsman places an estimate of the cost of correcting any formal defects of the drawing on form PO–948. See §§ 707.07 (a) and (c).

Files and drawings sent from the examining group to the Draftsman for estimating the cost of correcting the drawing or of making new drawings will be retained by the draftsman only long enough to estimate the cost of the work.

If the examiner approves of a proposed correction of a drawing for which an estimate is requested he will note his approval on the order for the estimate, attach the order to the outside of the file and have the docket clerk of the group forward the file and drawing to the Draftsman. The Draftsman will note the estimate on the order and also on the drawing. If the application is not up for action the Draftsman sends the estimate to the applicant. If the application is up for action the Draftsman does not send an estimate, but the examiner should include the estimate in the next action.

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When giving an estimate in a case where no allowable subject matter has been found the examiner should inform the applicant that no correction will be made until a claim is found to be allowable. If specifically requested by the applicant, the drawing will be corrected whether or not a claim is allowable or an appeal is filed.

If an application is ready for allowance except for a correction required by the draftsman, such as in a case where the lines are rough and blurred, the examiner will ascertain (by calling Ext. 73227) whether or not the attorney in the case has a deposit account. If there is no such account, the examiner will obtain an estimate of the cost of this work from the draftsman even though applicant has not requested such an estimate, provided that no estimate has been previously furnished on form PO–948. Including the estimate in the final requirement for correction of the drawing may avoid prolonging the prosecution. [R–36]

608.02(t) Cancelation of Figures [R–23]

Cancelation of one or more figures which do not occupy entire sheets of the drawings is done by the clerk in the examining group who encloses a figure and its legend with a red ink line. No portion of the figure itself should be crossed by the red line. The words "CANCEL per" and the date of the amendment directing the cancelation or the date that substitute sheets are filed should be written in red ink within the red line. Cancelation of an entire sheet of drawings is done by stamping the words "CANCEL per" in the top right corner of the drawing within the marginal line.

When the cancelation of some of the figures from one sheet of drawings has left the remaining figures with an inartistic arrangement, the Chief Draftsmen should be consulted as to whether the remaining figures should be transferred to other sheets already in the case or shown in additional drawings. Cancelation of a figure may necessitate renumbering of the remaining figures.

608.02(u) Changing Name of Attorney on Drawing Forbidden [R–23]

Writing upon the drawings the names of attorneys subsequently appointed, so as to make it appear that their names were present when the drawings were originally filed, is prohibited.

This prohibition applies also where a drawing is transferred from one case to another having a different attorney.

608.02(v) Drawing Changes Which Require Sketches [R–23]

When changes are to be made in the drawing itself, other than mere changes in reference characters, designations of figures, or inking over lines pale and rough, a print or pen-and-ink sketch showing such changes in red ink must be filed. Ordinarily, broken lines may be changed to full without a sketch.

Sketches filed by an applicant and used by the draftsman for correction of the drawing will not be returned. All such sketches must be in ink or permanent prints.

A pencil sketch that is otherwise acceptable or a blueprint with the changes indicated in pencil, may be inked in by the Office Draftsman at applicant's request and at his expense.

608.02(w) Drawing Changes Which May Be Made by Examiner's Amendment Without a Sketch [R–36]

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the examiner will prepare an examiner's amendment indicating the change made and note in pencil on the drawing the addition or alteration to be made and send the drawing to the Draftsman for the required correction.

As a guide to the examiner the following corrections are illustrative of those that may be made by examiner's amendment without a sketch.

1. Adding two or three reference characters or exponents.
2. Changing one or two numerals or figure ordinals.
3. Removing superfluous matter.
4. Adding or reversing directional arrows.
5. Changing Roman Numerals to Arabic Numerals to agree with specification.
6. Adding section lines or brackets, where easily executed.
7. Making simple changes in inventor's name (not his signature).
8. Changing lead lines.
9. Correcting misspelled legends.

In the event that several different kinds of changes are required or any of the listed changes are time consuming, an examiner's amendment should not be made.

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608.02(x) Disposition of Orders for Amendment of Drawing [R–36]

Where the ordered correction of the drawing in a case up for action by the examiner is approved, the application and drawing are forwarded to the draftsman provided there is an allowable claim, an appeal has been filed, or there has been a specific request by applicant that the drawing be corrected regardless of whether or not a claim has been allowed or an appeal filed (§ 608.02(s). Applicant's letter to the draftsman is attached to the outside of the file and the examiner writes on said letter "approved", with the date of approval and his initials, attaching, if appropriate, a "Special" tag (PO–364). If rough and blurred lines are to be corrected, the examiner should at that time indicate in the margin the figure to be printed in the Official Gazette. It is not necessary to carry such files to the draftsman. Messenger envelopes should be used. After the drawing has been corrected, the draftsman stamps the letter to the draftsman and the back of the drawing CORRECTED and returns the case to the examiner.

New Drawings Prepared by Patent Office

When new drawings have been required in pending applications and have been prepared by the draftsman, a copy (print) is sent to the applicant for his file.

In the event that the application is in condition for allowance, the application can be sent to issue immediately after the drawing is prepared.

Correction Not Approved

Where the correction is not approved, for example, because the proposed changes are erroneous, or involve new matter or (although otherwise proper) do not include all necessary corrections, the case and request for correction of drawing are not sent to the draftsman. The examiner's reasons for not approving the corrections to the drawing should be set forth in the Office action.

608.02(y) Return of Drawing [R–29]

If there is an accepted drawing in the case, other drawings (except those originally filed) that have been finally denied admission will be returned to the applicant only at his request.

Such a request must be filed within a reasonable time; otherwise the drawing may be disposed of at the discretion of the Commissioner.

When a drawing is to be returned, the file, the examiner's letter stating that the drawing is being returned, and the drawing are taken to the Drafting Division where the letter will be stamped and the drawing returned. The letter is mailed by the examining group.

Before drawings are returned prints are made and put in the application file.

Drawings prepared by the Office Draftsman are not sent to the applicant for signature. See § 608.02(x).

608.03 Models, Exhibits, Specimens [R–37]

35 U.S.C. 114 Models, specimens. The Commissioner may require the applicant to furnish a model of convenient size to exhibit advantageously the several parts of his invention.

When the invention relates to a composition of matter, the Commissioner may require the applicant to furnish specimens or ingredients for the purpose of inspection or experiment.

Rule 91. Models not generally required as part of application or patent. Models were once required in all cases admitting a model, as a part of the application, and these models became a part of the record of the patent. Such models are no longer generally required (the description of the invention in the specification, and the drawings, must be sufficiently full and complete, and capable of being understood, to disclose the invention without the aid of a model), and will not be admitted unless specifically called for.

Rule 92. Model or exhibit may be required. A model, working model, or other physical exhibit, may be required if deemed necessary for any purpose on examination of the application.

With the exception of cases involving perpetual motion, a model is not ordinarily required by the Office to demonstrate the operativeness of a device. If operativeness of a device is questioned, the applicant must establish it to the satisfaction of the examiner, but he may choose his own way of so doing.

A physical exhibit, not to be part of the case, is generally not refused except when bulky or dangerous.

Rule 93. Specimens. When the invention relates to a composition of matter, the applicant may be required to furnish specimens of the composition, or of its ingredients or intermediates, for the purpose of inspection or experiment.

608.03(a) Handling of Models, Exhibits and Specimens [R–23]

All models received in this Office, whether forming part of an application, or filed upon request from the examiner, must be received from the Supply and Receiving Unit and not from the applicant or his agent. It is necessary that all models should be taken to the Supply and Receiving Unit for proper recording in order that they may be located under subsequent inquiry and for final disposition. The examiners should, therefore, refuse to accept models from inventors or attorneys. Models properly received and entered in the records of the Supply and Receiving Unit will be delivered or will be picked up by the examining group.

When a model has been received in compliance with the official requirement, the date of its filing shall be entered on the file wrapper of the application.

When an exhibit or model is received, it will be forwarded from the Supply and Receiving Unit to the examining group. A label showing attorney's name and address should be attached to the model or exhibit so that it can be returned after prosecution of case. If exhibit is too large to be kept in the group during prosecution of case, it may be sent to the Supply and Receiving Unit with instructions to indicate whether exhibit is to be held or returned to sender.

Rule 94. Return of models, exhibits or specimens. Models, exhibits, or specimens in applications which have become abandoned, and also in other applications on conclusion of the prosecution, may be returned to the applicant upon demand and at his expense, unless it be deemed necessary that they be preserved in the Office. Such physical exhibits in contested cases may be returned to the parties at their expense. If not claimed within a reasonable time, they may be disposed of at the discretion of the Commissioner.

When a model is to be returned a letter should be written to applicant by the examining group stating that it is being returned under separate cover and the Supply and Receiving Unit should be properly notified to return the model.

NOTE.—Disposition of exhibits which are part of the record, § 715.07(d).

Models, exhibits and specimens may be presented to the Office for purposes of interview and taken away by the attorney at the end of the interview. See § 713.08.

NOTE.—Plant specimens, § 1607, Rule 166.

Rule 95. Copies of exhibits. Copies of models or other physical exhibits will not ordinarily be furnished by the Office, and any model or exhibit in an application or patent shall not be taken from the Office except in the custody of an employee of the Office specially authorized by the Commissioner.

608.04 New Matter [R–23]

Rule 118. Amendment of disclosure. In original applications, all amendments of the drawings or specifi-

cations, and all additions thereto, must conform to at least one of them as it was at the time of the filing of the application. Matter not found in either, involving a departure from or an addition to the original disclosure, cannot be added to the application even though supported by a supplemental oath, and can be shown or claimed only in a separate application.

In establishing a disclosure applicant may rely not only on the specification and drawing as filed but also on the original claims if their content justifies it. Note § 608.01(l).

While amendments to the specification and claims involving new matter are ordinarily entered, such matter is required to be canceled from the descriptive portion of the specification, and the claims affected are rejected.

A "new matter" amendment of the drawing is ordinarily not entered. Neither is an additional or substitute sheet containing "new matter" even though stamped APPROVED by the Draftsman and provisionally entered by the clerk. See § 608.02(h).

The examiner's holding of new matter may be petitionable or appealable, § 608.04(c).

NOTE.—New matter in reissue application, § 1401.07. New matter in substitute specification, § 714.20.

608.04(a) Matter Not in Original Specification, Claims or Drawings [R–23]

Matter not in the original specification, claims or drawings is usually new matter. Depending on circumstances such as the adequacy of the original disclosure, the addition of inherent characteristics such as chemical or physical properties, a new structural formula or a new use may be new matter. See Ex parte Vander Wal et al., 1956 C.D. 11; 705 O.G. 5 (physical properties), Ex parte Fox, 1960 C.D. 28; 761 O.G. 906 (new formula) and Ex parte Ayers et al., 108 USPQ 444 (new use). For rejection of claim involving new matter see § 706.03(o).

NOTE.—Completeness of disclosure, § 608.01 (p); Trademarks and trade names, § 608.01(v).

608.04(b) New Matter by Preliminary Amendment [R–23]

An amendment is sometimes filed along with the filing of the application. Such amendment does not enjoy the status as part of the original disclosure. Its test as to involving new matter is the same as though filed on a subsequent date. Ex parte Leishman, 137 Ms. 336, Pat. No. 1,581,937, and Ex parte Adams, Pat. No. 1,789,921.

608.04(c) Review of Examiner's Holding of New Matter

Where the new matter is confined to amendments to the specification, review of the examiner's requirement for cancellation is by way of petition. But where the alleged new matter is introduced into or affects the claims, thus necessitating their rejection on this ground, the question becomes an appealable one, and should not be considered on petition even though that new matter has been introduced into the specification also. Rules 181 and 191 afford the explanation of this seemingly inconsistent practice as affecting new matter in the specification.

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701 Statutory Authority for Examination [R–31]

35 U.S.C. 131. The Commissioner shall cause an examination to be made of the application and the alleged new invention; and if on such examination it appears that the applicant is entitled to a patent under the law, the Commissioner shall issue a patent therefor.

The main conditions precedent to the grant of a patent to an applicant are set forth in 35 U.S.C. 101, 102, 103.

35 U.S.C. 101. Inventions patentable. Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

35 U.S.C. 100. Definitions. When used in this title unless the context otherwise indicates—

(a) The term "invention" means invention or discovery.

(b) The term "process" means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

(c) The terms "United States" and "this country" mean the United States of America, its territories and possessions.

(d) The word "patentee" includes not only the patentee to whom the patent was issued but also the successors in title to the patentee.

702 Requisites of the Application [R–41]

When a new application is assigned in the examining group, the examiner should review the contents of the application to determine if the application meets the requirements of 35 U.S.C. 111. Any matters affecting the filing date of the application, such as lack of an original signature or lack of claims should be checked before the application is placed in the storage racks to await the first action.

The examiner should be careful to see that the application meets all the requisites set forth in chapter 600 both as to formal matters and as to the completeness and clarity of the disclosure. If all of the requisites are not met, applicant may be called upon for necessary amendments. Such amendments, however, must not include new matter.

702.01 Obviously Informal Cases [R–43]

When an application is reached for its first action and it is then discovered to be impractical to give a complete action on the merits because of an informal or insufficient disclosure, the following procedure may be followed:

(1) A reasonable search should be made of the invention so far as it can be understood from the disclosure, objects of invention and claims and any apparently pertinent art cited;

(2) Informalities noted by the Application Division and deficiencies in the drawing should be pointed out by means of attachments to the examiner's letter (see § 707.07(a)),

(3) A requirement should be made that the specification be revised to conform to idiomatic English and United States practice;

(4) The claims should be rejected as failing to define the invention in the manner required by 35 U.S.C. 112 if they are informal. A blanket rejection is usually sufficient.

The examiner should not attempt to point out the specific points of informality in the specification and claims. The burden is on the applicant to revise the application to render it in proper form for a complete examination.

It is obviously to applicant's advantage to *file* the application with an adequate disclosure and with claims which conform to the U.S. Patent and Trademark Office usages and requirements. This should be done whenever possible. If, however, due to the pressure of a Convention deadline or other reasons, this is not possible, applicants are urged to submit *promptly, preferably within three months after filing*, a preliminary amendment which corrects the obvious informalities. The informalities should be corrected

to the extent that the disclosure is readily understood and the claims to be initially examined are in proper form, particularly as to dependency, and otherwise clearly define the invention. "New matter" must be excluded from these amendments since preliminary amendments do not enjoy original disclosure status, § 608.04(b).

Whenever, upon examination, it is found that the terms or phrases of modes of characterization used to describe the invention are not sufficiently consonant with the art to which the invention pertains, or with which it is most nearly connected, to enable the examiner to make the examination specified in rule 104, the examiner should make a reasonable search of the invention so far as it can be understood from the disclosure. The action of the examiner may be limited to a citation of what appears to be the most pertinent prior art found and a request that applicant correlate the terminology of his specification with art-accepted terminology before further action is made.

A suitable form for this action is as follows:

"A preliminary examination of this application indicates that the following terminology (or properties or units of test data, etc.) . . . which appear(s) at page(s) . . . of the specification is (are) so different from those generally accepted in the art to which this invention pertains that it is difficult or impossible to make a reliable search.

Applicant is therefore requested to provide a sufficient elucidation of these terms (or properties or test data) or correlation thereof with art-accepted terminology so that a proper comparison with the prior art can be made.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE 30 DAYS FROM THE DATE OF THIS LETTER."

For the procedure to be followed when only the drawing is informal, see §§ 608.02(a) and 608.02(b).

703 "General Information Concerning Patents" [R–25]

The pamphlet "General Information Concerning Patents" may be sent to an applicant handling his own case when the examiner deems it advisable.

704 Search [R–25]

After reading the specification and claims, the examiner searches the prior art.

The subject of searching is more fully treated in chapter 900. See §§ 904 through 904.02. The invention should be thoroughly understood before a search is undertaken. However, informal cases, or those which can only be imperfectly understood when they come up for action in their regular turn are also given a search, in order to avoid piecemeal prosecution.

Previous Examiner's Search

When an examiner is assigned to act on an application which has received one or more actions by some other examiner, full faith and credit should be given to the search and action of the previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general the second examiner should not take an entirely new approach to the case or attempt to reorient the point of view of the previous examiner, or make a new search in the mere hope of finding something. See § 717.05.

705 Patentability Reports [R–25]

Where an application, properly assigned to one examining group, is found to contain one or more claims *per se* classifiable in one or more other groups, which claims are not divisible *inter se* or from the claims which govern classification of the application in the first group, the application may be referred to the other group or groups concerned for a report as to the patentability of certain designated claims. This report will be known as a Patentability Report (P.R.) and will be signed by the primary examiner in the reporting group.

The report, if legibly written, need not be typed.

Note that the Patentability Report practice is suspended, except in extraordinary circumstances. See § 705.01(e).

705.01 Instructions re Patentability Reports [R–25]

When an application comes up for any action and the primary examiners involved agree that a Patentability Report is necessary, the application will be forwarded to the proper group with a memorandum attached, for instance, "For Patentability Report from group ——— as to claims ———."

705.01(a) Nature of P.R., Its Use and Disposal [R–25]

The primary examiner in the group from which the Patentability Report is requested, if

he approves the request, will direct the preparation of the Patentability Report. This Patentability Report will be written or typed on a memorandum form and will include the citation of all pertinent references and a complete action on all claims involved. The field of search covered should be endorsed on the file wrapper by the examiner making the report. When an examiner to whom a case has been forwarded for a Patentability Report is of the opinion that final action is in order as to the referred claims, he should so state. The Patentability Report when signed by the primary examiner in the reporting group will be returned to the group to which the application is regularly assigned.

The examiner preparing the Patentability Report will be entitled to receive an explanation of the disclosure from the examiner to whom the case is assigned to avoid duplication

of work. If the primary examiner in a reporting group is of the opinion that a Patentability Report is not in order, he should so advise the primary examiner in the forwarding group.

DISAGREEMENT AS TO CLASSIFICATION

Conflict of opinion as to classification may be referred to a patent classifier for decision.

If the primary examiner in the group having jurisdiction of the case agrees with the Patentability Report, he should incorporate the substance thereof in his action, which action will be complete as to *all* claims. The Patentability Report in such a case will *not* be given a paper number but will be allowed to remain in the file until the case is finally disposed of by allowance or abandonment, at which time it should be removed.

DISAGREEMENT ON PATENTABILITY REPORT

If the primary examiner does not agree with the Patentability Report or any portion thereof, he may consult with the primary examiner responsible for the report. If agreement as to the resulting action cannot be reached, the primary examiner having jurisdiction of the case need not rely on the Patentability Report but may make his own action on the referred claims, in which case the Patentability Report should be removed from the file.

APPEAL TAKEN

When an appeal is taken from the rejection of claims, all of which are examinable in the group preparing a Patentability Report, and the application is otherwise allowable, formal transfer of the case to said group should be made for the purpose of appeal only. The receiving group will take jurisdiction of the application and prepare the examiner's answer. At the time of allowance, the application may be sent to issue by said group with its classification determined by the controlling claims remaining in the case.

705.01(b) Sequence of Examination [R–31]

In the event that the supervisory primary examiners concerned in a P.R. case cannot agree as to the order of examination by their groups, the supervisory primary examiner having jurisdiction of the case will direct that a complete search be made of the art relevant to his claims prior to referring the case to another group for report. The group to which the case is referred will be advised of the results of this search.

If the supervisory primary examiners are of the opinion that a different sequence of search is expedient, the order of search should be correspondingly modified.

705.01(c) Counting and Recording P.R.'s [R–23]

The forwarding of the application for a Patentability Report is not to be treated as a transfer by the forwarding group. When the P.R. is completed and the application is ready for return to the forwarding group, it is not counted either as a receipt or action by transfer. Credit, however, is given for the time spent. See § 1705.

A box is provided on each file wrapper headed "P.R. Group _____" and the number of the group making the P.R. is entered in pencil.

The date status of the application in the reporting group will be determined on the basis of the dates in the group of original jurisdiction. To insure orderly progress in the reported dates, a timely reminder should be furnished to the group making the P.R.

705.01(d) Duplicate Prints of Drawings [R–23]

In Patentability Report cases having drawings, the examiner to whom the case is assigned will furnish to the group to which the case is referred, prints of such sheets of the drawings as are applicable, for interference search purposes. That this has been done may be indicated by a pencil notation on the file wrapper.

When a case that has had Patentability Report prosecution is passed for issue or becomes abandoned, NOTIFICATION of this fact will AT ONCE be given by the group having jurisdiction of the case to each group that submitted a P.R. The examiner of each such reporting group will note the date of allowance or abandonment on his duplicate set of prints. At such time as these prints become of no value to the reporting group, they may be destroyed.

705.01(e) Limitation as to Use [R–31]

The above outlined Patentability Report practice is not obligatory and should be re-

sorted to only where it will save total examiner time or result in improved quality of action due to specialized knowledge. A saving of total examiner time that is required to give a complete examination of an application is of primary importance. Patentability Report practice is based on the proposition that when plural, indivisible inventions are claimed, in some instances either less time is required for examination, or the results are of better quality, when specialists on each character of claimed invention treat the claims directed to their specialty. However, in many instances a single examiner can give a complete examination of as good quality on all claims, and in less total examiner time than would be consumed by the use of the Patentability Report practice.

Where claims are directed to the same character of invention but differ in scope only, prosecution by Patentability Report is never proper.

Exemplary situations where Patentability Reports are ordinarily not proper are as follows:

(1) Where the claims are related as a manufacturing process and a product defined by the process of manufacture. The examiner having jurisdiction of the process can usually give a complete, adequate examination in less total examiner time than would be consumed by the use of a Patentability Report.

(2) Where the claims are related as a product and a process which involves merely the fact that a product having certain characteristics is made. The examiner having jurisdiction of the product can usually make a complete and adequate examination.

(3) Where the claims are related as a combination distinguished solely by the characteristics of a subcombination and such subcombination *per se*. The examiner having jurisdiction of the subcombination can usually make a complete and adequate examination.

Then there are situations where the examiner seeking the report is sufficiently qualified to search the art himself.

In view of these conditions which are expected to prevail for some time to come, it is felt to be in the best interests of the Office to suspend the present Patentability Report practice. Where it can be shown, however, that a Patentability Report will save total examiner time, exceptions may be permitted with the approval of the group director of the group to which the application is assigned. The "Approved" stamp should be impressed on the memorandum requesting the P.R.

705.01(f) Interviews With Applicants [R–23]

In situations where an interview is held on an application in which a Patentability Report has been adopted, the reporting group may be called on for assistance at the interview when it concerns claims treated by them. See §§ 713 to 713.10 regarding interviews in general.

706 Rejection of Claims [R–33]

Although this part of the Manual explains the procedure in *rejecting* claims, the examiner should never overlook the importance of his role in *allowing* claims which properly define the invention.

Rule 106. Rejection of claims. (a) If the invention is not considered patentable, or not considered patentable as claimed, the claims, or those considered unpatentable will be rejected.

(b) In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.

Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied *in each and every case.* The Supreme Court in *Graham* v. *John Deere*, 148 USPQ 459, stated that,

> "Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. . . .
>
> "This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as

negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definitiveness which Congress called for in the 1952 Act.

"While we have focused attention on the appropriate standard to be applied by the courts, it must be remembered that the primary responsibility for sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system. We have observed a notorious difference between the standards applied by the Patent Office and by the courts. While many reasons can be adduced to explain the discrepancy, one may well be the free rein often exercised by examiners in their use of the concept of "invention." In this connection we note that the Patent Office is confronted with a most difficult task. . . . This is itself a compelling reason for the Commissioner to strictly adhere to the 1952 Act as interpreted here. This would, we believe, not only expedite disposition but bring about a closer concurrence between administrative and judicial precedent."

Accordingly, an application covering an invention of doubtful patentability should not be allowed, unless and until issues pertinent to such doubt have been raised and overcome in the course of examination and prosecution, since otherwise the resultant patent would not justify the statutory presumption of validity (35 U.S.C. 282), nor would it "strictly adhere" to the requirements laid down by Congress in the 1952 Act as interpreted by the Supreme Court.

The standards of patentability applied in the examination of claims must be the same throughout the Office. In every art, whether it be considered "complex," "newly developed," "crowded," or "competitive," all of the requirements for patentability (e.g., novelty, usefulness and unobviousness, as provided in 35 U.S.C. 101, 102, and 103) must be met before a claim is allowed. The mere fact that a claim recites in detail all of the features of an invention (i.e., is a "picture" claim) is never, in itself, justification for the allowance of such a claim.

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible he should offer a definite suggestion for correction.

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

Rule 112. Reexamination and reconsideration. After response by applicant (rule 111) the application will be reexamined and reconsidered, and the applicant will be notified if claims are rejected, or objections or requirements made, in the same manner as after the first examination. Applicant may respond to such Office action, in the same manner provided in rule 111, with or without amendment, but any amendments after the second Office action must ordinarily be restricted to the rejection or to the objections or requirements made, and the application will be again considered, and so on repeatedly, unless the examiner has indicated that the action is final.

706.01 Contrasted With Objection [R-23]

The refusal to grant claims because the subject matter as claimed is considered unpatentable is called a "rejection." The term "rejected" must be applied to such claims in the examiner's letter. If the form of the claim (as distinguished from its substance) is improper, an "objection" is made. The practical difference between a rejection and an objection is that a rejection, involving the merits of the claim, is subject to review by the Board of Appeals, while an objection, if persisted in, may be reviewed only by way of petition to the Commissioner.

An example of a matter of form as to which objection is made is dependency of a claim on a rejected claim, if the dependent claim is otherwise allowable. See § 608.01(n).

706.02 Rejection on Prior Art [R-31]

35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent. A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or

in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

35 U.S.C. 103. Conditions for patentability; non-obvious subject matter. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

By far the most frequent ground of rejection is on the ground of unpatentability in view of the prior art, that is, that the claimed matter is either not novel under 35 U.S.C. 102, or else it is obvious under 35 U.S.C. 103. The language to be used in rejecting claims should be unequivocal. See § 707.07(d).

35 U.S.C. 102 (Anticipation or Lack of Novelty)

The distinction between rejections based on 35 U.S.C. 102 and those based on 35 U.S.C. 103 should be kept in mind. Under the former, the claim is anticipated by the reference. No question of obviousness is present. It may be advisable to identify a particular part of the reference to support the rejection. If not, the expression "rejected under 35 U.S.C. 102 as clearly anticipated by" is appropriate.

35 U.S.C. 103 (Obviousness)

In contrast, 35 U.S.C. 103 authorizes a rejection where to meet the claim, it is necessary to modify a single reference or to combine it with one or more others. After indicating that the rejection is under 35 U.S.C. 103, there should be set forth (1) the difference or differences in the claim over the applied reference(s), (2) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (3) an explanation why such proposed modification would be obvious.

Prior art rejections should ordinarly be confined strictly to the best available art. Exceptions may properly be made, e.g., (1) where the propriety of a 35 U.S.C. 102 rejection depends on a particular interpretation of a claim; (2) where a claim is met only in terms by a reference which does not disclose the inventive concept involved; or (3) where the most pertinent reference seems likely to be antedated by a rule 131 affidavit or declaration. Such rejections should be backed up by the best other art rejections available. Merely cumulative rejections; i.e., those which would clearly fall if the primary rejection were not sustained, should be avoided.

The Court of Customs and Patent Appeals has held that expedients which are functionally equivalent to each other are not necessarily obvious in view of one another. In re Scott, 139 USPQ 297, 51 CCPA 747 (1963); In re Flint, 141 USPQ 299, 51 CCPA 1230 (1964).

This Court has also held that when a claim is rejected under 35 U.S.C. 103, a limitation which is considered to be indefinite cannot be properly disregarded. If a limitation in a claim is considered to be indefinite, the claim should be rejected under 35 U.S.C. 112, second paragraph. In re Wilson, 165 USPQ 494, 57 CCPA 1029 (1970). Note also In re Steele, 134 USPQ 292, 49 CCPA 1295 (1962). See § 706.03(d).

Where a reference is relied on to support a rejection, whether or not in a "minor capacity" that reference should be positively included in the statement of the rejection. See In re Hoch, 166 USPQ 406, 57 CCPA 1292, footnote 3 (1970).

A U.S. patent may be a reference against an application even though the patent date is after the filing date of the application, provided the filing date of the patent is prior to the filing date of the application. It is proper to use such a patent as a basic or an auxiliary reference and such patents may be used together as basic and auxiliary references. This doctrine arose in *Alexander Milburn Co.* v. *Davis-Bournonville Co.*, 1926 C.D. 303; 344 O.G. 817; and was enacted into law by 35 U.S.C. 102(e). It was held applicable to rejections under 35 U.S.C. 103 by the

U.S. Supreme Court in Hazeltine Research, Inc. et al. v. Brenner, 147 USPQ 429 (1965).

Public Law 92–34 provided for situations caused by the postal emergency which began on March 18, 1970 and ended on or about March 30, 1970. This law allows the applicant to claim an earlier filing date if delay in filing was caused by the emergency. Such earlier filing dates were printed on the patents along with the actual filing dates whenever it was possible. However, patents issued with earlier filing dates claimed under Public Law 92–34 are effective as prior art under 35 U.S.C. 102(e) only as of their actual filing dates and not as of such claimed earlier filing dates. The details of the procedure to claim the earlier date appeared at 889 O.G. 1064.

For the proper way to cite a patent issued after the filing of the application in which it is being cited, see § 707.05(e).

706.02(a) Establishing "Well Known" Prior Art [R–34]

Things believed to be known to those skilled in the art are often asserted by the examiner to be "well known" or "matters of common knowledge". If justified, the examiner should not be obliged to spend time to produce documentary proof. If the knowledge is of such notorious character that judicial notice can be taken, it is sufficient so to state. In re Malcolm, 1942 C.D. 589; 543 O.G. 440. If the applicant traverses such an assertion the examiner should cite a reference in support of his position.

Failure of the applicant to seasonably challenge such assertions establishes them as admitted prior art. See In re Gunther, 1942 C.D. 332; 538 O.G. 744; In re Chevenard, 1944 C.D. 141; 500 O.G. 196. This applies also to assertions of the Board. In re Selmi, 1946 C.D. 525; 591 O.G. 160; In re Fischer, 1942 C.D. 295; 538 O.G. 503.

For further views on judicial notice, see In re Ahlert, 57 CCPA 1023, 165 USPQ 418 (1970) (assertions of technical facts in areas of estoteric technology must always be supported by citation of some reference work); In re Boon, 58 CCPA 1035, 169 USPQ 231 (1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice); and In re Barr, 58 CCPA 1389, 170 USPQ 330 (1971) (involved references held not a sufficient basis for taking judicial notice that involved controverted phrases are art-recognized).

706.03 Rejections Not Based on Prior Art [R–31]

The primary object of the examination of an application is to determine whether or not the claims define a patentable advance over the prior art. This consideration should not be relegated to a secondary position while undue emphasis is given to non-prior art or "technical" rejections. Effort in examining should be concentrated on truly essential matters, minimizing or eliminating effort on technical rejections which are not really critical. Where a major technical rejection is proper (e.g., lack of proper disclosure, undue breadth, utility, etc.) such rejection should be stated with a full development of the reasons rather than by a mere conclusion coupled with some stereotyped expression.

Rejections not based on prior art are explained in §§ 706.03(a) to 706.03(z). IF THE ITALICIZED LANGUAGE IN THESE SECTIONS IS INCORPORATED IN THE REJECTION, THERE WILL BE LESS CHANCE OF A MISUNDERSTANDING AS TO THE GROUNDS OF REJECTION.

706.03(a) Nonstatutory Subject Matter [R–34]

Patents are not granted for all new and useful inventions and discoveries. The subject matter of the invention or discovery must come within the boundaries set forth by 35 U.S.C. 101, which permits patents to be granted only for "any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof.

The term "process" as defined in 35 U.S.C. 100, means process, art or method, and includes a new use of a known process, machine, manufacture, composition of matter, or material.

Decisions have determined the limits of the statutory classes. Examples of subject matter not patentable under the Statute follow:

Printed Matter

For example, a mere arrangement of printed matter, though seemingly a "manufacture," is rejected as *not being within the statutory classes*. See In re Miller, 164 USPQ 46, 57 CCPA 809 (1969); Ex parte Gwinn, 112 USPQ 439 (Bd. App. 1955); and In re Jones, 153 USPQ 77, 54 CCPA 1218 (1967).

Naturally Occurring Article

Similarly, a thing occurring in nature, which is substantially unaltered, is not a "manufacture." A shrimp with the head and digestive tract removed is an example. Ex parte Grayson, 51 USPQ 413.

METHOD OF DOING BUSINESS

Though seemingly within the category of a process or method, a method of doing business can be rejected as not being within the statutory classes. See Hotel Security Checking Co. v. Lorraine Co., 160 Fed. 467 and In re Wait, 24 USPQ 88, 22 CCPA 822 (1934).

SCIENTIFIC PRINCIPLE

A scientific principle, divorced from any tangible structure, can be rejected as not within the statutory classes. O'Reilly v. Morse, 15 Howard 62.

This subject matter is further limited by the Atomic Energy Act explained in § 706.03(b).

706.03(b) Barred by Atomic Energy Act [R–18]

A limitation on what can be patented is imposed by the Atomic Energy Act of 1954. Section 151(a) (42 U.S.C. 2181a) thereof reads in part as follows:

> No patent shall hereafter be granted for any invention or discovery which is useful solely in the utilization of special nuclear material or atomic energy in an atomic weapon.

The terms "atomic energy" and "special nuclear material" are defined in Section 11 of the Act (42 U.S.C. 2014).

Sections 151(c) and 151(d) (42 U.S.C. 2181c and d) set up categories of pending applications relating to atomic energy that must be brought to the attention of the U.S. Atomic Energy Commission. Under rule 14(c), applications for patents which disclose or which appear to disclose, or which purport to disclose, inventions or discoveries relating to atomic energy are reported to the Atomic Energy Commission and the Commission will be given access to such applications, but such reporting does not constitute a determination that the subject matter of each application so reported is in fact useful or an invention or discovery or that such application in fact discloses subject matter in categories specified by the Atomic Energy Act.

All applications received in the Patent Office are sent to Licensing and Review for screening by Group 220 personnel, under rule 14(c), in order for the Commissioner to fulfill his responsibilities under section 151(d) (42 U.S.C. 2181d) of the Atomic Energy Act. Papers subsequently added must be inspected promptly by the examiner when received to determine whether the application has been amended to relate to atomic energy and those so related must be promptly forwarded to Licensing and Review.

All rejections based upon sections 151(a) (42 U.S.C. 2181a), 152 (42 U.S.C. 2182), and 155 (42 U.S.C. 2185) of the Atomic Energy Act must be made only by Group 220 personnel.

706.03(c) Functional [R–34]

See Ex parte Ball et al., 1953 C.D. 4; 675 O.G. 5: In re Arbeit et al., 1953 C.D. 409; 677 O.G. 843 and Ex parte Stanley, 121 USPQ 621.

> *35 U.S.C. 112. Specification.* The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.
>
> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.
>
> An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Paragraph 3 of 35 U.S.C. 112 has the effect of prohibiting the rejection of a claim for a combination of elements (or steps) on the ground that the claim distinguishes from the prior art solely in an element (or step) defined as a "means" (or "step") coupled with a statement of function. However this provision of paragraph 3 must always be considered as subordinate to the provision of paragraph 2 that the claim particularly point out and distinctly claim the subject matter. If a claim be found to contain language approved by paragraph 3 such claim should always be tested additionally for compliance with paragraph 2 and if it fails to comply with the requirements of paragraph 2, the claim should be so rejected and the reasons fully stated.

Paragraph 3 of 35 U.S.C. 112 makes no change in the established practice of rejecting claims as *functional* in situations such as the following:

1. A claim which contains functional language not supported by recitation in the claim of sufficient structure to warrant the presence

of the functional language in the claim. An example of a claim of this character may be found in In re Fuller, 1929 C.D. 172; 388 O.G. 279. The claim reads:

A woolen cloth having a tendency to wear rough rather than smooth.

2. A claim which recites only a single means and thus encompasses all possible means for performing a desired function. For an example, see the following claim in Ex parte Bullock, 1907 C.D. 93; 127 O.G. 1580:

In a device of the class described, means for transferring clothes-carrying rods from one position and depositing them on a suitable support.

Note the following cases:

1. In re Hutchinson, 69 USPQ 138, 33 CCPA 879 (1946), the terms "adapted for use in" and "adapted to be adhered to" were held not to constitute a limitation in any patentable sense.

2. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957), the functional "whereby" statement was held not to define any structure and accordingly could not serve to distinguish.

3. In re Boller, 141 USPQ 740, 51 CCPA 1484 (1964), the term "volatile neutralizing agent" was held to be patentably effective and commensurate with the breadth of the disclosed invention.

4. In re Land and Rogers, 151 USPQ 621 (1966), the expression "adapted to be rendered diffusible in said liquid composition only after at least substantial development" was given weight.

5. In re Halleck, 164 USPQ 647, 57 CCPA 954 (1970), the term "an effective amount" was held not objectionable.

6. In re Swinehart and Sfiligoj, 169 USPQ 226 (1971), held that the meaning of "transparent to infra-red rays" is sufficiently clear.

7. In re Barr et al., 170 USPQ 330, 58 CCPA 1388 (1971), held that the expression "incapable of forming a dye with said oxidized developing agent," set forth definite boundaries. [R–40]

706.03(d) Vague and Indefinite [R–34]

When the examiner is satisfied that patentable novelty is disclosed and it is apparent to the examiner that the claims are directed to such patentable subject matter, he should allow claims which define the patentable novelty with a *reasonable* degree of particularity and distinctness. Some latitude in the manner of expression and the aptness of terms should be permitted even though the claim language is not as precise as the examiner might desire.

The fact that a claim is broad does not necessarily justify a rejection on the ground that the claim is vague and indefinite or incomplete. In non-chemical cases, a claim may, in general, be drawn as broadly as permitted by the prior art.

The rejection of a claim as *indefinite* would appear to present no difficulties. On occasion, however, a great deal of effort is required to explain just what is wrong with the claim, when writing the examiner's letter. Although cooperation with the attorney is to be commended, undue time should not be spent trying to guess what the attorney was trying to say in the claim. Sometimes, a rejection as indefinite plus the statement that a certain line is meaningless is sufficient. The examiner's action should be constructive in nature and when possible he should offer a definite suggestion for correction.

The mere inclusion of reference numerals in a claim otherwise allowable is not a ground for rejection. But see Ex parte Osborne, 1900 C.D. 137; 92 O.G. 1797.

Alternative expressions such as "brake or locking device" may make a claim indefinite if the limitation covers two different elements. If two equivalent parts are referred to such as "rods or bars", the alternative expression may be considered proper.

The inclusion of a negative limitation shall not, in itself, be considered a sufficient basis for objection to or rejection of a claim. However, if such a limitation renders the claim unduly broad or indefinite or otherwise results in a failure to point out the invention in the manner contemplated by 35 U.S.C. 112, an appropriate rejection should be made.

Generally speaking, the inclusion of (1) negative limitations and (2) alternative expressions, provided that the alternatively expressed elements are basically equivalents for the purpose of the invention, are permitted if no uncertainty or ambiguity with respect to the question of scope or breadth of the claim is presented.

The examiner has the responsibility to make sure the wording of the claims is sufficiently definite to *reasonably* determine the scope. It is applicant's responsibility to select proper wording of the claim, except to the extent that the selection of words makes the claims indefinite. Under no circumstances should a claim be rejected merely because the examiner prefers a different choice of wording.

Still another way in which a claim can be indefinite is where a *non sequitur* occurs. For example, a claim is inferential and therefore indefinite when it recites "said lever" and there was no earlier reference or *no antecedent* in the claim to a lever. An *indirect limitation*

also affords a ground of rejection as indefinite. If a "lever" is set forth and, later in the claim, "said aluminum lever" is recited, the claim is rejected as indefinite.

Rejections for indefiniteness were affirmed in In re Cohn, 169 USPQ 95 (CCPA 1971); In re Hammack, 166 USPQ 209 (CCPA 1970); and In re Collier 158 USPQ 266 (CCPA 1968).

Rejections for indefiniteness were reversed in In re Castaing, 166 USPQ 550 (CCPA 1970); In re Fisher, 166 USPQ 18 (CCPA, 1970); and In re Wakefield, 164 USPQ 636 (CCPA 1970).

706.03(e) Product by Process [R-40]

An article may be claimed by a process of making it provided it is definite. In re Moeller, 1941 C.D. 316; 48 USPQ 542; 28 CCPA 932; In re Luck, 177 USPQ 523 (CCPA 1973); In re Steppan, 156 USPQ 143 (CCPA 1967); and In re Pilkington, 162 USPQ 145 (CCPA 1969).

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or 103 of the statute is appropriate. As a practical matter, the Patent Office is not equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith. A lesser burden of proof is required to make out a case of prima facie obviousness for product-by-process claims because of their peculiar nature than when a product is claimed in the conventional fashion. In re Brown, 59 CCPA 1036, 173 USPQ 685 (1972); In re Fessmann, 180 USPQ 324 (CCPA 1974).

The fact that it is necessary for an applicant to describe his product in product-by-process terms does not prevent him from presenting claims of varying scope, Ex parte Pantzer and Feier, 176 USPQ 141 (Board of Appeals, 1972).

706.03(f) Incomplete [R-27]

A claim can be rejected as *incomplete* if it omits essential elements, steps or necessary structural cooperative relationship of elements, such omission amounting to a gap between the elements, steps or necessary structural connections. Greater latitude is permissible with respect to the definition in a claim of matters not essential to novelty or operability than with respect to matters essential thereto. See also § 706.03(d).

706.03(g) Prolix

Claims are rejected as *prolix* when they contain long recitations of unimportant details which hide or obscure the invention. Ex parte Iagan, 1911 C.D. 10; 162 O.G. 538, expresses the thought that very long detailed claims setting forth so many elements that invention cannot possibly reside in the combination should be rejected as prolix. See also In re Ludwick, 1925 C.D. 306; 339 O.G. 393.

706.03(h) Nonstatutory Claim [R-27]

Some applications when filed contain an omnibus claim such as "A device substantially as shown and described."

Such a claim can be rejected as follows:

> Claim _____ is rejected for failing to particularly point out and distinctly claim the invention as required in 35 U.S.C. 112.

For cancellation of such a claim by examiner's amendment, see § 1302.04(b).

706.03(i) Aggregation [R-34]

Rejections on the ground of *aggregation* should be based upon a lack of cooperation between the elements of the claim. Many decisions and some legal writers extend the term to include old and exhausted combinations (§ 706.03(j)). Confusion as to what is meant can be avoided by treating all claims which include more than one element as combinations (patentable or unpatentable) if there is actual cooperation between the elements, and as aggregations if there is no cooperation.

Example of aggregation: A washing machine associated with a dial telephone.

Example of old combination: An improved carburetor claimed in combination with a gasoline engine.

A claim is not necessarily aggregative because the various elements do not function simultaneously. A typewriter, for example, is a good combination. See also In re Worrest, 40 CCPA 804, 96 USPQ 381 (1953). Neither is a claim necessarily aggregative merely because elements which do cooperate are set forth in specific detail.

A rejection on aggregation should be made only after consideration of the court's comments in In re Gustafson, 51 CCPA 1358, 141 USPQ 585 (1964).

706.03(j) Old Combination [R–34]

The rejection on the ground of *old combination* (synonymous with "exhausted combination") requires the citation of a reference, but is treated here because of its relation to aggregation. The reference (not a combination of references, of course) is cited, not to anticipate the claim, but to anticipate the broad combination set forth in the claim. Moreover, the cooperation and result between the elements in the reference must be the same as it is in the claim.

A rejection on the ground of old combination should be made whenever proper. Whether subcombination claims have been presented or allowed in the same application, or whether other grounds for rejection of the combination claims exist, are not determinative of the propriety of this rejection. The rejection is proper when a single reference discloses broadly a combination of the same elements functionally cooperating in substantially the same manner to produce substantially the same results as that of the claimed combination. *Ex parte* Silverstein, 125 USPQ 238. The fact that an applicant has improved one element of a combination which may be *per se* patentable does not entitle him to a claim to the improved element in combination with old elements where the elements perform no new function in the claimed combination. In re Hall, 41 CCPA 759.

Example: An improved (specifically recited) carburetor claimed in combination with a gasoline engine. A reference is cited which shows a carburetor combined with a gasoline engine. This shows the broad combination to be old. Both in the reference and in the claimed combination, the cooperation between the carburetor and engine is the same and the end result is the same. The claimed combination is an improvement over the prior art only because of the improved carburetor. The carburetor has separate status, since entire subclasses are devoted to carburetors, claimed as such. A reference is preferably cited to show the separate status and development. (See § 904.01 (d).)

Old combination rejections ordinarily are based on 35 U.S.C. 112 (failure to point out the invention). The rejection should make it clear exactly what the combination is and why it is thought that any improved element does not modify the action of the combination. A suggested form for use in making an old combination rejection is as follows:

"Claim 1 is rejected under 35 U.S.C. 112 as being drawn to the old combination of a bell, a battery and a switch connected in series by wire conductors. This combination is shown to be old by the patent to Jones which discloses broadly the same elements funtionally interrelated in the same manner to produce substantially the same results. The combination of claim 1 differs from that shown in Jones in setting forth a specific construction of the battery itself. Since the latter does not modify the action of the other elements recited in the claim in any material manner, no new combination is seen to exist. In re Hall, 100 USPQ 46; 41 CCPA 759; 208 F. 2d 370; 680 O.G.5."

See also Lincoln Engineering Co., v. Stewart-Warner Corp., 303 U.S. 545, 37 USPQ 1 (1938); In re McCabe, 48 CCPA 881, 129 USPQ 149 (1961) (discussion of claim 13); and particularly In re Bernhart, 57 CCPA 737, 163 USPQ 611 (1969).

706.03(k) Duplicate Claims; Double Patenting [R–27]

Inasmuch as a patent is supposed to be limited to only one invention or, at most, several closely related indivisible inventions, limiting an application to a single claim, or a single claim to each of the related inventions might appear to be logical as well as convenient. However, court decisions have confirmed applicant's right to restate (i.e., by plural claiming) his invention in a reasonable number of ways. Indeed, a mere difference in scope between claims has been held to be enough.

Nevertheless, when two claims in an application are duplicates, or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to reject the other as being a substantial duplicate of the allowed claim. Also, it is possible to reject one claim on an allowed claim if they differ only by subject matter old in the art. The latter ground of rejection is set forth in the following paragraph quoted from Ex parte Whitelaw, 1915 C.D. 18; 219 O.G. 1237:

"Claim 54 is not patentable over claim 51 and claims 53, 55 and 56 are not patentable over claim 50 in view of Comstock, No. 590,657, which shows that it is old to employ an engine-casing in tools of this character. The claims held patentable are considered as fully covering applicant's invention, and applicant cannot be permitted to multiply his claims by presenting alleged combinations which distinguish from the real invention only by including elements which are old in the art and perform no new function."

This rejection (the ex parte Whitelaw doctrine) is usually not applied if there are only a few claims in the application.

Situations related to that given above are as follows:

Where there is a common assignee for two or more applications by different inventors, and the applications contain conflicting claims, see § 804.03.

Double Patenting

Where there are conflicting claims in different applications of the same inventor, one of which is assigned, see § 304.

Where the same inventor has two or more applications for species or for related inventions, see Chapter 800, particularly §§ 804–804.02, 806.04(h), 822 and 822.01 for double patenting rejections of inventions not patentable over each other.

Application Filed Under 35 U.S.C 121

The Commissioner has determined that under 35 U.S.C. 121, the Patent Office cannot reject a divisional application on the parent patent if the divisional application is filed as a result of a requirement for restriction made by the Office even though the requirement for restriction relates to species. In re Joyce, 1958 C.D. 2; 115 USPQ 412. See also In re Herrick et al., 1958 C.D. 1; 115 USPQ 412 where the Com-

missioner ruled that a requirement for restriction should not be made in an application claiming more than five species if the examiner is of the opinion that the various species are obviously unpatentable over one another. [R–20]

706.03(l) Multiplicity [R–34]

Rule 75(b). More than one claim may be presented, provided they differ substantially from each other and are not unduly multiplied.

An unreasonable number of claims; that is unreasonable in view of the nature and scope of applicant's invention and the state of the art, may afford a basis for a rejection on the ground of *multiplicity.* A rejection on this ground should include all the claims in the case inasmuch as it relates to confusion of the issue.

To avoid the possibility that an application which has been rejected on the ground of undue multiplicity of claims may be appealed to the Board of Appeals prior to an examination on the merits of at least some of the claims presented, the examiner should, at the time of making the rejection on the ground of multiplicity of claims, specify the number of claims which in his judgment is sufficient to properly define applicant's invention and require the applicant to select certain claims, not to exceed the number specified, for examination on the merits. The examiner should be reasonable in setting the number to afford the applicant some latitude in claiming his invention.

The earlier views of the Court of Customs and Patent Appeals set forth in In re Chandler, 117 USPQ 361, 45 CCPA 911 (1958) and In re Chandler, 138 USPQ 138, 50 CCPA 1422 (1963) have been somewhat revised by its views in In re Flint, 162 USPQ 228, 56 CCPA 1300 (1969) and In re Wakefield, 164 USPQ 636, 57 CCPA 959 (1970).

If a rejection on multiplicity is in order the examiner should make a telephone call explaining that the claims are unduly multiplied and will be rejected on that ground. Note § 408. He should request selection of a specified number of claims for purposes of examination.

If time for consideration is requested arrangements should be made for a second telephone call, preferably within three working days.

When claims are selected, a formal multiplicity rejection is made, including a complete record of the telephone interview, followed by an action on the selected claims.

When applicant refuses to comply with the telephone request, a formal multiplicity rejection is made. No reference should be made to the unsuccessful telephone call.

The applicant's response to a formal multiplicity rejection of the examiner, to be complete, must either:

1. Reduce the number of claims presented to those selected previously by telephone, or if no previous selection has been made to a number not exceeding the number specified by the examiner in the Office action, thus overcoming the rejection based upon the ground of multiplicity, or

2. In the event of a traverse of said rejection applicant, besides specifically pointing out the supposed errors of the multiplicity rejection is required to confirm his selection previously made by telephone, or if no previous selection has been made, select certain claims for purpose of examination. the number of which is not greater than the number specified by the examiner.

If the rejection on multiplicity is adhered to. all claims retained will be included in such rejection and the selected claims only will be additionally examined on their merits. This procedure preserves applicant's right to have the rejection on multiplicity reviewed by the Board of Appeals.

See also § 706.03(k).

706.03(m) Nonelected Inventions [R–34]

See §§ 821 to 821.03 for treatment of claims held to be drawn to non-elected inventions.

706.03(n) Correspondence of Claim and Disclosure [R–29]

Rule 117. Amendment and revision required. The specification, claims and drawing must be amended and revised when required, to correct inaccuracies of description and definition or unnecessary prolixity, and to secure correspondence between the claims, the specification and the drawing.

Another category of rejections not based on the prior art is based upon the relation of the rejected claim to the disclosure. In chemical cases, a claim may be so broad as to not be supported by disclosure, in which case it is rejected as unwarranted by the disclosure. If averments in a claim do not correspond to the averments or disclosure in the specification, a rejection on the ground of inaccuracy may be in order. It must be kept in mind that an original claim is part of the disclosure and might adequately set forth subject matter which is completely absent from the specification. Applicant is required in such an instance to add the subject matter to the specification. Whenever an objection or rejection is made based on incomplete disclosure, the ex-

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aminer should in the interest of expeditious prosecution call attention to rule 118.

When an amendment is filed in response to an objection or rejection based on incomplete disclosure, a study of the entire application is often necessary to determine whether or not "new matter" is involved. Applicant should therefore specifically point out the support for any amendments made to the disclosure.

If subject matter capable of illustration is originally claimed and it is not shown in the drawing, the claim is not rejected but applicant is required to add it to the drawing. See § 608.01(l).

See § 706.03(z) for rejections on undue breadth.

706.03(o) New Matter [R–29]

35 U.S.C. 132. Notice of rejection; reexamination. Whenever, on examination, any claim for a patent is rejected, or any objection or requirement made, the Commissioner shall notify the applicant thereof, stating the reasons for such rejection, or objection or requirement, together with such information and references as may be useful in judging of the propriety of continuing the prosecution of his application; and if after receiving such notice, the applicant persists in his claim for a patent, with or without amendment, the application shall be reexamined. No amendment shall introduce new matter into the disclosure of the invention.

In amended cases, subject matter not disclosed in the original application is sometimes added and a claim directed thereto. Such a claim is rejected on the ground that it is *drawn to new matter*. New matter includes not only the addition of wholly unsupported subject matter, but also, adding specific percentages or compounds after a broader original disclosure, or even the omission of a step from a method. See §§ 608.04 to 608.04(c).

In the examination of an application following amendment thereof, the examiner must be on the alert to detect new matter. The prohibition against new matter has been incorporated into the patent statute. These rejections are based on 35 U.S.C. 132.

706.03(p) No Utility [R–20]

A rejection on the ground of *lack of utility* includes the more specific grounds of *inoperativeness*, *involving perpetual motion*, *frivolous*, *fraudulent*, *against public policy*. The statutory basis for this rejection is 35 U.S.C. 101. See § 608.01(p).

706.03(q) Obvious Method [R–40]

In view of a decision of the U.S. Court of Customs and Patent Appeals, process claims should no longer be rejected on a theory that once the article or composition produced thereby is conceived, anyone skilled in the art would at once be aware of a method of making it, In re Kuehl, 177 USPQ 250 (1973).

A process may be unpatentable, however, even if the product produced therefrom is patentable, In re Kanter, 158 USPQ 331 (CCPA 1968). The mere substitution of a new starting material in an otherwise conventional process may well be obvious in the absence of some unobvious result in the process itself, In re Kanter, 158 USPQ 331; In re Neugebauer et al., 141 USPQ 205 (CCPA 1964); Corning Glass Works et al. v. Brenner, 175 USPQ 516 (D.C. Cir. 1972).

However, the use of a specific mineral oil in a process was held to be material in In re Schneider et al., 179 USPQ 46 (CCPA 1973).

706.03(r) Mere Function of Machine [R–20]

In view of the decision of the Court of Customs and Patent Appeals in In re Tarczy-Hornoch appearing at 158 USPQ 141, process or method claims are not subject to rejection by Patent Office examiners solely on the ground that they define the inherent function of a disclosed machine or apparatus.

706.03(s) Statutory Bar [R–40]

Another category of rejections not based on the prior art finds a basis in some prior act of applicant, as a result of which the claim is denied him.

Abandonment of Invention

Under 35 U.S.C. 102(c), abandonment of the "invention" (as distinguished from abandonment of an application) results in loss of right to a patent. Note In re Gibbs et al., 168 USPQ 578 (CCPA 1971).

Own Prior Foreign Patent

Extract from 35 U.S.C. 102. Conditions for patentability; novelty and loss of right to patent. A person shall be entitled to a patent unless—

* * * * *

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States.

The statute above quoted establishes four conditions which, if all are present, establish a

bar against the granting of a patent in this country:

(1) The foreign application must be filed more than one year before the filing in the United States.

(2) It must be filed by the applicant, his legal representatives or assigns.

(3) The foreign patent must be actually granted (e.g., by sealing of the papers in Great Britain) before the filing in the United States or, since foreign procedures differ, the act from which it can be said that the invention was patented, has occurred. It need not be published. *Ex parte* Gruschwitz et al., 138 USPQ 505 discusses the meaning of "patented" as applied to German procedures.

(4) The same invention must be involved.

If such a foreign patent is discovered by the examiner, the rejection is made under 35 U.S.C. 102(d) on the ground of *statutory bar.*

Submission to Library Unnecessary

Applications should not be submitted as a routine matter to the library to ascertain if the foreign application has become a patent. Since the foreign patent to be a bar under 35 U.S.C. 102(d) must have been granted before the filing date in this country, the probability of the foreign patent having issued after the date of execution of the original oath and before the U.S. filing date is so slight as to make such a search ordinarily unproductive.

Foreign Filing Without License

35 U.S.C. 182. Abandonment of invention for unauthorized disclosure. The invention disclosed in an application for patent subject to an order made pursuant to section 181 of this title may be held abandoned upon its being established by the Commissioner that in violation of said order the invention has been published or disclosed or that an application for a patent therefor has been filed in a foreign country by the inventor, his successors, assigns, or legal representatives, or anyone in privity with him or them, without the consent of the Commissioner. The abandonment shall be held to have occurred as of the time of violation. The consent of the Commissioner shall not be given without the concurrence of the heads of the departments and the chief officers of the agencies who caused the order to be issued. A holding of abandonment shall constitute forfeiture by the applicant, his successors, assigns, or legal representatives, or anyone in privity with him or them, of all claims against the United States based upon such invention.

35 U.S.C. 184. Filing of application in foreign country. Except when authorized by a license obtained from the Commissioner a person shall not file or cause or authorize to be filed in any foreign country prior to six months after filing in the United States an application for patent or for the registration of a utility model, industrial design, or model in respect of an invention made in this country. A license shall not be granted with respect to an invention subject to an order issued by the Commissioner pursuant to section 181 of this title without the concurrence of the head of the departments and the chief officers of the agencies who caused the order to be issued. The license may be granted retroactively where an application has been inadvertently filed abroad and the application does not disclose an invention within the scope of section 181 of this title.

The term "application" when used in this chapter includes applications and any modifications, amendments, or supplements thereto, or divisions thereof.

35 U.S.C. 185. Patent barred for filing without license. Notwithstanding any other provisions of law any person, and his successors, assigns, or legal representatives, shall not receive a United States patent for an invention if that person, or his successors, assigns, or legal representatives shall, without procuring the license prescribed in section 184 of this title, have made, or consented to or assisted another's making, application in a foreign country for a patent or for the registration of a utility model, industrial design, or model in respect of the invention. A United States patent issued to such person, his successors, assigns, or legal representatives shall be invalid.

If, upon examining an application, the examiner learns of the existence of a corresponding foreign application which appears to have been filed before the United States application had been on file for six months, and if the invention apparently was made in this country, he shall refer the application to Licensing and Review Section of Group 220, calling attention to the foreign application. Pending investigation of the possible violation, the application may be returned to the examining group for prosecution on the merits. When it is otherwise in condition for allowance, the application will be again submitted to Licensing and Review Section of Group 220 unless the latter has already reported that the foreign filing involves no bar to the United States application.

If it should be necessary to take action under 35 U.S.C. 185, Licensing and Review Section of Group 220 will request transfer of the application to it.

Other Statutory Bars

Claims to an invention in public use or on sale in the United States more than twelve months before the effective U.S. filing date are rejected. 35 U.S.C. 102(b).

706.03(t) Other Assigned Application [R–19]

As pointed out in § 304, assignment of one of several overlapping applications of the same

inventor may give rise to a ground of rejection. See also §§ 305 and 706.03(k).

706.03(u) Disclaimer [R–19]

Claims may be rejected on the ground that applicant has disclaimed the subject matter involved. Such disclaimer may arise, for example, from the applicant's failure:

(a) to make claims suggested for interference with another application under rule 203, (§ 1101.01(m)),

(b) to copy a claim from a patent when suggested by the examiner (§ 1101.02(f)), or

(c) to respond or appeal, within the time limit fixed, to the examiner's rejection of claims copied from a patent (see rule 206(b) and § 1101.02(f)).

The rejection on disclaimer applies to all claims not patentably distinct from the disclaimed subject matter as well as to the claims directly involved.

706.03(v) After Interference or Public Use Proceeding [R–20]

For rejections following an interference, see §§ 1109 to 1110.

The outcome of public use proceedings may also be the basis of a rejection. (See rule 292).

Upon termination of a public use proceedings including a case also involved in interference, in order for a prompt resumption of the interference proceedings, a notice should be sent to the Board of Patent Interferences notifying them of the disposition of the public use proceedings.

706.03(w) Res Judicata [R–40]

Res Judicata may constitute a proper ground for rejection. However, as noted below, the Court of Customs and Patent Appeals has materially restricted the use of res judicata rejections. It should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision.

The timely filing of a second application copending with an earlier application does not preclude the use of *res judicata* as a ground of rejection for the second application claims.

When making a rejection on *res judicata*, action should ordinarily be made also on the basis of prior art, especially in continuing applications.

In the following cases a rejection of a claim on the ground of res judicata was sustained where it was based on a prior adjudication against the inventor on the same claim, a patentably nondistinct claim, or a claim involving the same issue.

Edgerton v. Kingsland, 75 USPQ 307 (D.C. Cir., 1947).

In re Swarc, 138 USPQ 208, 50 CCPA 1571 (1963).

In re Katz, 167 USPQ 487, 58 CCPA 713 (1970), (prior decision by District Court).

In the following cases for various reasons, res judicata rejections were reversed.

In re Fried, 136 USPQ 429, 50 CCPA 954 (1963) (differences in claims).

In re Szwarc, 138 USPQ 208, 50 CCPA 1571 (1963) (differences in claims).

In re Hellbaum, 152 USPQ 571, 54 CCPA 1051 (1967) (differences in claims).

In re Herr, 153 USPQ 548, 54 CCPA 1315 (1967) (same claims, new evidence, prior decision by CCPA).

In re Kaghan, 156 USPQ 130, 55 CCPA 844 (1967) (prior decision by Board of Appeals, final rejection on prior art withdrawn by examiner "to simplify the issue", differences in claims; holding of waiver based on language in MPEP at the time).

In re Craig, 162 USPQ 157, 56 CCPA 1438 (1969) (Board of Appeals held second set of claims patentable over prior art).

In re Fisher, 166 USPQ 18, 57 CCPA 1099 (1970) (difference in claims).

In re Russell, 169 USPQ 426, 58 CCPA 1081 (1971) (new evidence, rejection on prior art reversed by court).

In re Ackermann, 170 USPQ 340, 58 CCPA 1405 (1971) (prior decision by Board of Appeals, new evidence, rejection on prior art reversed by court).

Plastic Contact Lens Co. v. Gottschalk, 179 USPQ 262 (D.C. Cir., 1973) (follows In re Kayhan).

706.03(x) Reissue

35 U.S.C. 251 forbids the granting of a reissue "enlarging the scope of the claims of the original patent" unless the reissue is applied for within two years from the grant of the original patent. This is an absolute bar and cannot be excused. This prohibition has been interpreted to apply to any claim which is broader in any respect than the claims of the original patent. Such claims may be rejected as being barred by 35 U.S.C. 251. However, when the reissue is applied for within two years, the examiner does not go into the question of undue delay.

The same section permits the filing of a reissue application by the assignee of the entire interest only in cases where it does not "enlarge the scope of the claims of the original patent". Such claims which do enlarge the scope may also be rejected as barred by the statute.

A *defective reissue* oath affords a ground for rejecting all the claims in the reissue application. See § 1401.08.

Note that a reissue application is "special" and remains so even if applicant does not make a prompt response.

706.03(y) Improper Markush Group [R–34]

Ex parte Markush, 1925 C.D. 126; 340 O.G. 839, sanctions, in chemical cases, claiming a genus expressed as a group consisting of certain specified materials. This type of claim is employed when there is no commonly accepted generic expression which is commensurate in scope with the field which the applicant desires to cover. Inventions in metallurgy, refractories, ceramics, pharmacy, pharmacology and biology, may be claimed under the Markush formula but it has consistently been held to be improper to extend it to purely mechanical features or process steps. It is improper to use the term "comprising" instead of "consisting of". Ex parte Dotter, 12 USPQ 382. Regarding the normally prohibited inclusion of Markush claims of varying scope in the same case, see Ex parte Burke, 1934 C.D. 5; 441 O.G. 509.

The use of Markush claims of diminishing scope should not, in itself, be considered a sufficient basis for objection to or rejection of claims. However, if such a practice renders the claims indefinite or if it results in undue multiplicity, an appropriate rejection should be made. This practice with respect to Markush claims of diminishing scope is being continued.

The materials set forth in the Markush group ordinarily must belong to a recognized physical or chemical class or to an art-recognized class. However, when the Markush group occurs in a claim reciting a process or a combination (not a single compound), it is sufficient if the members of the group are disclosed in the specification to possess at least one property in common which is mainly responsible for their function in the claimed relationship, and it is clear from their very nature or from the prior art that all of them possess this property. While in the past the test for Markush-type claims was applied as liberally as possible, present practice which holds that claims reciting Markush groups are not generic claims (§ 803) may subject the groups to a more stringent test for propriety of the recited members. Where a Markush expression is applied only to a portion of a chemical compound, the propriety of the grouping is determined by a consideration of the compound as a whole, and does not depend on there being a community of properties in the members of the Markush expression.

When materials recited in a claim are so related as to constitute a proper Markush group, they may be recited in the conventional manner, or alternatively. For example, if "wherein R is a material selected from the group consisting of A, B, C and D" is a proper limitation then "wherein R is A, B, C or D" shall also be considered proper.

Subgenus Claim

A situation may occur in which a patentee has presented a number of examples which, in the examiner's opinion, are sufficiently representative to support a generic claim and yet a court may subsequently hold the claim invalid on the ground of undue breadth. Where this happens the patentee is often limited to species claims which may not provide him with suitable protection.

The allowance of a Markush type claim under a true genus claim would appear to be beneficial to the applicant without imposing any undue burden on the Patent Office or in any way detracting from the rights of the public. Such a subgenus claim would enable the applicant to claim all the disclosed operative embodiments and afford him an intermediate level of protection in the event the true genus claims should be subsequently held invalid.

The examiners are therefore instructed not to reject a Markush type claim merely because of the presence of a true genus claim embracive thereof.

See also §§ 608.01(p) and 715.03.

706.03(z) Undue Breadth [R–32]

In applications directed to inventions in arts where results are predictable, broad claims may

properly be supported by the disclosure of a single species. In re Vickers et al., 1944 C.D. 324; 61 USPQ 122: In re Cook and Merigold, 169 USPQ 298.

However, in applications directed to inventions in arts where the results are unpredictable, the disclosure of a single species usually does not provide an adequate basis to support generic claims. In re Sol, 1938 C.D. 723; 497 O.G. 546. This is because in arts such as chemistry it is not obvious from the disclosure of one species, what other species will work. In re Dreshfield, 1940 C.D. 351; 518 O.G. 255 gives this general rule: "It is well settled that in cases involving chemicals and chemical compounds, which differ radically in their properties it must appear in an applicant's specification either by the enumeration of a sufficient number of the members of a group or by other appropriate language, that the chemicals or chemical combinations included in the claims are capable of accomplishing the desired result." The article "Broader than the Disclosure in Chemical Cases", 31 J.P.O.S. 5, by Samuel S. Levin covers this subject in detail.

706.04 Rejection of Previously Allowed Claims

A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and approval of the proposed action.

Great care should be exercised in authorizing such a rejection. See Ex parte Grier, 1923 C.D. 27; 309 O.G. 223; Ex parte Hay, 1909 C.D. 18; 139 O.G. 197.

Previous Action by Different Examiner

Full faith and credit should be given to the search and action of a previous examiner unless there is a clear error in the previous action or knowledge of other prior art. In general, an examiner should not take an entirely new approach or attempt to reorient the point of view of a previous examiner, or make a new search in the mere hope of finding something.

Because it is unusual to reject a previously allowed claim, the examiner should point out in his letter that the claim now being rejected was previously allowed.

706.05 Rejection After Allowance of Application

See § 1308.01 for a rejection based on a reference.

For rejection of claims in an allowed case which has failed to make the date of a senior application in correspondence under rule 202, see § 1101.01(i).

706.06 Rejection of Claims Copied From Patent

See § 1101.02(f).

706.07 Final Rejection

Rule 113. Final rejection or action. (a) On the second or any subsequent examination or consideration, the rejection or other action may be made final, whereupon applicant's response is limited to appeal in the case of rejection of any claim (rule 191) or to amendment as specified in rule 116. Petition may be taken to the Commissioner in the case of objections or requirements not involved in the rejection of any claim (rule 181). Response to a final rejection or action must include cancellation of, or appeal from the rejection of, each claim so rejected and, if any claim stands allowed, compliance with any requirement or objection as to form.

(b) In making such final rejection, the examiner shall repeat or state all grounds of rejection then considered applicable to the claims in the case, clearly stating the reasons therefor.

Before final rejection is in order a clear issue should be developed between the examiner and applicant. To bring the prosecution to as speedy conclusion as possible and at the same time to deal justly by both the applicant and the public, the invention as disclosed and claimed should be thoroughly searched in the first action and the references fully applied; and in response to this action the applicant should amend with a view to avoiding all the grounds of rejection and objection. Switching from one subject matter to another in the claims presented by applicant in successive amendments, or from one set of references to another by the examiner in rejecting in successive actions claims of substantially the same subject matter, will alike tend to defeat attaining the goal of reaching a clearly defined issue for an early termination; i.e., either an allowance of the case or a final rejection.

While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection", present practice does not sanction hasty and ill-considered final rejections. The applicant who is seeking to define his invention in claims that will give him the patent protection to which he is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the

prosecution of his case. But the applicant who dallies in the prosecution of his case, resorting to technical or other obvious subterfuges in order to keep the application pending before the primary examiner, can no longer find a refuge in the rules to ward off a final rejection.

The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal is prosecuted. However, it is to the interest of the applicants as a class as well as to that of the

public that prosecution of a case be confined to as few actions as is consistent with a thorough consideration of its merits.

Neither the statutes nor the Rules of Practice confer any right on an applicant to an extended prosecution. Ex parte Hoogendam, 1939 C.D. 3; 499 O.G. 3.

STATEMENT OF GROUNDS

In making the final rejection, all outstanding grounds of rejection of record should be carefully reviewed, and any such grounds relied on in the final rejection should be reiterated. They must also be clearly developed to such an extent that applicant may readily judge the advisability of an appeal unless a single previous Office action contains a complete statement supporting the rejection.

However, where a single previous Office action contains a complete statement of a ground of rejection, the final rejection may refer to such a statement and also should include a rebuttal of any arguments raised in the applicant's response. If appeal is taken in such a case, the examiner's answer should contain a complete statement of the examiner's position. The final rejection letter should conclude with a statement that:

"The above rejection is made FINAL", or "This is a FINAL rejection".

The Office action first page form POL–326 should be used in all Office actions up to and including final rejections.

A final rejection must be signed by a primary examiner.

For amendments filed after final rejection, see §§ 714.12 and 714.13. [R–29]

706.07(a) Final Rejection, When Proper on Second Action [R–43]

Due to the change in practice as affecting final rejections, older decisions on questions of prematureness of final rejection or admission of subsequent amendments do not necessarily reflect present practice.

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection not necessitated by amendment of the application by applicant whether or not the prior art is already of record. Furthermore, a second or any subsequent action on the merits in any application will not be made final if it includes a rejection, on newly cited art, of any claim not amended by applicant in spite of the fact that other claims may have been amended to require newly cited art.

See § 809.02(a) for actions which indicate generic claims not allowable.

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the examiner should be on guard not to allow such claims. See § 714.04. The claims, however, may be finally rejected if, in the opinion of the examiner, they are clearly open to rejection on grounds of record.

706.07(b) Final Rejection, When Proper on First Action [R–43]

The claims of a new application may be finally rejected in the first Office action in those situations where (1) the new application is a continuing application of, or a substitute for, an earlier application, and (2) all claims of the new application (a) are drawn to the same invention claimed in the earlier application, and (b) would have been properly finally rejected on the grounds or art of record in the next Office action if they had been entered in the earlier application.

However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry for one of the following reasons:

(1) New issues were raised that required further consideration and/or search, or

(2) The issue of new matter was raised.

Further, it would not be proper to make final a first Office action in a continuation-in-part application where any claim includes subject matter not present in the earlier application.

A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

706.07(c) Final Rejection, Premature

Any question as to prematureness of a final rejection should be raised, if at all, while the case is still pending before the primary examiner. This is purely a question of practice, wholly distinct from the tenability of the rejection. It may therefore not be advanced as a ground for appeal, or made the basis of complaint before the Board of Appeals. It is reviewable by petition.

706.07(d) Final Rejection, Withdrawal of, Premature [R–29]

If, on request by applicant for reconsideration, the primary examiner finds the final rejec-

tion to have been premature, he should withdraw the finality of the rejection.

706.07(e) Withdrawal of Final Rejection, General [R–22]

See §§ 714.12 and 714.13, Amendments after final rejection.

Once a final rejection that is not premature has been entered in a case, however, it should not be withdrawn at the applicant's request except on the showing of rule 116. This does not mean that no further amendment or argument will be considered. An amendment that will place the case either in condition for allowance or in better form for appeal may be admitted. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with rule 116(a).

The examiner may withdraw the rejection of finally rejected claims. If new facts or reasons are presented such as to convince the examiner that the previously rejected claims are in fact allowable, then the final rejection should be withdrawn. Occasionally, the finality of a rejection may be withdrawn in order to apply a new ground of rejection.

Although it is permissible to withdraw a final rejection for the purpose of entering a new ground of rejection, this practice is to be limited to situations where a new reference either fully meets at least one claim or meets it except for differences which are shown to be completely obvious. Normally, the previous rejection should be withdrawn with respect to the claim or claims involved.

The practice should not be used for application of subsidiary references, or of cumulative references, or of references which are merely considered to be better than those of record. Furthermore, the practice should not be used for entering new non-reference or so-called "formal" grounds of rejection such as those under 35 U.S.C. 112.

When a final rejection is withdrawn, all amendments filed after the final rejection are ordinarily entered.

707 Examiner's Letter or Action [R–43]

Rule 104. Nature of examination; examiner's action.

(a) On taking up an application for examination, the examiner shall make a thorough study thereof and shall make a thorough investigation of the available prior art relating to the subject matter of the invention sought to be patented. The examination shall be complete with respect both to compliance of the application with the statutes and rules and to the patentability of the invention as claimed, as well as with respect to matters of form, unless otherwise indicated.

(b) The applicant will be notified of the examiner's action. The reasons for any adverse action or any objection or requirement will be stated and such information or references will be given as may be useful in aiding the applicant to judge of the propriety of continuing the prosecution of his application.

Under the current first action procedure, the examiner signifies on the action form POL–326 certain information including the period set for response, any attachments, and a "summary of action," the position taken on all claims.

This procedure also allows the examiner, in the exercise of his professional judgment to indicate that a discussion with applicant's representative may result in agreements whereby the application may be placed in condition for allowance and that the examiner will telephone the representative within about two weeks. Under this practice the applicant's representative can be adequately prepared to conduct such a discussion. Any resulting amendment may be made either by the applicant's attorney or agent or by the examiner in an examiner's amendment. It should be recognized that when extensive amendments are necessary it would be preferable if they were filed by the attorney or agent of record, thereby reducing the professional and clerical workload in the Office and also providing the file wrapper with a better record, including applicant's arguments for allowability as required by rule 111.

The list of references cited appears on a separate form, Notice of References Cited, PO–892, (copy in § 707.05) attached to applicant's copies of the action. Where applicable, Notice of Informal Patent Drawings, PO–948 and Notice of Informal Patent Application, PO–152 are attached to the first action.

The attachments have the same paper number and are to be considered as part of the Office action.

Replies to Office actions should include the 3-digit art unit number and the examiner's name to expedite handling within the Office.

In accordance with the Patent Statute, "Whenever, on examination, any claim for a patent is rejected or any objection . . . made" (35 U.S.C. 132) notification of the reasons for rejection and/or objection together with such information and references as may be useful in judging the propriety of continuing the prosecution, as required under the Statute, should appear in colums 2–4 of a completed form PO–1142, supplemented by relevant sections of the Statute on the reverse side of the form.

Upon proper completion of form PO–1142:

Column 1 will identify the rejected and/or objected claim(s);

U.S. DEPARTMENT OF COMMERCE
Patent Office

Address Only: COMMISSIONER OF PATENTS
Washington, D.C. 20231

C.D.Henry Art Unit 118

03/21/74 999,997
John A. Novel

Paper No. 1 MAILED

Mailed JAN 14 1975

GROUP 110

John C. Able
1234 Jefferson Davis Highway
Arlington, Virginia 22202

This is a communication from the Examiner in charge of your application.

Commissioner of Patents

☒ This application has been examined.

☐ Responsive to communication filed _____. ☐ This action is **made final.**

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE

3 MONTH(S) ~~DAYS~~ FROM THE DATE OF THIS LETTER

PART I

The following attachments(s) are part of this action:

a. ☒ Notice of References Cited, Form PO-892 b. ☐ Notice of Informal Patent Drawing, PO-948.

c. ☐ Notice of Informal Patent Application, Form PO-152 d. ☐

PART II

Summary of Action

1. ☒ Claims 1-11 are presented for examination.

2. ☐ Claims _____ are allowed.

3. ☒ Claims 9-11 would be allowable if amended as indicated.

4. ☒ Claims 1-8 are rejected.

5. ☒ Claims 9-11 are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ Claims _____ are withdrawn from consideration.

8. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 OG. 213.

9. ☐ Since it appears that a discussion with applicant's representative may result in agreements whereby the application may be placed in condition for allowance, the examiner will telephone the representative within about 2 weeks from the date of this letter.

10. ☐ Receipt is acknowledged of papers under 35 USC 119, which papers have been placed of record in the file.

11. ☐ Applicant's claim for priority based on an application filed in _____ on _____ is acknowledged. It is noted, however, that a certified copy as required by 35 USC 119 has not been received.

12. ☐ Other

POL 326 (10-70)

—1—

567-749 O - 75 - 2

FORM PO-1142 (Rev. 6-72) — U. S. DEPARTMENT OF COMMERCE Patent Office

PART III — SERIAL NUMBER 999,999 — GROUP ART UNIT 353

NOTIFICATION OF REJECTION(S) AND/OR OBJECTION(S) (35 USC 132)

	CLAIMS (1)	REASONS FOR REJECTION (2)	REFERENCES * (3)	INFORMATION IDENTIFICATION AND COMMENTS (4)
1	1,3,4	35 U.S.C. 102	A	
2	2,5	35 U.S.C. 102	B/C	Axle assemblies of each fixed to tubular members (Fig. 2 of B, Fig. 4 of C).
3	6,7	35 U.S.C. 103	D v E+F	Obvious to extend auxiliary wheels of D (Fig. 1) laterally as in E (p. 2, ls. 1-6). Also, obvious to provide vertically adjustable wheels in D as shown by F (Fig. 3).
4	6,7	35 U.S.C. 112	—	"Aperture" is misdescriptive in defining a sleeve within a frame member.
5	8	35 U.S.C. 103	A v E	Obvious to extend auxiliary wheels of A (Fig. 1) laterally as in E (p. 2, ls. 1-6).
6	9-11	—	—	Objected to — depend from rejected claim; will be allowed if rewritten in independent form.

7 Claim 6 would be allowed if amended to recite the specific hydraulic wheel-moving arrangement.

8 G cited to show an analogous hydraulic wheel-moving mechanism.

* Capital letters representing references are identified on accompanying Form PO-892.
The symbol "v" between letters represents – in view of –.
The symbol "+" or "&" between letters represents – and –.
A slash "/" between letters represents the alternative – or –.

NOTE Sections 100, 101, 102, 103 and 112 of the Patent Statute (Title 35 of the United States Code) are reproduced on the back of this sheet.

EXAMINER ——— TEL. NO. (703) -557 -3070

Thomas F. Callaghan
Primary Examiner
Art Unit 353

-2-

Column 2, in the case of a rejection, will give the reason by designating the applicable statutory or other legal ground;

Column 3 will identify the references relied upon in the rejection by the capital letters on "Notice of References Cited" form PO–892, the relation of the references as applied being indicated by symbols illustrated and defined at the bottom of the form;

Column 4 will supply the necessary information useful in judging the propriety of continuing the prosecution.

When considered necessary for adequate information, the particular figure(s) of the drawing(s), and/or page(s) or paragraph(s) of the reference(s), and/or any relevant comments briefly stated should be inserted in column 4. For rejections under section 103, the way in which a reference is modified or plural references are combined should be set out in condensed language.

In exceptional cases, as to satisfy the more stringent requirements under rule 106(b), and in pro se cases where the inventor is unfamiliar with the patent law and practice, a more complete explanation may be needed. If necessary, a regular action, not using form PO–1142, may be prepared.

Revised "Notice of References Cited" form PO–892 with the capital letters in the left-hand margin should be used with form PO–1142. To facilitate the use of these letters for reference identification, the patents and other references should be listed in the order they are first used on form PO–1142. Accordingly, the first U.S. patent used as a reference in preparing form PO–1142 will be identified by letter "A" and listed in the first line of form PO–892 regardless of the patent number, the second U.S. patent used will be identified as "B" and listed in the second line, etc. The first foreign patent or publication used will be listed on the line identified by letter "L".

Objections to the disclosure, explanation of references cited but not applied, indication of allowable subject matter, requirements (including requirements for restriction if space is available) and any other pertinent comments may be written at the bottom of form PO–1142.

Summary sheet POL–326, which serves as the first page of the Office action, will continue to be used with all first actions and, as usual, will identify any allowed claims. This summary sheet, designated as page 1, identifies two parts of the Office action with Roman numerals as "Part I" and "Part II".

Form PO–1142 has "Part III" printed thereon for identification and distinction with regard to other parts of the action. The form is to be numbered page 2 in the space provided at the bottom, and material to be inserted on the lower part of the form should be arranged in paragraph format starting with and sequentially numbered after paragraph 5 with a blank space between each paragraph.

The prearranged paragraphs numbered 1–4 on the upper part of form PO–1142 are expected to be adequate for all the claims that are subject to rejection and/or objection in most cases. If additional paragraphs are needed for that purpose, they may be arranged on the lower part of the form with the claims, reasons for rejection, references and information vertically aligned with the columns on the upper part of the form, with or without extending the vertical column lines downward and, if extended downward, prefereably without passing through the vacant space between paragraphs 4 and 5.

If space in the form including the lower part is inadequate for all the claims that are subject to rejection and/or objection, a second form PO–1142 may be used, marked as page 3 and further marked for distinguishing identification as "Part III–a" with the lower case letter "a" inserted after the printed Roman numeral III.

If the space on the form or forms is inadequate for completing the rest of the action (other than rejection and/or objection of claims), a regular blank action sheet may be used, marked with a page number succeeding the page number on the form(s). This page should be marked as "Part IV", and marked with paragraph numbers in sequential order starting with number "1".

If form PO–1142 is the last sheet of the action without additional typed pages annexed, examiner's signatures and telephone numbers should be located at the bottom of the form at the indicated location.

A yellow worksheet form PO–1142A, corresponding to the form PO–1142, is available for use by the examiner in preparing his action for typing. However, the action should preferably be written or printed by hand directly on form PO–1142, rather than typed if the writing or printing is legible and clearly readable in the opinion of the supervisory primary examiner. All doubts concerning legibility of writing or printing shall be resolved in favor of a typed action. A BLACK INK BALL POINT PEN MUST BE USED.

The first action should be complete, with a full explanation of the reasons for decisions on the merits in condensed language, using essential words and phrases in abbreviated form. Identification of patentable subject matter and constructive suggestions for rendering the case allowable should be made whenever possible, § 707.07(j).

Form PO–1142 should be used only for non-final first actions on the merits concerned with the rejection and/or objection of claims on statutory or other legal grounds.

Second actions are to be made final according to prevailing practice using conventional reference identification, such as patentee name, rather than the capital letter symbols used on the first action form PO–1142.

It is imperative that the condensed language used on form PO–1142 be clear, intelligible and complete for communication to the applicant.

Suggestions

(1) When examiner writes a significant portion of the action on PO–1142, decides to make a *major* change, rather than rewriting the action, the PO–1142 should be completed and one sheet used as a worksheet for having the action typed.

(2) If an examiner's initial attempts at hand written or printed actions are not deemed to be easily readable, rather than assuming that all of his actions should be typed, he should be encouraged to make further attempts, adjusting his writing or printing by making the individual letters wider and by making *all* letters as large as the space between the lines permits.

(3) All *carbon copies* of PO–1142 should be checked for legibility before the action is handed in for counting.

(4) When actions are returned by the Reference Processing Section (RPS) for correction, they should be routed to the examiner by way of the supervisory patent assistant (SPA) and the supervisory primary examiner (SPE).

(5) When action returned from RPS with copy indicating defect.

a. If feasible, correct (e.g., insert phone number),

b. If not feasible to correct, use original copy of returned PO–1142 as worksheet and have new PO–1142 typed.

Instructions

(1) PO–1142 can be used for actions on the merits prior to the attorney's response to the first action on the merits, as for example, a supplemental action, the previous action being the first action on the merits or for a first action on the merits which is not the first action in the case, but it should not be used for a second action on the merits which is not made final since the attorneys are expected to respond to all actions by using the names of the references rather than the capital letters used on PO–1142. All other Office actions should also use the names for the references. If a PO–1142 is used for a supplemental action, the previous action having been the first action on the merits, and additional references are cited, begin the citation of the references on the new PO–892 on the line having the letter following the last letter used on the first PO–892 for that type of reference.

(2) When using PO–1142, if the examiner finds it necessary to cite more references on PO–892 than is provided for on the form for any of the three types of references, he should use an additional PO–892 drawing a line through the letters used to designate that type of reference and to the left of these letters insert V, W, X, Y, Z, as necessary.

(3) Prior to starting to write a rejection in Column 4, if the examiner feels certain that he will not have enough room in a single box in that column, he should merely insert: "See paragraph 6" (or another appropriate paragraph number) and write the rejection in that paragraph. If he has any doubts as to whether the rejection will fit in the box, he should write the rejection in the box. On reaching the last line, if he finds that he will not have enough room, at the end of that line he should write "Continued in paragraph 6" (or another appropriate paragraph no.) and finish the rejection in that paragraph. Under no circumstances should a rejection started in column 4 of any of the first five paragraphs be continued into the next numbered paragraph of that column.

(4) When PO–1142 is the last page of the action, the names, signatures, and telephone number that appears at the end of a conventional action should be placed in the box in the lower right-hand corner of the form. The telephone number should include area code 703 and Patent and Trademark Office prefix 557 as well as the examiner's extension.

(5) Examiners are never to fill out address part of POL–326.

(6) In Col. 4, the references should always be referred to by the appropriate letter. The symbols appearing at the bottom of the form should never be used in Column 4.

(7) When a section of U.S.C. is referred to in Col. 2, it should always include 35 U.S.C. as well as the section of the statute.

(8) Only capital letters representing references and the symbols appearing at the bottom of the form should appear in Col. 3. For example, the examiner should not indicate in Col. 3—

AvB
as applied
above
vD

(9) Reference citation form PO–892 should be marked with the paper number to which it is an attachment.

(10) Old forms POL–326 and PO–892 (dated earlier than 10–70), should never be used with PO–1142 but they may be used with other actions.

(11) The three parts of the action (forms POL–326, PO–892 and PO–1142) should be stapled together when finally placed in the file wrapper.

MOST FREQUENT DEFECTS

(1) No telephone number.

(2) Reference names used in Col. 4 and paragraph 6.

(3) Writing or printing not easily readable:
Carbon too light
Printing too small or compressed
Handwriting not easily readable

(4) References merely described and not combined in Column 4. [R–36]

707.01 Primary Examiner Indicates Action for New Assistant [R–20]

After the search has been completed, action is taken in the light of the references found. Where the assistant examiner has been in the Office but a short time, it is the duty of the primary examiner to go into the case thoroughly. The usual procedure is for the assistant examiner to explain the invention and discuss the references which he regards as most

pertinent. The primary examiner may indicate the action to be taken, whether restriction or election of species is to be required, or whether the claims are to be considered on their merits. If action on the merits is to be given, he may indicate how the references are to be applied in cases where the claim is to be rejected, or authorize allowance if it is not met in the references and no further field of search is known.

707.02(a) Cases Up for Third Action and Five-Year Cases [R–41]

The supervisory primary examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them.

The supervisory primary examiners are expected to personally check on the pendency of every application which is up for the third or subsequent official action with a view to finally concluding its prosecution.

Any case that has been pending five years should be carefully studied by the supervisory primary examiner and every effort made to terminate its prosecution. In order to accomplish this result, the case is to be considered "special" by the examiner.

707.04 Initial Sentence [R–22]

The "First Page of Action" form POL–326 contains an initial sentence which indicates the status of that action, as, "This application has been examined" if it is the first action in the case, or, "Responsive to communication filed ———." Other papers received, such as supplemental amendments, affidavits, new drawings, etc., should be separately mentioned.

A preliminary amendment in a new case should be acknowledged by adding a sentence such as "The amendment filed (date) has been received."

707.05 Citation of References [R–25]

During the examination of an application the examiner should cite appropriate prior art which is nearest to the subject matter defined in the claims. When such prior art is cited, its pertinence should be explained.

All allowed applications should contain a citation of the prior art for printing in the patent. Only in rare instances involving pioneer inventions, such as new chemical compounds, would it be appropriate to send a case to issue with no art cited. In the exceptional case where no prior art is cited, the examiner must write "None" on a form PO–892 and insert it in the file wrapper. On the allowance of a continuation application where references have been cited during the prosecution of the parent application, no additional citation of the prior art is necessary. See § 1302.12.

In all continuing applications, the parent applications should be reviewed for pertinent prior art.

Rule 107. Citation of references. If domestic patents be cited, their numbers and dates, the names of the patentees, and the classes of inventions must be stated. If foreign patents be cited, their nationality or country, numbers and dates, and the names of the patentees must be stated, and such other data must be furnished as may be necessary to enable the applicant to identify the patents cited. In citing foreign patents, in case part only of the patent be involved, the particular pages and sheets containing the parts relied upon must be identified. If printed publications be cited, the author (if any), title, date, pages or plates, and place of publication, or place where a copy can be found, shall be given. When a rejection is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons.

TO SEPARATE, HOLD TOP AND BOTTOM EDGES, SNAP-APART AND DISCARD CARBON

FORM PO-892 REV. 4/71 — U. S. DEPARTMENT OF COMMERCE PATENT OFFICE

NOTICE OF REFERENCES CITED

☐ Check here if this is a supplemental citation. (Do not prepare an additional folder.)

SERIAL NO.	GROUP ART UNIT	ATTACHMENT TO PAPER NUMBER
999,998	425	

APPLICANT(S): NOVEL et al

U. S. PATENTS

•		PATENT NO.	DATE	PATENTEE	CLASS	SUB-CLASS	FILING DATE IF APPROPRIATE
	A	2091086	8-1937	TAYLOR	315	71 UX	
	B	2717874	9-1955	VERAIN	21	102 R X	
X	C	2572144	10-1951	HEALY	340	71 X	
	D	2137376	11-1938	ALTORFER	21	DIG. 2	
	E	2403912	7-1946	DOLL	100	269 B UX	
	F	P.P. 24000	5-1964	BOERNER	Plant	20	
	G	1671843	5-1928	SCOTT	15	104.01 R	
	H	D 219366	12-1970	LEWIS Jr. et al	D9	46	6-26-1969
	I	3143924	8-1964	PEARSON et al	100	258 A	
	J	Re. 18406	4-1932	MARINSKY	24	205.16 C	
X	K	3035319	5-1962	WOLFF	24	274 WB X	

FOREIGN PATENTS OR PUBLISHED APPLICATIONS

•		PATENT NO.	DATE	COUNTRY	NAME	CLASS	SUB-CLASS	PERTINENT SHTS. DWG	PERTINENT PP. SPEC.
	L	136113	1-1950	AUSTRALIA	PAPER PRODUCTS	24	134 QA		
	M	Add. 346222	11-1934	FRANCE	LORENZ	26	15 R	1	4-7
	N	194211	of 1913	GREAT BRITAIN	CROSSE	26	51.5		
X	O	1345890	7-1963	GERMANY	MUTHER	19	6		
	P	683125	3-1964	CANADA	FISHBURNE	100	216	1-5	1-19
	Q								

OTHER REFERENCES (Including Author, Title, Date, Pertinent Pages, Etc.)

R: JONES, Def. Pub. of Serial No. 30,226, filed 4-20-70, published in 881 O.G. 21 on 12-1-1970, Defensive Publication No. T881,002, 96-1.6

S: (S00840001) WINSLOW, C.E.A., Fresh Air and Ventilation, E.P. Dutton, N.Y., 1926, p. 97-112, TH 7653 W5, 315-22

T: Ballistic Missile & Aerospace Technology, Vol. 3, Academic Press, N.Y., 1964, TL 78759, p. 199, 250-108

U: Carbowax & Polyethylene Glycols, Carbide Chemical Corporation, 1946, p. 5, Copy in Group 120 Library

EXAMINER	DATE	
Jane Searcher	7-15-74	☐ CHECK HERE IF FOREIGN EXCHANGE

• ATTENTION R.O.B.: Do not furnish copy if this box is checked.

USCOMM-DC 50860 P71

707.05(a) Copies of Cited References Provided by Reference Processing Section [R–42]

Copies of cited references (except as noted below) are automatically furnished without charge to applicant together with the Office action in which they are cited. Copies of the cited references are also placed in the application file for use by the examiner during the prosecution.

Copies of references which are cited at the time of allowance, in Ex parte Quayle actions, and by applicant in accordance with §§ 707.05 (b) and 708.02 are *not* furnished to applicant with the Office action. Additionally, copies of references cited in continuation applications if they had been previously cited in the parent application are not furnished. In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent.

This service is furnished by the Reference Processing Section (R.P.S.) which is in charge of (1) ordering copies of the cited U.S. patents; (2) mailing the action with one copy of each cited reference and (3) after mailing, returning to the group the ribbon copy of the mailed action together with a copy of each reference to be placed in the application file.

To assist in providing this service, the examiner should:

(a) Write the citation of the references on form PO–892, "Notice of References Cited".

(b) Place the original copy of PO–892 in the file wrapper and give to the clerk with the completed Office action for counting.

(c) Write the application serial number on the plastic index tab of a special folder. Insert into the folder both carbon copies of PO–892 together with two copies of any foreign and other references cited in the action. Such copies of the foreign patents and publications should be made by the Coyping Center. Do not enclose any U.S. patents.

(d) Place the folder in the "Out Box for R.P.S."

Form PO–892 is completed and the folder prepared and forwarded to R.P.S. in all cases in which a reference is to be provided, regardless of the type reference cited.

If special handling is desired, a "special" sticker should be attached to the top of the folder.

Jumbo U.S. patents will be furnished to the applicant, but will not be placed in the application file. A tab card stamped "Jumbo Patent" will be inserted in the file to account for the missing reference.

Detailed instructions regarding the above outlined procedure, and the procedure to be followed in correcting an Office action prior to mailing are found in Chapter 400 of the Manual of Clerical Procedures.

In the case of design applications, procedures are the same as set forth in section 707.05(a)–(g) except that less than the entire disclosure of a cited patent may be supplied with the action by the Design group. Copies of all sheets of drawings and of the first page of the specification of cited patents are furnished without charge. Any other subject matter relied on by the examiner will also be provided without charge. Where an applicant desires a complete copy of a patent it may be obtained through the Customer Services Division at the usual charge.

707.05(b) Citation of Prior Art by Applicants [R–41]

This section sets forth positive guidelines for applicants, their attorneys and agents who desire to submit prior art for consideration by the Patent Office. Such citations of relevant art are welcomed and are encouraged. In order that they may be most effectively considered by the examiner, however, with as little disruption of the regular examination process as possible, it is requested that they be submitted in accordance with the following guidelines.

(1) Citations should be submitted within three months after the application filing date if possible. Any citation made after the first action on the merits (if this occurs more than three months after filing) should be accompanied by an explanation of why it was not earlier presented. This may take the form of a statement that it was made as soon as the art or other material was discovered, or as soon as its pertinency was appreciated, indicating the date of discovery of the cited material or its pertinency.

(2) Full text copies of the pertinent portions of all such prior art citations or other material relevant to patentability of the claimed invention should be supplied, whether the citation is made in a separate paper or in the specification of the application. This will be unnecessary in the case of pending or abandoned United States applications (e.g. Defensive Publications). In the case of publications, a copy of the title page, its copyright notice or other indication of a publication date, and copies of the entire pages which contain the text of the relevant material will be sufficient.

561-970 O - 74 - 2

While patent copies are, of course, available in the Patent Office, failure of the applicant to include copies of the cited art means that the examiner must interrupt his examination until copies can be ordered and received. Since the person making the citation will have copies in hand, an overall saving in time and more expeditious examination will result if copies are supplied with the citation.

(3) If the reference is not in English, a translation of its pertinent portions should be included.

(4) Accompanying each citation should be an indication of its pertinency to the claimed subject matter, together with any reasons applicant may wish to point out why the claims are considered to be patentable over the cited material.

All citations of prior art or other material submitted in accordance with the above guidelines and submitted before all claims have been indicated as allowable will be fully considered by the examiner.

While the Patent Office will not knowingly ignore any prior art which might anticipate or suggest the claimed invention, no assurance can be given that cited art or other material not submitted in accordance with these guidelines will be considered by the examiner. Consequently, any patent issuing on the application

in question would not be expected to be accorded the usual presumption of validity with respect to such cited art or material.

After the claims have been indicated as allowable by the examiner, e.g., by the mailing of an *Ex parte* Quayle action, a notice of allowability (POL–327), an examiner's amendment (POL–37), or a Notice of Allowance, any citations submitted will be placed in the file. Since prosecution has ended, however, such submissions will not ordinarily be considered by the examiner unless the citation is accompanied by:

(a) A proposed amendment cancelling or further restricting at least one independent claim and narrowing the scope of protection sought;

(b) A timely affidavit under Rule 131 (37 CFR 1.131) with respect to the material cited; or

(c) A statement by the applicant or his attorney or agent that, in the judgment of the person making the statement, the prior art or other material cited raises a serious question as to the patentability of the claimed subject matter.

If the material is submitted after the base issue fee has been paid, it must also be accompanied by a petition under Rule 183 (37 CFR 1.183) requesting a waiver of Rule 312 (37 CFR 1.312). Such petition, if granted, would result in review of the art by the examiner and possible entry of the amendment.

Submitted citations will not in any way diminish the obligation of examiners to conduct independent prior art searches, or relieve examiners of citing pertinent prior art of which they may be aware, whether or not such art is cited by the applicant. Nothing in this section is intended to relieve applicants of any responsibility they may have to cite known prior art to the Patent Office.

If the specification or a separate paper filed in the application contains citations relating to background material, applicant has the responsibility of determining whether or not such material is sufficiently relevant to the claimed invention that full compliance with these guidelines is necessary.

Prior art submitted by applicant in the manner provided herein will not be supplied with an Office action, but will be listed on the form PO–892, "Notice of References Cited," along with other prior art relied upon by the examiner during the examination. Only that prior art listed by the examiner on form PO–892, will be printed on the patent. However, the complete listing of applicant's citations will be in the application file and will be available for inspection by the public after issuance of the patent.

Citations of prior art may be placed of record in the patented file after the grant of the patent at the request of the patentee (see Section 100(d) of Title 35, United States Code, for definition of patentee). Any such submissions by the patentee will be placed in the patented file without comment by the Patent Office. Citations submitted to the Patent Office by third parties will not be placed in the record of a patented file unless the party submitting the art certifies that he has sent the owner of record copies of the cited art and of his letter transmitting it to the Patent Office.

707.05(c) Order of Listing [R–41]

In citing references for the first time, the identifying data of the citation should be placed on form PO–892 "Notice of References Cited", a copy of which will be attached to the Office action. No distinction is to be made between references on which a claim is rejected and those formerly referred to as "pertinent". With the exception of applicant submitted citations (§§ 707.05(b) and 708.02), the pertinent features of references which are not used as a basis for rejection, shall be pointed out briefly.

Revised "Notice of References Cited" form PO–892 with the capital letters in the left-hand margin should be used with form PO–1142. To facilitate the use of these letters for reference identification, the patents and other references should be listed in the order they are first used on form PO–1142. Accordingly, the first U.S. patent used as a reference in preparing form PO–1142 will be identified by letter "A" and listed in the first line of form PO–892 regardless of the patent number, the second U.S. patent used will be identified as "B" and listed in the second line, etc. The first foreign patent or publication used will be listed on the line identified by letter "L".

See § 1302.12.

707.05(d) Reference Cited in Subsequent Actions

Where an applicant in an amendatory paper refers to a reference which is subsequently relied upon by the examiner, such reference shall be cited by the examiner in the usual manner.

707.05(e) Data Used in Citing References [R–41]

Rule 107 (§§ 707.05 and 901.05(a)) requires the examiner to give certain data when citing references. The patent number, patent date, name of the patentee, class and subclass, and the filing date, if appropriate, must be given in the citation of U.S. patents. This information is listed on the "Notice of References Cited" form PO–892. See § 901.04 for details concerning the various series of U.S. patents and how to cite them. Note that patents of the X-Series (dated prior to July 4, 1836) are *not* to be cited by number. Some U.S. patents issued in 1861 have two numbers thereon. The larger number should be cited.

If the patent date of a U.S. patent is after and the effective filing date of the patent is before the effective U.S. filing date of the application, the filing date of the patent must be set forth along with the citation of the patent. This calls attention to the fact that the particular patent relied on is a reference because of its filing date and not its patent date. Similarly, when the reference is a continuation-in-part of an earlier-filed application which discloses the anticipatory matter and it is necessary to go back to the earlier filing date, the fact that the subject matter relied upon was originally disclosed on that date in the first application should be stated.

In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. See § 707.05(a).

Cross-References

Official cross-references should be marked "X" and unofficial cross-references "UX".

Foreign Patents and Published Applications

In citing foreign patents, the patent number, citation date, name of the country, name of the patentee, and class and subclass must be given.

In actions where references are furnished, and (1) less than the entire disclosure is relied upon, the sheet and page numbers specifically relied upon and the total number of sheets of drawing and pages of specification must be included (except applicant submitted citations); (2) the entire disclosure is relied upon, the total number of sheets and pages are not included, and the appropriate columns on PO–892 are left blank.

Publications such as German allowed applications and Belgian and Netherlands printed specifications should be similarly handled. If the total number of sheets and pages in any publication *to be furnished* (other than U.S. patents) exceeds 15, the authorizing signature of the supervisory primary examiner is required. Applicants who desire a copy of the complete foreign patent or of the portion not "relied on" must order it in the usual manner.

See § 901.05(a) for a chart in which foreign language terms indicative of foreign patent and publication dates to be cited are listed.

Publications

See § 711.06(a) for citation of abstracts, abbreviatures and defensive publications. See § 901.06(c) for citation of Alien Property Custodian publications.

In citing a publication, sufficient information should be given to determine the identity and facilitate the location of the publication. The data required by rule 107 (§ 707.05) with the specific pages relied on identified together with the SCIENTIFIC LIBRARY call number will suffice. The call number appears on the "spine" of the book if the book is thick enough and, in any event, on the back of the title page. Books on interlibrary loan will be marked with the call number of the other library, of course. THIS NUMBER SHOULD NOT BE CITED. If the copy relied upon is located only in the group making the action (there may be no call number), the additional information, "Copy in Group ——" should be given.

Examples of nonpatent bibliographical citations:

Winslow, C. E. A. Fresh Air and Ventilation. N.Y., E. P. Dutton, 1926. p. 97–112. TH7653.W5.

Singer, T. E. R. Information and Communication Practice in Industry. N.Y., Reinhold, 1958. Chapter 8, p. 157–165, by J. F. Smith, Patent Searching. T175.S5.

Machinery's Handbook, 16th ed. N.Y., Industrial Press, 1959. p. 1526–1527. TJ151.M3 1959.

Calvert, R. Patents (Patent Law). In Encyclopedia of Chemical Technology, ed. by R. E. Kirk and D. F. Othmer. N.Y., Interscience Encyclopedia. Vol. 9, 1952, p. 868–890. TP9. E68.

Hine, J. S. Physical Organic Chemistry. N.Y., McGraw-Hill, 1956, p. 81. QD476.H5.

Noyes, W. A., Jr. A Climate for Basic Chemical Research. In Chem. & Eng. News. 38(42): p. 91–95. Oct. 17, 1960. TP1.I418.

NOTE: In this citation, 38 is the volume number, 42 the issue number, and 91–95 the page numbers.

If the original publication is located outside the Office, the examiner should immediately order a photocopy of at least the portion relied upon and indicate the class and subclass in which it will be filed. The Office action MUST designate this class and subclass.

Whenever, in citing references anywhere in the application file the titles of periodicals are abbreviated, the abbreviations of titles used in Chemical Abstracts and printed in the list of periodicals abstracted by Chemical Abstracts should be adopted with the following exceptions: (1) the abbreviation for the Berichte der Deutschen Chemischen Gesellschaft should be Ber. Deut. Chem. rather than Ber., and (2) where a country or city of origin is a necessary part of a complete identification, the country or city of origin should be added in parentheses; e.g., J. Soc. Chem. Ind. (London).

707.05(f) Effective Dates of Declassified Printed Matter [R–31]

In using declassified material as references there are usually two pertinent dates to be considered, namely, the printing date and the publication date. The printing date in some instances will appear on the material and may be considered as that date when the material was prepared for limited distribution. The publication date is the date of release when the material was made available to the public. See Ex parte Harris et al., 79 USPQ 439. If the date of release does not appear on the material, this date may be determined by reference to the Office of Technical Services, Department of Commerce.

In the use of any of the above noted material as an anticipatory publication, the date of release following declassification is the effective date of publication within the meaning of the statute.

For the purpose of anticipation predicated upon prior knowledge under 35 U.S.C. 102(a) the above noted declassified material may be taken as prima facie evidence of such prior knowledge as of its printing date even though such material was classified at that time. When so used the material does not constitute an absolute statutory bar and its printing date may be antedated by an affidavit or declaration under rule 131.

707.05(g) Incorrect Citation of References [R–36]

Where an error in citation of a reference is brought to the attention of the Office by applicant, a letter correcting the error and restarting the previous period for response, together with a correct copy of the reference, is sent to applicant. Where the error is discovered by the examiner, applicant is also notified and the period for response restarted. In either case, the examiner is directed to correct the error, in ink, in the paper in which the error appears, and place his initials on the margin of such paper, together with a notation of the paper number of the action in which the citation has been correctly given. See § 710.06.

Form POL–316 is used to correct an erroneous citation or an erroneously furnished reference. Clerical instructions are outlined in the Manual of Clerical Procedures, § 410.C (2) and (3).

In any case otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation on an examiner's amendment form POL–37.

If a FOREIGN patent is incorrectly cited; for example, the wrong country is indicated or the country omitted from the citation, the General Reference Branch of the Scientific Library may be helpful. The date and number of the patent are often sufficient to determine the correct country which granted the patent.

To correct a citation prior to mailing, either before or after sending the typed action to Reference Processing Unit (R.P.U.), see the Manual of Clerical Procedures, § 410.C(1).

707.06 Citation of Decisions, Orders, Memorandums and Notices [R–36]

In citing court decisions, the U.S., C.C.P.A. or Federal Reporter citation should be given in addition to the USPQ citation, when it is convenient to do so.

The citation of manuscript decisions which are not available to the public should be avoided.

In citing a manuscript decision which is available to the public but which has not been published, the tribunal rendering the decision and complete data identifying the paper should be given. Thus, a decision of the Board of Appeals which has not been published but which is available to the public in the patented file should be cited, as "Ex parte ____, decision of the Board of Appeals, Patent No. ------, paper No. ____, ------ pages."

Decisions found only in patented files should be cited only when there is no published decision on the same point.

When a Commissioner's order, notice or memorandum not yet incorporated into this manual is cited in any official action, the title and date of the order, notice or memorandum should be given. When appropriate other data, such as a specific issue of the *Journal of the Patent Office Society* or of the *Official Gazette* in which the same may be found, should also be given.

707.07 Completeness and Clarity, of Examiner's Action [R–31]

Rule 105. Completeness of examiner's action. The examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made. However, matters of form need not be raised by the examiner until a claim is found allowable.

707.07(a) Complete Action on Formal Matters [R–36]

Forms are placed in informal applications listing informalities noted by the Draftsman (Form PO–948) and the Application Division (Form PO–152). Each of these forms comprises an original for the file record and a copy to be mailed to applicant as a part of the examiner's first action. They are specifically referred to as attachments to the letter and are marked with its paper number. In every instance where these forms are to be used they should be mailed with the examiner's *first* letter, and any additional formal requirements which the examiner desires to make should be included in the *first* letter.

When any formal requirement is made in an examiner's action, that action should, in all cases where it indicates allowable subject matter, call attention to rule 111(b) and state that a complete response must either comply with all formal requirements or specifically traverse each requirement not complied with.

707.07(b) Requiring New Oath [R–31]

See § 602.02.

707.07(c) Draftsman's Requirement [R–36]

See § 707.07(a); also §§ 608.02(a), (e), and (s).

707.07(d) Language To Be Used In Rejecting Claims [R–36]

Where a claim is refused for any reason relating to the merits thereof it should be "rejected" and the ground of rejection fully and clearly stated, and the word "reject" must be used. The examiner should designate the *statutory basis* for any ground of rejection by express reference to a section of 35 U.S.C. in the opening sentence of each ground of rejection. If the claim is rejected as too broad, the reason for so holding should be given; if rejected as indefinite the examiner should point out wherein the indefiniteness resides; or if rejected as incomplete, the element or elements lacking should be specified, or the applicant be otherwise advised as to what the claim requires to render it complete.

See § 706.02 for language to be used.

Everything of a personal nature must be avoided. Whatever may be the examiner's view as to the utter lack of patentable merit in the disclosure of the application examined, he should not express in the record the opinion that the application is, or appears to be, devoid of patentable subject matter. Nor should he express doubts as to the allowability of allowed claims or state that every doubt has been resolved in favor of the applicant in granting him the claims allowed.

Although, not every ground of rejection may be categorically related to a specific section of the statute, § 112 is considered as the more apt section for old combination rejection than §§ 102 or 103. Ex parte Des Granges, 864 O.G. 712.

The examiner should, as a part of the first Office action on the merits, identify any claims which he judges, as presently advised, to be allowable and/or should suggest any way in which he considers that rejected claims may be amended to make them allowable. If the examiner does not do this, then by implication it will be understood by the applicant or his attorney or agent that in the examiner's opinion, as presently advised, there appears to be no allowable claim nor anything patentable in the subject matter to which the claims are directed.

IMPROPERLY EXPRESSED REJECTIONS

An omnibus rejection of the claim "on the references and for the reasons of record" is stereotyped and usually not informative and should therefore be avoided. This is especially true where certain claims have been rejected on one ground and other claims on another ground.

A plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group.

707.07(e) Note All Outstanding Requirements

In taking up an amended case for action the examiner should note in every letter all the requirements outstanding against the case. Every point in the prior action of an examiner which is still applicable must be repeated or referred to, to prevent the implied waiver of the requirement.

As soon as allowable subject matter is found, correction of all informalities then present should be *required.*

707.07(f) Answer All Material Traversed

Where the requirements are traversed, or suspension thereof requested, the examiner should make proper reference thereto in his action on the amendment.

Where the applicant traverses any rejection, the examiner should, if he repeats the rejection, take note of the applicant's argument and answer the substance of it.

If a rejection of record is to be applied to a new or amended claim, specific identification of that ground of rejection, as by citation of the paragraph in the former Office letter in which the rejection was originally stated, should be given.

ANSWERING ASSERTED ADVANTAGES

After an Office action, the response (in addition to making amendments, etc.) may frequently include arguments and affidavits to the effect that the prior art cited by the examiner does not teach how to obtain or does not inherently yield one or more advantages (new or improved results, functions or effects), which advantages are urged to warrant issue of a patent on the allegedly novel subject matter claimed.

If it is the examiner's considered opinion that the asserted advantages are without significance in determining patentability of the rejected claims, he should state the reasons for his position in the record, preferably in the action following the assertion or argument relative to such advantages. By so doing the applicant will know that the asserted advantages have actually been considered by the examiner and, if appeal is taken, the Board of Appeals will also be advised.

The importance of answering such arguments is illustrated by In re Herrmann et al., 1959 C.D. 159; 739 O.G. 549 where the applicant urged that the subject matter claimed produced new and useful results. The court noted that since applicant's statement of advantages was not questioned by the examiner or the Board of Appeals, it was constrained to accept the statement at face value and therefore found certain claims to be allowable.

707.07(g) Piecemeal Examination [R–31]

Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See § 904.02.) Major technical rejections on grounds such as lack of proper disclosure, undue breadth, serious indefiniteness and *res judicata* should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.

In cases where there exists a sound rejection on the basis of prior art which discloses the "heart" of the invention (as distinguished from prior art which merely meets the terms of the claims), secondary rejections on minor technical grounds should ordinarily not be made. Certain technical rejections (e.g. negative limitations, indefiniteness) should not be made where the examiner, recognizing the limitations of the English language, is not aware of an improved mode of definition.

Some situations exist where examination of an application appears best accomplished by limiting action on the claims thereof to a particular issue. These situations include the following:

(1) Where an application is too informal for a complete action on the merits; see § 702.01;

(2) Where there is an undue multiplicity of claims, and there has been no successful telephone request for election of a limited number of claims for full examination; see § 706.03(l);

(3) Where there is a misjoinder of inventions and there has been no successful telephone request for election; see §§ 803, 806.02, 812.01;

(4) Where the disclosure is directed to perpetual motion; note *ex parte* Payne, 1904 C.D. 42; 108 O.G. 1049.

However, in such cases, the best prior art readily available should be cited and its pertinancy pointed out without specifically applying it to the claims.

On the other hand, a rejection on the grounds of *res judicata*, no *prima facie* showing for reissue, new matter, or inoperativeness (not involving perpetual motion) should be accomplished by rejection on all other available grounds.

707.07(h) Notify of Inaccuracies in Amendment [R–27]

See § 714.23.

707.07(i) Each Claim To Be Mentioned in Each Letter [R–31]

In every letter each claim should be mentioned by number, and its treatment or status given. Since a claim retains its original numeral throughout the prosecution of the case, its history through successive actions is thus easily traceable. Each action should conclude with a summary of all claims presented for examination.

Claims retained under rule 142 and claims retained under rule 146 should be treated as set out in §§ 821 to 821.03 and 809.02(c).

See § 1109.02 for treatment of claims in the application of losing party in interference.

The Index of Claims should be kept up to date as set forth in § 717.04.

707.07(j) State When Claims Are Allowable [R–20]

Inventor Filed Applications

When, during the examination of a pro se case, it becomes apparent to the examiner that there is patentable subject matter disclosed in the application, he shall draft one or more claims for the applicant and indicate in his action that such claims would be allowed if incorporated in the application by amendment.

This practice will expedite prosecution and offer a service to individual inventors not represented by a registered patent attorney or agent.

Although this practice may be desirable and is permissible in any case where deemed appropriate by the examiner, it will be expected to be applied in all cases where it is apparent that the applicant is unfamiliar with the proper preparation and prosecution of patent applications.

Allowable Except as to Form

When an application discloses patentable subject matter and it is apparent from the claims and the applicant's arguments that the claims are intended to be directed to such patentable subject matter, but the claims in their present form cannot be allowed because of defects in form or omission of a limitation, the examiner should not stop with a bare objection or rejection of the claims. The examiner's action should be constructive in nature and when possible he should offer a definite suggestion for correction. Further, an examiner's suggestion of allowable subject matter may justify his indicating the possible desirability of an interview to accelerate early agreement on allowable claims.

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he may note in the Office action that certain aspects or features of the patentable invention have not been claimed and that if properly claimed such claims may be given favorable consideration.

If a claim is otherwise allowable but is dependent on a cancelled claim or on a rejected claim, the Office action should state that the claim would be allowable if rewritten in independent form.

EARLY ALLOWANCE OF CLAIMS

Where the examiner is satisfied that the prior art has been fully developed and some of the claims are clearly allowable, he should not delay the allowance of such claims.

707.07(k) Numbering Paragraphs

It is good practice to number the paragraphs of the letter consecutively. This facilitates their identification in the future prosecution of the case.

707.08 Reviewing and Initialing by Assistant Examiner [R–24]

The full surname of the examiner who prepares the Office action will, in all cases, be typed below the action on the left side. The telephone number below this should be called if the case is to be discussed or an interview arranged.

After the action is typed, the examiner who prepared the action reviews it for correctness. If this examiner does not have the authority to sign the action, he should initial above the typed name, and forward the action to the authorized signatory examiner for signing.

707.09 Signing by Primary or Other Authorized Examiner [R–31]

Although only the original is signed, the word "Examiner" and the name of the signer should appear on the original and copies.

All letters and issues should be signed promptly.

707.10 Entry [R–16]

The original, signed by the authorized examiner, is the copy which is placed in the file wrapper. The character of the action, its paper number and the date of mailing are entered in black ink on the outside of the file wrapper under "Contents".

707.11 Date

The date should not be typed when the letter is written, but should be stamped on all copies of the letter after it has been signed by the authorized signatory examiner and the copies are about to be mailed.

707.12 Mailing [R–20]

In cases where no references are to be provided by Reference Order Section (R.O.S.), the copies are mailed by the group after the original, initialed by the assistant examiner and signed by the authorized signatory examiner, has been placed in the file.

In cases where cited references are to be provided, the original and copies after signing are forwarded by the clerk to Reference Order Section (R.O.S.) for mailing. The file with a copy of the action is retained in the group. After the copies are mailed by R.O.S., the original is returned for placement in the file.

707.13 Returned Office Action

Letters are sometimes returned to the Office because the Post Office has not been able to deliver them. The examiner should use every reasonable means to ascertain the correct address and forward the letter again, after stamping it "remailed" with the date thereof and redirecting it if there be any reason to believe that the letter would reach applicant at such new address. If the Office letter was addressed to an attorney, a letter may be written to the inventor or assignee informing him of the returned letter. The period running against the application begins with the date of remailing. (Ex parte Gourtoff, 1924 C.D. 153; 329 O.G. 536.)

If the Office is not finally successful in delivering the letter, it is placed, with the envelope, in the file wrapper. If the period dating from the remailing elapses with no communication from applicant, the case is forwarded to the Abandoned Files Unit.

708 Order of Examination [R–31]

Rule 101. Order of examination. (a) Applications filed in the Patent Office and accepted as complete applications (rules 53 and 55) are assigned for examination to the respective examining groups having the classes of inventions to which the applications relate. Applications shall be taken up for examination by the examiner to whom they have been assigned in the order in which they have been filed except for those applications in which the Office has accepted a request under rule 139.

(b) Applications which have been acted upon by the examiner, and which have been placed by the applicant in condition for further action by the examiner (amended applications) shall be taken up for action in such order as shall be determined by the Commissioner.

Each examiner will give priority to that application in his docket, whether amended or new, which has the **oldest effective U.S. filing date.** Except as rare circumstances may justify group directors in granting individual exceptions, this basic policy applies to all applications.

The actual filing date of a continuation-in-part application is used for docketing purposes. However, the examiner may act on a continuation-in-part application by using the effective filing date, if he desires.

If at any time an examiner determines that the "effective filing date" status of any application differs from what the records show, he should so inform the clerk, who should promptly amend the records to show the correct status, with the date of correction.

The order of examination for each examiner is to give top priority to those special cases having a fixed 30 day due date, such as examiner's answers and decisions on motions. Most other cases in the "special" category (for example, reissues, interference cases, cases made special by petition, cases ready for final conclusion, etc.) will continue in this category, with the first effective U.S. filing date among them normally controlling priority.

All amendments before final rejection should be responded to within 30 days of receipt.

Action on those applications in which the Office has accepted a request under rule 139 is suspended for the entire pendency, except for purposes relating to interference proceedings under rule 201(b) initiated within (5) five years of the earliest effective U.S. filing date.

708.01 List of Special Cases [R–24]

Rule 102. Advancement of examination. (a) Applications will not be advanced out of turn for examination or for further action except as provided by these rules, or upon order of the Commissioner to expedite the business of the Office, or upon a verified showing which, in the opinion of the Commissioner, will justify so advancing it.

(b) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and the head of some department of the Government requests immediate action for that reason, may be advanced for examination.

Certain procedures by the examiners take precedence over actions even on special cases.

For example, all papers typed and ready for signature should be completed and mailed.

All issue cases returned with a "Printer Waiting" slip must be processed and returned within the period indicated.

Cases in which practice requires that the examiner act within 30 days, such as decisions on motion (§ 1105.06) and examiner's answers (§ 1208), necessarily take priority over special cases without specific time limits.

If an examiner has a case which he is satisfied is in condition for allowance, or which he is satisfied will have to be finally rejected, he should give such action forthwith instead of making the case await its turn.

The following is a list of special cases (those which are advanced out of turn for examination):

(a) Applications wherein the inventions are deemed of peculiar importance to some branch of the public service and when for that reason the head of some department of the Government requests immediate action and the Commissioner so orders (rule 102).

(b) Cases made special as a result of a petition. (See § 708.02.)

Subject alone to diligent prosecution by the applicant, an application for patent that has once been made special and advanced out of turn for examination by reason of a ruling made in that particular case (by the Commissioner or an Assistant Commissioner) will continue to be special throughout its entire course of prosecution in the Patent Office, including appeal, if any, to the Board of Appeals; and any interference in which such an application becomes involved shall, in like measure, be considered special by all Patent Office officials concerned.

(c) Applications for reissues (rule 176).

(d) Cases remanded by an appellate tribunal for further action.

(e) A case, once taken up for action by an examiner according to its effective filing date, should be treated as special by any examiner, art unit or group to which it may subsequently be transferred; exemplary situations include new cases transferred as the result of a telephone election and cases transferred as the result of a timely response to any official action.

(f) Applications which appear to interfere with other applications previously considered and found to be allowable, or which it is demanded shall be placed in interference with an unexpired patent or patents (rule 201).

(g) Cases ready for allowance, or ready for allowance except as to formal matters.

(h) Cases which are in condition for final rejection.

(i) Cases pending more than five years, including those which, by relation to a prior United States application, have an effective pendency of more than five years. See § 707.02(a).

See also §§ 714.13 and 1207.

708.02 Petition to Make Special [R-39]

New applications ordinarily are taken up for examination in the order of their effective United States filing dates. Certain exceptions are made by way of petitions to make special, which may be granted under the conditions set forth below.

I. Manufacture

An application may be made special on the ground of prospective manufacture upon the filing of a petition by the applicant or assignee alleging under oath or declaration:

1. The possession by the prospective manufacturer of sufficient presently available capital (stating approximately the amount) and facilities (stating briefly the nature thereof) to manufacture the invention in quantity or that sufficient capital and facilities will be made available if a patent is granted;

If the prospective manufacturer is an individual, there must be a corroborating affidavit from some responsible party, as for example, an officer of a bank, showing that said individual has the required available capital to manufacture;

2. That the prospective manufacturer will not manufacture, or will not increase present manufacture, unless certain that the patent will be granted;

3. That affiant obligates himself or the prospective manufacturer, to manufacture the invention, in the United States or its possessions, in quantity immediately upon the allowance of claims or issuance of a patent which will protect the investment of capital and facilities.

The attorney or agent of record in the application (or applicant, if not represented by an attorney or agent) must file an affidavit or declaration to show:

1. That he has made or caused to be made a careful and thorough search of the prior art, or has a good knowledge of the pertinent prior art; and

2. That he believes all of the claims in the application are allowable.

II. Infringement

Subject to a requirement for a further showing as may be necessitated by the facts of a particular case, an application may be made special because of actual infringement (but not for prospective infringement) upon the filing of a petition alleging facts under oath or declaration to show, or indicating why it is not possible to show; (1) that there is an infringing device or product actually on the market or method in use, (2) when the device, product or method alleged to infringe was first discovered to exist; supplemented by an affidavit or declaration of the applicant's attorney or agent to show, (3) that he has made a rigid comparison of the alleged infringing device, product, or method with the claims of the application, (4) that, in his opinion, some of the claims are unquestionably infringed, (5) that he has made or caused

to be made a careful and thorough search of the prior art or has a good knowledge of the pertinent prior art, and (6) that he believes all of the claims in the application are allowable.

Models or specimens of the infringing product or that of the application should not be submitted unless requested.

III. Applicant's Health

An application may be made special upon a showing as by a doctor's certificate, that the state of health of the applicant is such that he might not be available to assist in the prosecution of the application if it were to run its normal course.

IV. Applicant's Age

An application may be made special upon a showing, as by a birth certificate or the applicant's affidavit or declaration, that the applicant is 65 years of age, or more.

V. Environmental Quality

The Patent Office will accord "special" status to all patent applications for inventions which materially enhance the quality of the environment of mankind by contributing to the restoration or maintenance of the basic life-sustaining natural elements—air, water, and soil.

All applicants desiring to participate in this program should request that their applications be accorded "special" status. Such requests should be written, should identify the applications by serial number and filing date, and should be accompanied by affidavits or declarations under rule 102 by the applicant or his attorney or agent explaining how the inventions contribute to the restoration or maintenance of one of these life-sustaining elements.

VI. Energy

The Patent Office will, on request, accord "special" status to all patent applications for inventions which materially contribute to (1) the discovery or development of energy resources, or (2) the more efficient utilization and conservation of energy resources. Examples of inventions in category (1) would be developments in fossil fuels (natural gas, coal, and petroleum), nuclear energy, solar energy, etc. Category (2) would include inventions relating to the reduction of energy consumption in combustion systems, industrial equipment, household appliances, etc.

All applicants desiring to participate in this program should request that their applications be accorded "special" status. Such requests should be written, should identify the application by serial number and filing date, and should be accompanied by affidavits or declarations under rule 102 by the applicant or his attorney or agent explaining how the invention materially contributes to category (1) or (2) set forth above.

VII. Special Examining Procedure for Certain New Applications—Accelerated Examination

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent):

(a) Submits a written petition to make special.

(b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status.

The election may be made by applicant at the time of filing the petition for special status. Should applicant fail to include an election with the original papers or petition and the Office determines that a requirement should be made, the established telephone restriction practice will be followed.

If otherwise proper, examination on the merits will proceed on claims drawn to the elected invention.

If applicant refuses to make an election without traverse, the application will not be further examined at that time. The petition will be denied on the ground that the claims are not directed to a single invention, and the application will await action in its regular turn.

Divisional applications directed to the nonelected inventions will not automatically be given special status based on papers filed with the petition in the parent case. Each such application must meet on its own all requirements for the new special status.

(c) Submits a statement that a pre-examination search was made, and specifying whether by the inventor, attorney, agent, professional searchers, etc., and listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. A search made by a foreign patent office or the International Patent Institute at The Hague, Netherlands satisfies this requirement.

(d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims.

(e) Submits a detailed discussion of the references, which discussion points out, with the

particularity required by rule 111 (b) and (c), how the claimed subject matter is distinguishable over the references. Where applicant indicates an intention of overcoming one of the references by affidavit or declaration under rule 131, the affidavit or declaration must be submitted before the application is taken up for action, but in no event later than one month after request for special status.

In those instances where the request for this special status does not meet all the prerequisites set forth above, applicant will be notified and the defects in the request will be stated. The application will remain in the status of a new application awaiting action in its regular turn. In those instances where a request is defective in one or more respects, applicant will be given *one* opportunity to perfect the request. If perfected, the request will then be granted.

Once a request has been granted, prosecution will proceed according to the procedure set forth below; there is no provision for "withdrawal" from this special status.

The special examining procedure of VII (accelerated examination) involves the following procedures:

1. The new application, having been granted special status as a result of compliance with the requirements set out above will be taken up by the examiner before all other categories of applications except those clearly in condition for allowance and those with set time limits, such as examiner's answers, decisions on motions, etc., and will be given a complete first action which will include *all* essential matters of merit as to all claims. The examiner's search will be restricted to the *subject matter encompassed by the claims.* A first action rejection will set a three-month shortened period for response.

2. During the three-month period for response, applicant is encouraged to arrange for an interview with the examiner in order to resolve, with finality, as many issues as possible. In order to afford the examiner time for reflective consideration before the interview, applicant or his representative should cause to be placed in the hands of the examiner at least one working day prior to the interview, a copy (clearly denoted as such) of the amendment that he proposes to file in response to the examiner's action. Such a paper will not become a part of the file, but will form a basis for discussion at the interview.

3. Subsequent to the interview, or responsive to the examiner's first action if no interview was had, applicant will file his "record" response. The response at this stage, to be proper, must be restricted to the rejections, objections, and requirements made. Any amendment which would require broadening the search field will be treated as an improper response.

4. The examiner will, within one month from the date of receipt of applicant's formal response, take up the application for final disposition. This disposition will constitute either a final action which terminates with the setting of a three-month period for response, or a notice of allowance. The examiner's response to any amendment submitted after final rejection should be prompt and by way of forms PO–303 or PO–327, by passing the case to issue, or by an examiner's answer should applicant choose to

file an appeal brief at this time. The use of these forms is not intended to open the door to further prosecution. Of course, where relatively minor issues or deficiencies might be easily resolved, the examiner may use the telephone to inform the applicant of such.

5. A personal interview after final Office action will not be permitted unless requested by the examiner. However, telephonic interviews will be permitted where appropriate for the purpose of correcting any minor matters which remain outstanding.

6. After allowance, these applications are given top priority for printing. See § 1309.

HANDLING OF PETITIONS TO MAKE SPECIAL

Each petition to make special, regardless of the ground upon which the petition is based and the nature of the decision, is made of record in the application file, together with the decision thereon. The Office that rules on a petition is responsible for properly entering that petition and the resulting decision in the file record. The petition, with any attached papers and supporting affidavits, will be given a single paper number and so entered in the "Contents" of the file. The decision will be accorded a separate paper number and similarly entered. To insure entries in the "Contents" in proper order, the clerk in the examining group will make certain that all papers prior to a petition have been entered and/or listed in the application file before forwarding it for consideration of the petition. Note §§ 1002.02(a), (c), and (j). [R–34]

708.03 Examiner Tenders His Resignation

Whenever an examiner tenders his resignation, the supervisory primary examiner should see that he spends his remaining time as far as possible in winding up the old complicated cases or those with involved records and getting as many of his amended cases as possible ready for final disposition.

If the examiner has considerable experience in his particular art, it is also advantageous to the Office if he indicates (in pencil) in the file wrappers of cases in his docket, the field of search or other pertinent data that he considers appropriate.

709 Suspension of Action [R–24]

Rule 103. Suspension of action. (a) Suspension of action by the Office will be granted at the request of the applicant for good and sufficient cause and for a reasonable time specified. Only one suspension may be granted by the primary examiner; any further suspension must be approved by the Commissioner.

(b) If action on an application is suspended when not requested by the applicant, the applicant shall be notified of the reasons therefor.

(c) Action by the examiner may be suspended by order of the Commissioner in the case of applications owned by the United States whenever publication of the invention by the granting of a patent thereon might be detrimental to the public safety or defense, at the request of the appropriate department or agency.

(d) Action on applications in which the Office has accepted a request filed under rule 139 will be suspended for the entire pendency of these applications except for purposes relating to proceedings under rule 201(b).

Suspension of action (rule 103) should not be confused with extension of time for reply (rule 136). It is to be noted that a suspension of action applies to an impending Office action by the examiner whereas an extension of time for reply applies to action by the applicant.

Paragraph (b) of the rule provides for a suspension of Office action by the examiner on his own initiative, as in §§ 709.01 and 1101.01(i). Petitions for a second or subsequent suspension of action in patent applications under rule 103 are decided by the group director. See § 1002.02(e), item 11.

Paragraph (d) is used in the Defensive Publication Program described in § 711.06.

709.01 Overlapping Applications by Same Applicant or Owned by Same Assignee [R–34]

Examiners should not consider ex parte, when raised by an applicant, questions which are pending before the Office in *inter partes* proceedings involving the same applicant. (See ex parte Jones, 1924 C.D. 59; 327 O.G. 681.)

Because of this where one of several applications of the same inventor which contain overlapping claims gets into an interference it was formerly the practice to suspend action by the Office on the applications not in the interference in accordance with Ex parte McCormick, 1904 C.D. 575; 113 O.G. 2508.

However, the better practice would appear to be to reject claims in an application related to another application in interference over the counts of the interference and in the event said claims are not cancelled in the outside application, prosecution of said application should be suspended pending the final determination of priority in the interference.

If, on the other hand, applicant wishes to prosecute the outside application, and presents good reasons in support therefor, prosecution

should be continued. Ex parte Bullier, 1899 C.D. 155, 88 O.G. 1161; In re Seebach, 1937 C.D. 495, 484 O.G. 503; In re Hammell, 1964 C.D. 733, 808 O.G. 25. See § 1111.03.

See also § 804.03.

710 Period for Response [R–29]

35 U.S.C. 133. Time for prosecuting application. Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commisioner that such delay was unavoidable.

35 U.S.C. 267. Time for taking action in Government applications. Notwithstanding the provisions of sections 133 and 151 of this title, the Commissioner may extend the time for taking any action to three years, when an application has become the property of the United States and the head of the appropriate department or agency of the Government has certified to the Commissioner that the invention disclosed therein is important to the armament or defense of the United States.

See Chapter 1200 for period for response when appeal is taken or court review sought.

710.01 Statutory Period [R–24]

Rule 135. Abandonment for failure to respond within time limit. (a) If an applicant fails to prosecute his application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (rule 136), the application will become abandoned.

(b) Prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper.

(See rule 7.)

The maximum statutory period for response to an Office action is six months, 35 U.S.C. 133. Shortened periods are currently used in practically all cases, see § 710.02(b).

710.01(a) Statutory Period, How Computed [R–24]

The actual time taken for response is computed from the date stamped on the Office action to the date of receipt by the Office of applicant's response. No cognizance is taken of fractions of a day and applicant's response is due on the corresponding day of the month six months or any lesser number of months specified after the Office action.

Response to an Office action with a 3 month shortened statutory period, dated November 30 is due on the following February 28 (or 29 if it is a leap year), while a response to an Office action dated February 28 is due on May 28 and not on the last day of May. Ex parte Messick, 1930 C.D. 6; 400 O.G. 3.

The date of receipt of a response to an Office action is given by the "Office date" stamp which appears on the responding paper.

In some cases the examiner's letter does not determine the beginning of a statutory response period. In all cases where the statutory response period runs from the date of a previous action, a statement to that effect should be included.

710.02 Shortened Statutory Period and Time Limit Actions [R–24]

Extract from Rule 136. Time less than six months. (a) An applicant may be required to prosecute his application in a shorter time than six months, but not less than thirty days, whenever such shorter time is deemed necessary or expedient. Unless the applicant is notified in writing that response is required in less than six months, the maximum period of six months is allowed.

Under rule 136 (35 U.S.C. 133) an applicant may be required to respond in a shorter period than six months, not less than 30 days, whenever it is deemed "necessary or expedient". Some conditions deemed "necessary or expedient" are listed in § 710.02(b).

In other situations, for example, the rejection of a copied patent claim, the examiner may require applicant to respond on or before a specified date. These are known as time limit actions and are established under authority of 35 U.S.C. 6. Some situations in which time limits are set are noted in § 710.02(c). The time limit requirement should be typed in capital letters where required.

An indication of a shortened time for reply should appear prominently on the first page

of all copies of actions in which a shortened time for reply has been set so that a person merely scanning the action can easily see it.

710.02(b) Shortened Statutory Period: Situations in Which Used [R–32]

Under the authority given him by 35 U.S.C. 133 the Commissioner has directed the examiners to set a shortened period for response to every action. The length of the shortened statutory period to be used depends on the type of response required. Some specific cases of shortened statutory period for response to be given are:

THIRTY DAYS

Requirement for restriction or election of species—no claim rejected	§§ 809.02(a) and 817.

TWO MONTHS

Winning party in terminated interference to reply to unanswered Office action	§ 1109.01

Where, after the termination of an interference proceeding, the application of the winning party contains an unanswered Office action, final rejection or any other action, the primary examiner notifies the applicant of this fact. In this case response to the Office action is required within a shortened statutory period running from the date of such notice. See Ex parte Peterson, 1941 C.D. 8; 525 O.G. 3.

Ex parte Quayle	§ 714.14

When an application is in condition for allowance, except as to matters of form, such as correction of drawings or specification, a new oath, etc., the case will be considered special and prompt action taken to require correction of formal matters. Such action should include an indication on first page form letter POL–326 that prosecution on the merits is closed in accordance with the decision in *Ex parte* Quayle, 1935 C.D. 11; 453 O.G. 213. A two month shortened statutory period for response should be set.

Multiplicity rejection—no other rejection	§ 706.03(l)
A new ground of rejection in an examiner's answer on appeal	§ 1208.01

THREE MONTHS

To respond to any Office action on the merits.

PERIOD FOR RESPONSE RESTARTED

Incorrect citation by examiner—regardless of time remaining in original period	§ 710.06

The above periods may be changed under special, rarely occurring circumstances.

A shortened statutory period may not be less than 30 days (35 U.S.C. 133).

710.02(c) Time-Limit Actions: Situations in Which Used [R–32]

As stated in § 710.02, 35 U.S.C. 6 provides authority for the Commissioner to establish rules and regulations for the conduct of proceedings in the Patent Office. Among the rules are certain situations in which the examiner sets a time limit within which some specified action should be taken by applicant. Some situations in which a time limit is set are:

(a) A portion of rule 203(b) provides that in suggesting claims for interference:

> The parties to whom the claims are suggested will be required to make those claims (i. e., present the suggested claims in their applications by amendment) within a specified time, not less than 30 days, in order that an interference may be declared.

See § 1101.01(m).

(b) Rule 206(b) provides:

> *Rule 206(b).* Where the examiner is of the opinion that none of the claims can be made, he shall reject the copied claims stating in his action why the applicant cannot make the claims and set a time limit, not less than 30 days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit shall be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

See § 1101.02(f).

(c) When applicant's action is not fully responsive to the Office action, the examiner may give applicant one month or the remainder of the period for response, whichever is longer, to complete his response. See rule 135(c) which reads as follows:

> *Rule 135(c).* When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

See § 714.03.

(d) In applications filed on or after October 25, 1965, applicant is given one month or the remainder of the period for response, whichever is longer, to remit any additional fees re-

quired for the submission of an amendment in response to an Office action.

See §§ 607 and 714.03.

(e) To ratify or otherwise correct an unsigned amendment, applicant is given one month or the remainder of the period for response, whichever is longer.

See § 714.01(a).

(f) Where an application is otherwise allowable but contains a traverse of a requirement to restrict, one month is given to cancel claims to nonelected invention or species or take other appropriate action. See rules 141, 144, and §§ 809.02(c) and 821.01.

710.02(d) Difference Between Shortened Statutory and Time-Limit Periods [R–24]

The distinction between a limited time for reply and a shortened statutory period under rule 136 should not be lost sight of. The penalty attaching to failure to reply within the time limit (from the suggestion of claims or the rejection of copied patent claims) is loss of the subject matter involved on the doctrine of disclaimer. A rejection on the ground of disclaimer is appealable. On the other hand, a complete failure to respond within the set statutory period results in abandonment of the entire application. This is not appealable, but a petition to revive may be granted if the delay was unavoidable. Further, where applicant responds a day or two after the time limit, this may be excused by the examiner if satisfactorily explained; but a response one day late in a case carrying a shortened statutory period under rule 136, no matter what the excuse, results in abandonment; however, if asked for in advance extension of the period may be granted by the examiner, provided the extension does not go beyond the six months' period from the date of the Office action. See also § 1101.02(f).

710.02(e) Extension of Time [R–32]

Extract from Rule 136. (b) The time for reply, when a time less than six months has been set, will be extended only for good and sufficient cause, and for a reasonable time specified. Any request for such extension must be filed on or before the day on which action by the applicant is due, but in no case will the mere filing of the request effect any extension. Only one extension may be granted by the primary examiner in his discretion; any further extension must be approved by the Commissioner. In no case can any extension carry the date on which response to an action is due beyond six months from the date of the action.

It should be very carefully noted that neither the primary examiner nor the Commissioner has authority to extend the shortened statutory period unless request for the extension is filed on or before the day on which applicant's response is due. While the shortened period may be extended within the limits of the statutory six months' period, no extension can operate to extend the time beyond the six months.

Compare, however, rule 135(c) and § 714.03.

Any request under rule 136(b) for extension of time for reply to an Office action must state a reason in support thereof; under the present policy the application of the rule will entail only a limited evaluation of the stated reason.

This liberality will not apply to

(1) any requests for more than one-month extension, and
(2) second and subsequent requests for extension of time to reply to a particular Office action.

All first requests for extension of time to an Office action are decided by the primary examiner for any period of time up to the maximum six month period. All requests subsequent to the first request for extension of time to respond to a particular Office action are forwarded to the group director for action. For an extension of time to file an appeal brief see § 1206.

If a request for extension of time is filed in duplicate and accompanied by a stamped return-addressed envelope, the Office will indicate the action taken on the duplicate and return it promptly in the envelope. Utilization of this procedure is optional on the part of applicant.

In this procedure, the action taken on the request should be noted on the original and on the copy which is to be returned. The notation on the original, which becomes a part of the file record, should be signed by the person granting or denying the extension, and the name and title of that person should also appear in the notation on the copy which is returned to the person requesting the extension.

When the request is granted, no further action is necessary; when it is denied, a formal letter of denial, giving the reason for denial, should be forwarded promptly after the mailing of the duplicate.

If the request for extension of time is granted, the time extended is added to the last calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday or holiday.

Request for extension of time may be made by hand delivery of a duplicate copy of a request which has been filed. Prompt consideration is

given and the action taken communicated to applicant at the earliest practicable time; if an attorney's copy as well as the duplicate copy is submitted, it is sufficient to merely indicate on both copies that the extension will be granted if the request is timely filed.

For purposes of convenience, a request for an extension of time may be personally delivered and left with the examiner to become an official paper in the file without routing through the mail room. The examiner who accepts the request for an extension of time will have it date stamped with the group stamp.

If the request for extension is not presented in duplicate, the applicant should be advised promptly by way of form letter POL–327 regarding action taken on the request so that the file record will be complete.

FINAL REJECTION—TIME FOR RESPONSE

The filing of a timely first response to a final rejection having a shortened statutory period for response is construed as including a request to extend the shortened statutory period an additional month, even if previous extensions have been granted, but in no case to exceed six months from the date of the final action.

During the additional month no applicant or attorney initiated interview is permitted. Since a timely first response to a final rejection is construed as including a request for an extension of time, any subsequent request for an extension of time is considered to be a second request and must be submitted to the group director.

An object of this practice is to obviate the necessity for appeal or filing a continuing case merely to gain time to consider the examiner's position in reply to an amendment timely filed after final rejection. Failure to file a response during the shortened statutory period results in abandonment of the application.

710.04 Two Periods Running [R–24]

There sometimes arises a situation where two different periods for response are running

against an application, the one limited by the regular statutory period, the other by the limited period set in a subsequent Office action. The running of the first period is not suspended nor affected by an *ex parte* limited time action or even by an appeal therefrom. For an exception, involving suggested claims, see § 1101.01(n).

710.04(a) Copying Patent Claims [R–24]

Where, in an application in which there is an unanswered rejection of record, claims are copied from a patent and all of these claims are rejected there results a situation where two different periods for response are running against the application. One period, the first, is the regular statutory period of the unanswered rejection of record, the other period is the limited period set for response to the rejection (either first or final), established under rule 206. The date of the last unanswered Office action on the claims other than the copied patent claims is the controlling date of the statutory period. (Ex parte Milton, 164 Ms. D. 1, 63 USPQ 132 and Ex parte Nelson, 164 Ms. D. 361, 26 J.P.O.S. 564.) See also § 1101.02(f).

710.05 Period Ending on Saturday, Sunday or Holiday [R–26]

35 U.S.C. 21. Day for taking action falling on Saturday, Sunday, or holiday. When the day, or the last day, for taking any action or paying any fee in the United States Patent Office falls on Saturday, Sunday, or a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding secular or business day.

Rule 7. Times for taking action; expiration on Saturday, Sunday, or holiday. Whenever periods of time are specified in these rules in days, calendar days are intended. When the day, or the last day, fixed by statute or by or under these rules for taking any action or paying any fee in the Patent Office falls on Saturday, Sunday, or on a holiday within the District of Columbia, the action may be taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday, or a holiday. See rule 304 for time for appeal or for commencing civil action.

As of January 1, 1971, the holidays in the District of Columbia are: New Year's Day, January 1; Washington's Birthday, the third Monday in February; Memorial Day, the last Monday in May; Independence Day, July 4; Labor Day, the first Monday in September; Columbus Day, the second Monday in October; Veterans' Day, the fourth Monday in October; Thanksgiving Day, the fourth Thursday in November; Christmas Day, December 25; Inauguration Day (January 20, every four years). Whenever a holiday falls on a Sunday, the following day (Monday) is also a holiday. Ex. Order 10,358; 17 F.R. 5269.

When a holiday falls on a Saturday, the preceding day, Friday, is considered to be a holiday within the District of Columbia and the Patent Office will be closed for business on that day (5 U.S.C. 6103). Accordingly, any action or fee due on such a holiday Friday or Saturday is to be considered timely if the action is taken, or the fee paid, on the next succeeding day which is not a Saturday, Sunday or a holiday.

When an amendment is filed a day or two later than the expiration of the period fixed by statute, care should be taken to ascertain whether the last day of that period was Saturday, Sunday or a holiday in the District of Columbia, and if so, whether the amendment was filed or the fee paid on the next succeeding day which is not a Saturday, Sunday or a holiday.

An amendment received on such succeeding day which was due on Saturday, Sunday or a holiday is endorsed on the file wrapper with the date of receipt. The Saturday, Sunday and/or holiday is also indicated.

710.06 Miscellaneous Factors Determining Date [R–26]

Where the citation of a reference is incorrect and this error is called to the attention of the Office before the expiration of the period for response, a new period for response starts from the date of the Office letter giving the correct citation and forwarding the correct copy. The previous period is restarted regardless of the time remaining. See § 707.05(g) for the manner of correcting the record where there has been an erroneous citation.

Where for any reason it becomes necessary to remail any action (§ 707.13), the action should be correspondingly redated, as it is the re-mailing date that establishes the beginning of the period for response. *Ex parte* Gourtoff, 1924 C.D. 153; 329 O.G. 536.

A supplementary action after a rejection explaining the references more explicitly or giving the reasons more fully, even though no further references are cited, establishes a new date from which the statutory period runs.

If for any other reason an Office action is defective in some matter necessary for a proper response, applicant's time to respond begins with the date of correction of such defect.

711 Abandonment [R–38]

Rule 135. Abandonment for failure to respond within time limit. (a) If an applicant fails to prosecute his

application within six months after the date when the last official notice of any action by the Office was mailed to him, or within such shorter time as may be fixed (rule 136), the application will become abandoned.

(b) Prosecution of an application to save it from abandonment must include such complete and proper action as the condition of the case may require. The admission of an amendment not responsive to the last official action, or refusal to admit the same, and any proceedings relative thereto, shall not operate to save the application from abandonment.

(c) When action by the applicant is a bona fide attempt to advance the case to final action, and is substantially a complete response to the examiner's action, but consideration of some matter or compliance with some requirement has been inadvertently omitted, opportunity to explain and supply the omission may be given before the question of abandonment is considered.

(d) Prompt ratification or filing of a correctly signed copy may be accepted in case of an unsigned or improperly signed paper. (See rule 7.)

Rule 138. Express abandonment. An application may be expressly abandoned by filing in the Patent Office a written declaration of abandonment signed by the applicant himself and the assignee of record, if any, and identifying the application. Except as provided in Rule 262 an application may also be expressly abandoned by filing a written declaration of abandonment signed by the attorney or agent of record. Express abandonment of the application may not be recognized by the Office unless it is actually received by appropriate officials in time to act thereon before the date of issue.

Abandonment may be either of the invention or of an application. This discussion is concerned with abandonment of the application for patent.

An abandoned application, in accordance with rules 135 and 138, is one which is removed from the Office docket of pending cases through:

1. formal abandonment

a. by the applicant, himself (acquiesced in by the assignee if there be one), or

b. by the attorney or agent of record (including an associate attorney or agent appointed by the principal attorney or agent and whose power is of record but not including a registered attorney or agent acting in a representative capacity under rule 34(a)); or

2. failure of applicant to take appropriate action within a specified time at some stage in the prosecution of the case.

Where an applicant, himself, formally abandons an application and there is a corporate assignee, the acquiescence must be made through an officer whose official position is indicated.

See § 712 for abandonment for failure to pay issue fee.

711.01 Express or Formal Abandonment [R–39]

Applications may be expressly abandoned as provided for in rule 138. When a letter expressly abandoning an application (not in issue) is received, the examiner should acknowledge receipt thereof, indicate whether it does or does not comply with the requirements of rule 138.

If it does comply, the examiner should respond by using form POL–327 and by checking the appropriate boxes which indicate that the letter is in compliance with rule 138 and that the application is being forwarded to the Abandoned Files Unit. The examiner's signature may appear at the bottom of the form. If such a letter does not comply with the requirements of rule 138, a fully explanatory letter should be sent.

In view of the doctrine set forth in Ex parte Lasscell, 1884 C.D. 66; 29 O.G. 861, an amendment canceling all of the claims, even though said amendment is signed by the applicant himself and the assignee, is not an express abandonment. Such an amendment is regarded as non-responsive and should not be entered, and applicant should be notified as explained in §§ 714.03 to 714.05. But see § 608.02(i) for situation where application is abandoned along with transfer of drawings to a new application.

An attorney or agent not of record in an application may file a withdrawal of an appeal under rule 34(a) except in those instances where such withdrawal would result in abandonment of the application. In such instances the withdrawal of appeal is in fact an express abandonment and does not comply with rule 138.

An express abandonment signed with a firm name is properly acceptable only if the power of attorney naming the firm was filed prior to July 2, 1971 and has not been revoked.

After Notice of Allowance

Letters of abandonment of allowed applications are acknowledged by the Patent Issue Division.

Rule 313 provides that an allowed application will not be withdrawn from issue except by approval of the Commissioner, and that after the first portion of the issue fee has been paid and the patent to be issued has received its date and number, it will not be withdrawn for any reason except mistake on the part of the Office, or because of fraud or illegality in the application, or for interference. In cases where the second paragraph of rule 313 precludes giving

effect to an express abandonment, the appropriate remedy is a petition under rule 183, showing an extraordinary situation where justice requires suspension of rule 313.

The Defensive Publication Program is set forth in § 711.06.

711.02 Failure To Take Required Action During Statutory Period [R–20]

Rule 135 specifies that an application becomes abandoned if applicant "fails to prose-

cute" his application within the fixed statutory period. This failure may result either from

1. failure to respond within the statutory period, or

2. insufficiency of response, i.e., failure to take "complete and proper action, as the condition of the case may require" within the statutory period (rule 135).

Abandonment by entire failure to respond presents no problems.

Nor is there ordinarily any particular difficulty when an amendment reaches the Office (not the group) after the expiration of the statutory period. The case is abandoned and the remedy is to petition to revive it. The examiner should notify the applicant or attorney at once that the application has been abandoned by using form letter POL–327. The proper boxes on the form should be checked and the blanks for the dates of the proposed amendment and the Office action completed. The late amendment is endorsed on the file wrapper but not formally entered. (See § 714.17.)

To pass on questions of abandonment, it is essential that the examiner know the dates that mark the beginning and end of the statutory period under varying situations. Applicant's response must reach the Office within the set statutory period for reply dating from the date stamped on the Office letter. See §§ 710 to 710.06.)

711.02(a) Insufficiency of Response [R–35]

Abandonment may result from a situation where applicant's reply is within the period for response but is not fully responsive to the Office action. But see § 710.02(c), par. (c). See also §§ 714.02 to 714.04.

711.02(b) Special Situations Involving Abandonment [R–23]

The following situations involving questions of abandonment often arise, and should be specially noted:

1. Copying claims from a patent when not suggested by the Patent Office does not constitute a response to the last Office action and will not save the case from abandonment, unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

2. A case may become abandoned through withdrawal of, or failure to prosecute, an appeal to the Board of Appeals. See §§ 1215.01 to 1215.04.

3. Likewise it may become abandoned through dismissal of appeal to C.C.P.A. or civil action, where there was not filed prior to such dismissal an amendment putting the case in condition for issue or fully responsive to the Board's decision. Abandonment results from failure to perfect an appeal as required by C.C.P.A. Rule 25. See §§ 1215.05 and 1216.01.

4. Where claims are suggested for interference near the end of the period for response running against the case, see § 1101.01(n).

5. When drawings are transferred under rule 88. See § 608.02(i).

711.02(c) Termination of Proceedings [R–23]

"Termination of proceedings" is an expression found in 35 U.S.C. 120. As there stated, a second application is considered to be copending with an earlier case if it is filed before (a) the patenting, (b) the abandonment of, or (c) other termination of proceedings in the earlier case. "Before" has consistently been interpreted, in this context, to mean "not later than".

In each of the following situations, proceedings are terminated:

1. When the issue fee is not paid and the application is abandoned for failure to pay the issue fee, proceedings are terminated as of the date the issue fee was due and the application is the same as if it were abandoned on that date (but if the issue fee is later accepted, on petition, the application is in a sense revived). See § 712.

2. If an application is in interference involving all the claims present in the application as counts and the application loses the interference as to all the claims, then proceedings on that application are terminated as of the date appeal or review by civil action was due if no appeal or civil action was filed.

3. Proceedings are terminated in an application after decision by the Board of Appeals as explained in § 1214.06.

4. Proceedings are terminated after a decision by the court as explained in §§ 1215.05 and 1216.01.

711.03 Reconsideration of Holding of Abandonment; Revival

When advised of the abandonment of his application, applicant may either ask for reconsideration of such holding, if he disagrees with it on the basis that there is no abandonment in fact; or petition for revival under rule 137.

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711.03(a) Holding Based on Insufficiency of Response [R–35]

Applicant may deny that his response was incomplete.

While the primary examiner has no authority to act upon an application in which no action by applicant was taken during the period for response, he may reverse his holding as to whether or not an amendment received during such period was responsive and act on a case of such character which he has previously held abandoned. This is not a revival of an abandoned application but merely a holding that the case was never abandoned. See also § 714.03.

711.03(b) Holding Based on Failure To Respond Within Period [R–23]

When an amendment reaches the Patent Office (not the examining group) after the expiration of the period for response and there is no dispute as to the dates involved, no question of reconsideration of a holding of abandonment can be presented.

However, the examiner and the applicant may disagree as to the date on which the period for response commenced to run or ends. In this situation, as in the situation involving sufficiency of response, the applicant may take issue with the examiner and point out to him that his holding was erroneous.

711.03(c) Petitions Relating to Abandonment [R–35]

Rule 137. Revival of abandoned application. An application abandoned for failure to prosecute may be revived as a pending application if it is shown to the satisfaction of the Commissioner that the delay was unavoidable. A petition to revive an abandoned application must be accompanied by a verified showing of the causes of the delay, by the proposed response unless it has been previously filed, and by the petition fee.

A decision on a petition to revive an abandoned application is based solely on whether a satisfactory showing has been made that the delay was unavoidable (35 U.S.C. 133). A petition to revive is not considered unless the petition fee and a proposed response to the last Office action has been received (rule 137). While a response to a non-final action may be either an argument or an amendment under rule 111, a response to a final action "must include cancellation of, or appeal from the rejection of, each claim so rejected" under rule 113. Accordingly, in any case where a final rejection had been made, the proposed response required for consideration of a petition to revive must be either an appeal or an amendment that cancels all the rejected claims or otherwise prima facie places the application in condition for allowance. When a notice of appeal is the appropriate response accompanying a petition to revive, the brief required by rule 192 is due within two months from the date the petition to revive is granted. In those situations where abandonment occurred because of the failure to file an appeal brief, the proposed response, required for consideration of a petition to revive, must include a brief accompanied by the proper fee.

The granting of a petition to revive does not serve in any way as a determination that the proposed response to the Office action is completely responsive. Revived applications are forwarded to the examiner to determine the completeness of the proposed response. Such applications must be taken up *Special*. If the examiner determines that the response is complete, he should promptly take the case up for action. If the proposed response is not a complete response to the last Office action, the examiner should write a letter to the applicant informing him of the specific defects in his response and set a one-month time limit for applicant to complete his response. If the applicant does not complete his response within the one-month limit, the application is again abandoned.

A petition to revive an abandoned application should not be confused with a petition from an examiner's holding of abandonment. Abandonment may result not only from insufficiency of response but also from entire failure to respond, within the statutory period following an Office action.

Where the holding of abandonment is predicated on the insufficiency of the response, or disagreement as to controlling dates the petition from such holding comes under rule 181 and does not require a fee.

Where the applicant acquiesces in the holding of abandonment, or where the petition from such holding is denied, applicant's only recourse, so far as concerns the particular case involved, is by petition to revive.

See § 712 for a petition for late payment of the issue fee.

Office Action—Timely Response

The Patent Office has been receiving an excessively large volume of petitions to revive based primarily on the late filing of amendments and other responses to official actions. Many of these

petitions indicate that the late filing was due to unusual mail delays; however, the records generally show that the filing was only two or three days late.

In order to alleviate, for applicants and the Office, the problems and expenditures of time and effort occasioned by abandonments and petitions to revive, it is suggested that responses to official action be mailed to the Patent Office at least one, and preferably two, week(s) prior to the expiration of the period within which a response is required. This suggestion is made in the interest of improving efficiency, thereby providing better service to the public.

Conditional Petition To Revive

Since applications that become abandoned unintentionally present burdens to both the Patent Office and the applicant, a simplified procedure has been devised to alleviate these burdens when the abandonment results from a delay in the mails. This procedure provides for an automatic petition to revive or petition to accept the delayed payment of issue fee.

It is suggested that when a communication, complying with the circumstances enumerated below, is mailed to the Patent Office more than three calendar days prior to the due date, a conditional petition be attached to the communication. If the communication is received in the Patent Office after the due date and the application becomes abandoned, the conditional petition will become effective, subject to the following requirements. The petition must include (1) an authorization to charge a deposit account for any required fees, including the petition fee (35 U.S.C. 41(a) 7), and (2) an oath or declaration signed by the person mailing the communication and also signed by the applicant or his registered attorney or agent stating that the communication and petition were either placed in the United States mail as first class or air mail, or placed in the mail outside the United States as air mail. Since mail handled in this manner may reasonably be expected to reach the Patent Office within three days of posting, any mail delays beyond such time will be considered to constitute unavoidable delay and sufficient cause to grant a petition to revive (35 U.S.C. 133) or a petition to accept delayed payment of an issue fee (35 U.S.C. 151). For example, if a response was due in the Patent Office on June 10, 1974, the communication and conditional petition must be posted no later than June 6, 1974 in order for the conditional petition to be effective. June 7, 1974 is not "more than three calender days prior to the due date" which is June 10, 1974.

The circumstances under which this procedure may be used are those where the communication, if timely filed, (1) would be a proper and complete response to an action or request by the Patent Office, and (2) would stop a period for response from continuing to run. Accordingly, this procedure would be appropriate for:

1. A response to a non-final Office action.
2. A response to a final Office action in the form of an amendment that cancels all rejected claims or otherwise prima facie places the application in condition for allowance.
3. A notice of appeal and requisite fee.
4. An appeal brief, in triplicate, and requisite fee.
5. A base issue fee.
6. A balance of issue fee.

Categories 1–4 would include a conditional petition to revive. Categories 5 and 6 would include a conditional petition to accept the delayed payment of the issue fee. The boxes on the below suggested format should be checked accordingly.

Examples for which this procedure would not be appropriate and will not apply include the following types of communications when they are forwarded to the Patent Office.

1. Application papers.
2. A response to a final Office action other than that indicated in categories 2 and 3, above.
3. Extensions of time.
4. Petitions for delayed payment of either the issue fee or balance of issue fee.
5. Amendments under Rule 312.
6. Priority documents.

Normal petition practices are not affected in those situations where this procedure is either not elected or appropriate.

A suggested format for the conditional petition is shown below:

Applicant(s)_____ ☐ Petition to revive

Serial No._____ ☐ Petition to accept delayed payment of issue fee

Date Filed_____

For_____

I hereby certify that the attached communication is being deposited in

☐ the United States mail as first class or air mail

☐ the mail outside the United States as air mail

in an envelope addressed to: Commissioner of Patents, Washington, D.C. 20231, on _____, which date is more than three (3) calendar days prior to the due date from _____, by _____.

(Location) (Name of Individual)

In the event that such communication is not timely filed in the United States Patent Office, it is requested that this paper be treated as a petition and that the:

☐ delay in prosecution be held unavoidable—35 U.S.C. 133.

☐ delayed payment of the fee be accepted—35 U.S.C. 151.

The petition fee required by 35 U.S.C. 41(a) 7 is authorized to be charged to Deposit Account No. _____ in the name of _____.

The undersigned declare further that all statements made herein are true, based upon the best available information; and further, that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Date _____ _____

(Signature of applicant or signature and registration number of Registered Representative)

And

Date _____ _____

(Signature of person mailing, if other than the above)

The procedure for handling applications becoming abandoned due to late filing of a communication having a conditional petition attached thereto is as follows:

1. Forward the papers and the application file wrapper to the Office of the Deputy Assistant Commissioner for Patents, Room 4–11E14.

2. Do not mail a form POL–327 or forward the file wrapper to the Abandoned File Unit.

3. In the event that the application is revived, the file wrapper will be returned to the forwarding group for further action. [R–42]

711.03(d) Examiner's Statement on Petition To Set Aside Examiner's Holding [R–23]

Rule 181 states that the examiner "may be directed by the Commissioner to furnish a written statement within a specified time setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner". Often, however, the question is passed upon without a statement being requested, if the issue raised is clear from the record. Unless requested, such a statement should not be prepared. See § 1002.01.

711.04 Disposition of Abandoned Applications [R–23]

Extract from Rule 14. Abandoned applications may be destroyed after twenty years from their filing date, except those to which particular attention has been called and which have been marked for preservation. Abandoned applications will not be returned.

As explained in § 1302.07, a retention label is used to indicate applications not to be destroyed.

711.04(a) Pulling and Forwarding [R–23]

The files and drawings of abandoned applications are pulled and forwarded to the Abandoned Files Unit on a bi-weekly basis in accordance with the chart in Section 505.E(1) of the Manual of Clerical Procedure.

They should be carefully scrutinized by the appropriate examiner to verify that they are actually abandoned. A check should be made of files containing a decision of the Board of Appeals for the presence of allowed claims to avoid their being erroneously sent to the Abandoned Files Unit.

711.04(b) Ordering Abandoned Files [R–37]

Abandoned files may be ordered by examiners by sending (through the messenger service) a completed Form PO–125 to the Abandoned Files Unit. The name and art unit should appear on the form and the file will be sent to him through the messenger service.

Abandoned files more than ten years old which have not been marked for permanent retention are stored in a nearby Federal Records Center. Orders for these old files require at least two days for processing. The file should be returned promptly when it is no longer needed.

Expedited Service

Examiners may expedite service by ordering abandoned files by telephone (Ext. 73181).

711.05 Letter of Abandonment Received After Application Is Allowed [R–42]

Receipt of a letter of abandonment while an application is allowed, is acknowledged by the Patent Issue Division.

An express abandonment arriving after the issue fee has been paid and the patent to issue has received its date and number will not be accepted without a showing of one of the reasons indicated in rule 313(b), or else a showing under rule 183 justifying suspension of rule 313.

711.06 Abstracts, Abbreviatures and Defensive Publications [R–41]

Abstracts

Abstracts were prepared in accordance with the Notice of January 25, 1949, 619 O.G. 258.

Each abstract includes a summary of the disclosure of the abandoned application, and in applications having drawings, a figure of the drawing. The publication of such abstracts was discontinued in 1953.

Abbreviatures

Abbreviatures were prepared in accordance with the procedure indicated in the Notice of October 13, 1964, 808 O.G. 1. Each abbreviature contains a specific portion of the disclos-

ure of the abandoned application, preferably a detailed representative claim, and, in applications having drawings, a figure of the drawing. The publication of such abbreviatures was discontinued in 1965.

Defensive Publications

Rule 139. Waiver of patent rights. An applicant may waive his rights to an enforceable patent based on a pending patent application by filing in the Patent Office a written waiver of patent rights, a consent to the publication of an abstract, an authorization to open the complete application to inspection by the general public, and a declaration of abandonment signed by the applicant and the assignee of record or by the attorney or agent of record.

A. Defensive Publication Program

An applicant may request to have an abstract of the technical disclosure of his application published as a defensive publication abstract under rule 139. The request may be filed only (1) while a pending application is awaiting the first Office action in that application or (2) within 8 months of the earliest effective U.S. filing date if a first Office action has been issued and responded to within said 8 month period. The application is laid open for public inspection and the applicant provisionally abandons the application, retaining his rights to an interference for a limited period of five years from the earliest effective U.S. filing date.

The defensive publication of an application precludes a continuing application (divisional, continuation-in-part, or continuation) filed under 35 U.S.C. 120 from being entitled to the benefit of the filing date of the defensively published application unless a continuing application is filed within thirty (30) months after the earliest effective U.S. filing date. Where a similar application is not filed until after expiration of the thirty (30) month period, the application is examined, but it may not claim the benefit of the earlier filing date of the defensive publication application. The examiner should require the cancellation of any claim or statement intended to obtain the benefit of the earlier filing date in such cases, objecting to its inclusion on the ground of estoppel.

If a first continuing application is filed within 30 months from the earliest U.S. effective filing date of the application published under the Defensive Publication Program, later copending continuing applications (such as divisions if restriction is required during the prosecution of the first continuing application) are not barred and may be filed during the pendency of the first continuing application, even though beyond the 30 month period, without loss of the right to claim the benefit of the filing date of the Defensive Publication application.

The approval of a request for defensive publication is made by the Supervisory Primary Examiner.

An application having therein a request for defensive publication is taken up special by the examiner, and if acceptable, the application is processed promptly for publication of the abstract and opening of the application to the public. A request for defensive publication cannot be withdrawn after it has been accepted by the Office.

No fee is required for the defensive publication of an application.

The Defensive Publication Abstract and a selected figure of the drawing, if any, are published in the Official Gazette. Defensive Publication Search Copies, containing the defensive publication abstract and suitable drawings, if any, are provided for the application file, the Public Search Room and the examiner's search files.

The defensive publication application files are maintained in the Record Room after publication.

B. Requirements for a Statement Requesting Defensive Publication

An application may be considered for defensive publication provided applicant files a request under rule 139 agreeing to the conditions for defensive publication. The statement requesting publication should: (1) be signed by the assignee of record, or by the attorney or agent of record, or by the applicant and the assignee of record, if any; (2) request the Commissioner to publish an abstract of the disclosure in the O.G.; (3) authorize the Commissioner to lay open to public inspection the complete application upon publication of the abstract in the O.G.; (4) expressly abandon the application to take effect 5 years from the earliest U.S. effective filing date of said application unless interference proceedings have been initiated within that period; and (5) waive all rights to an enforceable patent based on said application as well as on any continuing application filed more than 30 months after the earliest effective U.S. filing date of said application, unless the continuing application was copending with an earlier continuing application which was filed within 30 months after the earliest effective U.S. filing date.

C. Requirements for Defensive Publication

The examiner should scan the disclosure of the application to the extent necessary to determine whether it is suitable for publication and he also should ascertain that the abstract and the selected figure of the drawing, if any, adequately reflect the technical disclosure. The ab-

stract should be entitled "Defensive Publication Abstract" and may contain up to 200 words and be an expanded version of the abstract required under rule 72(b).

The request for defensive publication is disapproved if (1) there is some informality in the application or drawings, (2) the requirements of the statement requesting defensive publication as described in B above have not been met, or (3) the subject matter of the application is not considered suitable for publication because: (a) it involves national security; (b) it is considered advertising, frivolous, scandalous, lacking utility, or against public policy, etc., or (c) the disclosure is clearly anticipated by readily available art, and publication would not add anything to the fund of public knowledge (matters of patentability are generally not considered and no search is made).

If there are defects in the request for defensive publication which cannot be corrected by Examiner's Amendment, the examiner should notify applicant in writing, usually giving the reasons for disapproval and indicating how corrections may be made. Applicant is given a period of one (1) month within which to make the necessary corrections. Failure to correct a defect as required results in nonacceptance for defensive publication, and in resumption of the prosecution of the application by the Office in its regular turn.

In those instances, however, where the subject matter is not suitable for publication, the request may be disapproved without explanation. Under these circumstances, the examiner's letter is first submitted to the group director for approval.

Petition may be taken to the Commissioner from the disapproval of a request for defensive publication.

Where the request is apparently fatally defective and involves subject matter not considered suitable for publication, for example, advertising, frivolous, lacking utility, etc., or is clearly anticipated by readily available art, the examiner should generally examine the application and prepare a complete Office action when notifying applicant.

D. Formal Requirements of a Defensive Publication Application

Correction is required by the examiner of informalities listed by the Application Division and by the Draftsman before approval of the request for defensive publication. Informalities of the drawing are listed on the Notice of Informal Patent Drawings and defects of the application are noted on the Notice of Informal Patent Application. A letter notifying an applicant of the informalities in a request for defensive publication should end with the following paragraphs:

"The request for defensive publication has not been approved in view of the noted informalities. APPLICANT IS GIVEN ONE (1) MONTH WITHIN WHICH TO MAKE THE CORRECTIONS NECESSARY FOR PUBLICATION.

Failure to respond within the set period will result in resumption of the prosecution of the application in the normal manner."

Where the heading "Defensive Publication Abstract" has been omitted, it is inserted by a letter in the form of an Examiner's Amendment, as are other corrections to the abstract. The examiner has the authority to add to the abstract reference numerals of the figure selected for the O.G., and to designate a figure of the drawing for printing in the O.G., or to change the selection made by applicant by a letter in the form of an Examiner's Amendment.

Informalities noted by the Draftsman on the Notice of Informal Patent Drawings should be corrected where appropriate and should be handled as follows: The examiner notes in pencil in the left margin of the drawing the number of the figure selected for defensive publication in the O.G. and returns the drawing with the file to the Draftsman for further consideration in view of the request under rule 139. Although the selected figure itself must meet all the drawing standards, the Draftsman may waive requirements as to the remaining figures which need be formal only to the extent of being sufficiently clear for reproduction. The Draftsman will note on the drawing and all copies of the Notice of Informal Patent Drawings "Approved for Defensive Publication Only". (If the application is later passed to issue, *all* drawing informalities must be corrected). If the drawing correction requires authority from the applicant, the examiner notifies him in writing that the request under rule 139 is disapproved until authorization for correction is received.

E. Preparation of an Application for Defensive Publication

After determining that the application is acceptable for defensive publication the examiner indicates which papers, if any, are to be entered. Amendments accompanying the request are not entered until approved by the examiner. If filed after receipt of the request, amendments will be placed in the file, but will not be entered unless the subject matter of the amendment is in response to a requirement by the examiner.

The drawings of a published Defensive Publication may be transferred to a later application drawn to the same invention filed within 30 months of the earliest effective U.S. filing date of the Defensive Publication provided that no alterations whatsoever are to be made in the drawings. Applicant must submit a mounted copy of the drawings to allow processing of the application if transfer is contemplated.

The designated spaces on the face of the file wrapper for class, subclass, claim for foreign priority and prior United States application data are appropriately completed.

The Defensive Publication Retention Label identifies Defensive Publication Applications only and is affixed by the examiner in the space on the file wrapper reserved for the retention label. Patent Issue Division completes the date of publishing and O.G. citation of the Defensive Publication Retention Label.

In the spaces titled "Prep. for Issue" and "Examined and Passed for Issue" the word "Issue" is changed to—Def. Publ.—by the examiner before signing. (The clerk's signature is not necessary).

The "blue issue" slip is used on defensive publication applications and is completed in the usual manner except that in the space designated for the Patent Number the examiner writes "Defensive Publication". Cross references are designated only in those subclasses where the examiner believes the subject matter will be of significant interest to warrant it.

With respect to the drawings the procedure is the same as for allowance and the examiner fills in the appropriate spaces on the margin, in the Draftsman's "Approved" stamp area.

F. Citation of Prior Art in a Defensive Publication Application

Since the defensive publication procedure makes the disclosure of an application available to the public, usually before it or any continuing application is patented, citation of prior art under rule 291 by any person or party is accepted for consideration in the event examination is subsequently conducted. Such citation is endorsed on the file wrapper "Contents" by the Record Room, for the convenience of the examiner when preparing the application or a continuing application of such an application for allowance.

G. Defensive Publication Application Interferences

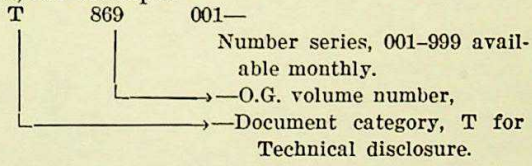
During the five year period from its earliest U.S. effective filing date, interferences may be declared between defensive publication applications and other applications and/or patents in accordance with existing interference rules and procedures.

Examiners search the Defensive Publication Search Copies in the regular patent search files, when making patentability searchs. Where the claims of a defensive publication application recite substantially the same subject matter as the allowed claims, the allowed claims should be suggested for interference purposes to the defensive publication application if these claims would be allowable therein.

Abandonment of a defensive publication application will be stayed during the period beginning with the suggestion of claims or the filing of claims copied from a patent and ending with the termination of the interference proceedings or the mailing of a decision refusing the interference.

Termination of the interference in favor of the defensive publication application would render the express abandonment ineffective but would not result in the issuance of an enforceable patent. The examiner cancels by examiner's amendment all the claims in the case except those awarded to applicant and sends the case to issue. The Notice of Allowance in these cases will be accompanied by a statement informing the applicant that when the issue fee is remitted, a disclaimer of the entire term of the patent to be granted, must be included in accordance with 35 U.S.C. 253.

Distinct numbers are assigned to all Defensive Publications published after December 16, 1969, for example.



Defensive Publications are included in subclass lists and subscription orders. The distinct numbers are used for all official reference and document copy requirements.

A conversion table from the application serial number to the distinct number for all Defensive Publications published before December 16, 1969 appears at 869 O.G. 687. [R–41]

711.06(a) Citation and Use of Abstracts, Abbreviatures and Defensive Publications as References [R–24]

It is important that abstracts, abbreviatures and defensive publications (O.G. Defensive Publication and Defensive Publication Search Copy) be referred to as publications and not

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as patents or applications. These printed publications are cited as prior art under 35 U.S.C. 102(a) or 102(b) effective from the date of publication in the Official Gazette.

An application or portion thereof from which an abstract, abbreviature or defensive publication has been prepared, in the sense that the application is evidence of prior knowledge, may be used as a reference under 35 U.S.C. 102(a), effective from the actual date of filing in the United States.

These publications may be used alone or in combination with other prior art in rejecting claims under 35 U.S.C. 102 and 103.

Abstracts, Abbreviatures and Defensive Publications are listed with Other References in the citation thereof as follows:

(a) Abstracts and Abbreviatures

Brown, (abstract or abbreviature) of Serial No. _____, filed _____, published in _____ O.G. _____, on _____ (list classification).

(b) The O.G. defensive publication

Jones, Def. Pub. of Serial No. _____ filed _____, published in _____ O.G. _____, on _____, Defensive Publication No. T —, —, (list classification).

(c) Search Copy defensive publication; (where a disclosure relied on is in the Search Copy but not in the O.G. publication)

Jones, Def. Pub. Search Copy of Serial No. _____, filed _____, published in _____ O.G. _____, on _____ Defensive Publication No. T —, —, (list classification).

(d) Applications or designated portions thereof abstracts, abbreviatures and defensive publications

Jones, Application Serial No. _____, filed _____, laid open to public inspection on _____ as noted at _____, O.G. _____ (portion of application relied on) (list classification).

712 Abandonment for Failure To Pay Issue Fee [R–24]

Rule 316. Application abandoned for failure to pay issue fee. (a) If the fee specified in the notice of allowance is not paid within three months from the date of the notice the application will be regarded as aban-

doned. Such an abandoned application will not be considered as pending before the Patent and Trademark Office.

(b) If the issue fee or portion thereof specified in the notice of allowance is not timely paid but is submitted, with the fee for delayed payment, within three months of its due date with a verified showing or statement in the form of a declaration of sufficient cause for the late payment, it may be accepted by the Commissioner as though no abandonment had ever occurred.

Rule 317. Delayed payment of balance of the issue fee; lapsed patents. Any remaining balance of the issue fee is to be paid within three months from the date of notice thereof and, if not paid, the patent lapses at the termination of the three-month period. If this balance is not timely paid but is submitted, with the fee for delayed payment, within three months of its due date with a verified showing or statement in the form of a declaration of sufficient cause for the late payment, it may be accepted by the Commissioner as though no lapse had ever occurred.

An application abandoned by reason of failure to pay the issue fee was formerly referred to as a forfeited application.

(Note, the following procedure is that which was in existence prior to the enactment of Public Law 93–601 on January 2, 1975. The procedures for operating under the new Law had not been established when this revision was prepared.)

When the three months' period within which the issue fee might have been paid has expired, the file is returned by the Patent Issue Division to the examining group. Certain clerical operations are performed and the file and drawing are forwarded to the Abandoned Files Unit. When the issue fee is not paid and the application is abandoned, proceedings are terminated as of the date the issue fee was due. The application is abandoned on that date (but if the issue fee is later accepted, on petition, the application is in a sense revived). During the three month period following such abandonment, it is possible to petition the Commissioner to have the application issued as a patent. Such petition must be supported by a verified showing of sufficient cause for the late payment, and accompanied by the proper issue fee and the fee for late payment. If such a petition accompanied by the required fees is not filed within the three month period following the abandonment (six months after the date of the notice of allowance) and granted, such abandoned application cannot be revived. In this respect an abandoned application that has passed through the six months' period indicated in rule 316 differs in status from an application that has become abandoned under the provisions of rules 135 and 136 in that the latter may be revived under the provisions of rule 137. Brenner v. Ebbert et al., 157 USPQ 609; 398 F. 2d 762; Certiorari denied, 159 USPQ 799. [R–43]

713 Interviews [R–24]

The personal appearance of an applicant, attorney, or agent before the examiner presenting matters for the latter's consideration is considered an interview.

713.01 General Policy, How Conducted [R–43]

Rule 133. Interviews. (a) Interviews with examiners concerning applications and other matters pending before the Office must be had in the examiners' rooms at such times, within office hours, as the respective examiners may designate. Interviews will not be permitted at any other time or place without the authority of the Commissioner. Interviews for the discussion of the patentability of pending applications will not be had before the first official action thereon. Interviews should be arranged for in advance.

(b) In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for response to Office actions as specified in rules 111,135.

Interviews are permissible on any working day except during periods of overtime work.

An interview should normally be arranged for in advance, as by letter, telegram or phone call, in order to insure that the primary examiner and/or the examiner in charge of the application will be present in the Office. When a second art unit is involved (Patentability Report), the availability of the second examiner should also be checked. (See § 705.01(f).) An appointment for interview once arranged should be kept. Many applicants and attorneys plan trips to Washington in reliance upon such appointments. When, after an appointment has been made, circumstances compel the absence of the examiner or examiners necessary to an effective interview, the other party should be notified immediately so that substitute arrangements may be made.

When a telephone call is made to an examiner and it becomes evident that a lengthy discussion will ensue or that the examiner needs time to restudy the situation, the call should be terminated with an agreement that the examiner will call back at a specified time. Such a call and all other calls originated by the examiner should be made through the FTS (Federal Telecommunications System) even though a collect call had been authorized. It is helpful if amendments and other papers, such as the letter of transmit-

tal, include the complete telephone number with area code and extension, preferably near the signature of the writer.

The unexpected appearance of an attorney or applicant requesting an interview without any previous notice to the examiner may well justify his refusal of the interview at that time, particularly in an involved case.

An examiner's suggestion of allowable subject matter may justify his indicating the possibility of an interview to accelerate early agreement on allowable claims.

An interview should be had only when the nature of the case is such that the interview could serve to develop and clarify specific issues and lead to a mutual understanding between the examiner and the applicant, and thereby advance the prosecution of the application. Thus the attorney when presenting himself for an interview should be fully prepared to discuss the issues raised in the Office action. When it is obvious that the attorney is not so prepared, an interview should not be permitted.

Examiners should avoid unnecessary interruptions during interviews with attorneys or inventors. In this regard, examiners should notify their receptionist, immediately prior to an interview, to not complete incoming telephone calls unless such are of an emergency nature.

The examiner should not hesitate to state, if such be the case, that claims presented for consideration at the interview require further search and study. Nor should the examiner hesitate to conclude an interview when it appears that no common ground can be reached nor when it becomes apparent that the application requires further amendment or an additional action by the examiner.

It is the responsibility of both parties to the interview to see that it is not extended beyond a reasonable period, usually not longer than thirty minutes. It is the duty of the primary examiner to see that an interview is not extended beyond a reasonable period even when he does not personally participate in the interview.

During an interview with an applicant who is prosecuting his own case and is not familiar with Office procedure the examiner may make suggestions that will advance the prosecution of this case; this lies wholly within his discretion. Too much time, however, should not be allowed for such interviews.

Examiners may grant one interview after final rejection. See § 713.09.

Where the response to a first complete action includes a request for an interview or a telephone consultation to be initiated by the examiner, or where an out-of-town attorney under similar circumstances requests that the examiner defer taking any further action on the case until the attorney's next visit to Washington (provided such visit is not beyond the date when the Office action would normally be given), the examiner, as soon as he has considered the effect of the response, should grant such request if it appears that the interview or consultation would result in expediting the case to a final action.

Where agreement is reached as a result of an interview, applicant's representative should be advised that an amendment pursuant to the agreement should be promptly submitted. If the amendment prepares the case for final action, the examiner should take the case up as special. If not, the case should await its turn.

Consideration of a filed amendment may be had by hand delivery of a duplicate copy of said amendment.

Early communication of the results of the consideration should be made to applicant; if requested, indicate on attorney's copy any agreement; initial and date both copies.

Although entry of amendatory matter usually requires actual presence of the original paper, examiner and clerical processing should proceed as far as practicable based on the duplicate copy. The extent of processing will depend on each amendment.

The substance of any interview, whether in person or by telephone must be made of record in the application. See § 713.04.

Examination by Examiner Other Than The One Who Conducted The Interview

Sometimes the examiner who conducted the interview is transferred to another group or resigns, and the examination is continued by another examiner. If there is an indication that an interview had been held, the second examiner should ascertain if any agreements were reached at the interview. Where conditions permit, as in the absence of a clear error or knowledge of other prior art, the second examiner should take a position consistent with the agreements previously reached. See § 812.01 for a statement of telephone practice in restriction and election of species situations.

713.02 Interviews Prior to First Official Action [R–43]

Prior to filing, no interview is permitted. However, in the examiner's discretion, a limited amount of time may be spent in indicating the field of search to an attorney, searcher or inventor.

A request for an interview, whether made orally or in writing, prior to the first Office

action is untimely and will not be acknowledged if written, or granted if oral; rule 133(a).

SEARCHING IN GROUP

Search in the group art unit should be permitted only with the consent of a primary examiner.

EXPOUNDING PATENT LAW

→ The Patent and Trademark Office cannot act as an expounder of the patent law, nor as a counsellor for individuals.

713.03 Interview for "Sounding Out" Examiner Not Permitted

Interviews that are solely for the purpose of "sounding out" the examiner, as by a local attorney acting for an out-of-town attorney, should not be permitted when it is apparent that any agreement that would be reached is conditional upon being satisfactory to the principal attorney.

713.04 Substance of Interview Must Be Made of Record [R–43]

→ A complete written statement as to the substance of any face-to-face or telephone interview with regard to an application must be made of record in the application, whether or not an agreement with the examiner was reached at the interview. See rule 133(b), § 713.01.

This is further brought out by the following Rule:

Rule 2. Business to be transacted in writing. All business with the Patent and Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

Applicants and their attorneys or agents are responsible for compliance with the requirement for a complete written statement except in those situations in which it is agreed that the examiner will issue an Office action upon the application without further written response on behalf of applicant. In those situations, the examiner will make the substance of the interview of record in the Office action. The examiner may also complete the record of an interview if significant matters are inadvertently omitted from a written statement filed on behalf of applicant.

Noncompliance on behalf of applicant with the above noted requirement for a complete written statement when filing a response will result in the applicant being given one month from the date of the notifying letter or the remainder of any period for response, whichever is longer, to complete the response and thereby avoid abandonment of the application (rule 135(c)).

EXAMINER TO CHECK FOR ACCURACY

Applicant's summary of what took place at the interview should be carefully checked to determine the accuracy of any statement attributed to the examiner during the interview. (a) If there is an inaccuracy and it bears directly on the question of patentability, it should be pointed out in the next Office letter. If the claims are allowable for other reasons of record, the examiner should withhold allowance by means of an Ex parte Quayle action until the record is clarified. (b) If the inaccuracy does not bear directly on the question of patentability, the case may be sent to issue, if allowable for reasons of record, but the examiner should send a letter setting forth his version of the statement attributed to him.

An inaccuracy with respect to an argument presented at the interview; e.g., including in the summary of the interview an argument not then presented, should be treated as in (a) or (b) above.

713.05 Interviews Prohibited or Granted, Special Situations [R–43]

Saturday interviews, see § 713.01.

Except in unusual situations, no interview is permitted after the brief on appeal is filed or after a case has been passed to issue.

An interview may be appropriate before applicant's first response when the examiner has suggested that allowable subject matter is present or where it will assist applicant in judging the propriety of continuing the prosecution.

Office employees are forbidden to hold either ← oral or written communication with an unregistered or a disbarred attorney regarding an application unless it be one in which said attorney is the applicant. See § 105.

Interviews are frequently requested by persons whose credentials are of such informal character that there is serious question as to whether such persons are entitled to any infor-

mation under the provisions of rule 14. In general, interviews are not granted to persons who lack proper authority from the applicant or attorney of record in the form of a paper on file in the case or do not have in their possession a copy of the application file. A MERE POWER TO INSPECT IS NOT SUFFICIENT AUTHORITY FOR GRANTING AN INTERVIEW INVOLVING THE MERITS OF THE APPLICATION.

However, interviews may be granted to registered individuals who are known to be the local representatives of the attorney in the case, even though a power of attorney to them is not of record in the particular application. When prompt action is important an interview with the local representative may be the only way to save the application from abandonment. (See § 408.)

If a registered individual seeking the interview has in his possession a copy of the application file, the examiner may accept his statement that he is authorized to represent the applicant under rule 34 or he is the person named as the attorney of record.

Interviews normally should not be granted unless the requesting party has authority to bind the principal concerned.

The availability of personal interviews in the "Conference Period", which is the time between the filing of applicant's thorough first response and a concluding action by the examiner, for attorneys resident or frequently in Washington is obvious. For others more remote, telephone interviews may prove valuable. However, present Office policy places great emphasis on telephone interviews initiated by the examiner to attorneys and agents of record. See § 408.

The examiner, by making a telephone call, may be able to suggest minor, probably quickly acceptable changes which would result in allowance. If there are *major* questions or suggestions, the call might state them concisely, and suggest a further telephone or personal interview, at a prearranged later time, giving applicant more time for consideration before discussing the points raised.

For an interview with an examiner who does not have negotiation authority, arrangements should always include an examiner who does have such authority, and who has familiarized himself with the case, so that authoritative agreement may be reached at the time of the interview.

GROUPED INTERVIEWS

For attorneys remote from Washington who prefer personal interviews, the grouped interview practice is effective. If in any case there is a prearranged interview, *with agreement to file a prompt supplemental amendment putting the case as nearly as may be in condition for concluding action*, prompt filing of the supplemental amendment gives the case special status, and brings it up for immediate special action.

713.06 No Inter Partes Questions Discussed Ex Parte [R–26]

The examiner may not discuss *inter partes* questions *ex parte* with any of the interested parties. For this reason, the telephone number of the examiner should not be typed on decisions on motions or any other interference papers. See § 1111.01.

713.07 Exposure of Other Cases [R–26]

Prior to an interview the examiner should arrange his desk so that files, drawings and other papers, except those necessary in the interview, are placed out of view. See § 101.

713.08 Demonstration, Exhibits, Models [R–26]

The invention in question may be exhibited or demonstrated during the interview by a model thereof which may be sent to the Office prior to the interview where it is received in the Supply and Receiving Unit and forwarded to the group. A model is not to be received by the examiner directly from the applicant or his attorney. See §§ 608.03 and 608.03(a).

Oftentimes a model or exhibit is not given into the custody of the Office but is brought directly into the group by the attorney solely for inspection or demonstration during the course of the interview. This is permissible. Demonstrations of apparatus or exhibits too large to be brought into the Office may be viewed by the examiner outside of the Office, (in the Washington area) with the approval of the supervisory primary examiner. It is presumed that the witnessing of the demonstration or the reviewing of the exhibit is actually essential in the developing and clarifying of the issues involved in the application.

713.09 Finally Rejected Application [R–26]

Normally, one interview after final rejection is permitted. However, the intended purpose and content of the interview must be presented briefly, either orally or in writing. With the approval of the primary examiner, an interview may be granted if the examiner is convinced that disposal or clarification for appeal may be accomplished with only nominal further consideration. Interviews merely to restate arguments of record or to discuss new limita-

tions which would require more than nominal reconsideration or new search should be denied. See § 714.13.

713.10 Interview Preceding Filing Amendment Under Rule 312 [R–26]

After a case is sent to issue, it is technically no longer under the jurisdiction of the primary examiner, rule 312. An interview with an examiner that would involve a detailed consideration of claims sought to be entered and perhaps entailing a discussion of the prior art for determining whether or not the claims are allowable should not be given. Obviously an applicant is not entitled to a greater degree of consideration in an amendment presented informally than is given an applicant in the consideration of an amendment when formally presented, particularly since consideration of an amendment filed under rule 312 cannot be demanded as a matter of right.

Requests for interviews on cases already passed to issue should be granted only with specific approval of the group director upon a showing in writing of extraordinary circumstances.

714 Amendments, Applicant's Action [R–26]

Rule 115. Amendment by applicant. The applicant may amend before or after the first examination and action, and also after the second or subsequent examination or reconsideration as specified in rule 112 or when and as specifically required by the examiner.

See also § 714.12.

714.01 Signatures to Amendments [R–26]

To facilitate any telephone call that may become necessary, it is recommended that the complete telephone number with area code and extension be given, preferably near the signature. Note §§ 605.04 to 605.05(a) for a discussion of signatures to the application.

714.01(a) Unsigned or Improperly Signed Amendment [R–39]

An unsigned amendment or one not properly signed by a person having authority to prosecute the case is not entered. This applies, for instance, where the amendment is signed by one only of two applicants and the one signing has not been given a power of attorney by the other applicant.

If copies (carbon or electrostatic) are filed, the signature must be applied after the copies are made. § 714.07

An amendment filed with a copy of a signature rather than an original signature, may be entered if an accompanying transmittal letter contains a proper original signature.

Telegraphic amendments must be confirmed by signed formal amendments. § 714.08.

A "Telecopier" document, or a copy thereof, without an original signature, is acceptable in the same manner as a telegraphic amendment to preserve the dates involved, § 714.08. However, such a practice is discouraged because it results in the filing of duplicate papers and much unnecessary paper work. A "Telecopier" document with the original signature of a registered attorney or agent acting in a representative capacity under rule 34(a) is acceptable and does not require confirmation.

When an unsigned or improperly signed amendment is received the amendment will be listed on the file wrapper, but not entered. The examiner will notify applicant of the status of the case, advising him to furnish a duplicate amendment properly signed or to ratify the amendment already filed. Applicant is given either the time remaining in the period for response, or one month, whichever is longer, to file his supplemental response (rule 135, § 711).

Sometimes problems arising from unsigned or improperly signed amendments may be disposed of by calling in the local representative of the attorney of record, since he may have the authority to sign the amendment. Listings of local representatives of out-of-town attorneys are kept available in the various group directors' offices.

An amendment signed by a person whose name is known to have been removed from the registers of attorneys and agents under the provisions of rule 347 or rule 348 is not entered. The file and unentered amendment are submitted to the Office of the Solicitor for appropriate action.

714.01(c) Signed by Attorney Not of Record [R–36]

See § 405.

A registered attorney or agent acting in a representative capacity under rule 34, may sign amendments even though he does not have a power of attorney in the application. See § 402.

714.01(d) Amendment Signed by Applicant But Not by Attorney of Record [R–30]

If an amendment signed by the applicant is received in an application in which there

is a duly appointed attorney, the amendment should be entered and acted upon. Attention should be called to rule 33(a). Two copies of the action should be prepared, one being sent to the attorney and the other direct to applicant. The notation: "Copy to applicant" should appear on the original and on both copies.

714.02 Must Be Fully Responsive [R–25]

Rule 111. Reply by applicant. (a) After the Office action, if adverse in any respect, the applicant, if he persist in his application for a patent, must reply thereto and may request reexamination or reconsideration, with or without amendment.

(b) In order to be entitled to reexamination or reconsideration, the applicant must make request therefor in writing, and he must distinctly and specifically point out the supposed errors in the examiner's action; the applicant must respond to every ground of objection and rejection in the prior Office action (except that request may be made that objections or requirements as to form not necessary to further consideration of the claims be held in abeyance until allowable subject matter is indicated), and the applicant's action must appear throughout to be a bona fide attempt to advance the case to final action. A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this rule.

(c) In amending an application in response to a rejection, the applicant must clearly point out the patentable novelty which he thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. He must also show how the amendments avoid such references or objections. (See rules 135 and 136 for time for reply.)

In all cases where response to a requirement is indicated as necessary to further consideration of the claims, or where allowable subject matter has been indicated, a complete response must either comply with the formal requirements or specifically traverse each one not complied with.

Drawing and specification corrections, presentation of a new oath and the like are generally considered as formal matters. However, the line between formal matters and those touching the merits is not sharp, and the determination of the merits of a case may require that such corrections, new oath, etc., be insisted upon prior to any indication of allowable subject matter.

Rule 119. Amendment of claims. The claims may be amended by canceling particular claims, by presenting new claims, or by rewriting particular claims as indicated in Rule 121. The requirements of Rule 111 must be complied with by pointing out the specific distinctions believed to render the claims patentable over the references in presenting arguments in support of new claims and amendments.

An amendment submitted after a second or subsequent non-final action on the merits which is otherwise responsive but which increases the number of claims drawn to the invention previously acted upon is not to be held nonresponsive for that reason alone. (See rule 112, § 706).

The prompt development of a clear issue requires that the responses of the applicant meet the objections to and rejections of the claims. Applicant should also specifically point out the support for any amendments made to the disclosure. See § 706.03(n).

An amendment attempting to "rewrite" a claim in the manner set forth in rule 121(b) may be held non-responsive if it uses parentheses, ( ), where brackets, [ ], are called for; see § 714.22.

Responses to requirements to restrict are treated under § 818.

714.03 Amendments Not Fully Responsive, Action To Be Taken [R–39]

If there is sufficient time remaining in the six-month statutory period or set shortened period when applicant's amendment is found to be not fully responsive to the last Office action, a letter should at once be sent applicant pointing out wherein his amendment fails to fully respond coupled with a warning that the response must be completed within the time period in order to avoid the question of abandonment. See § 714.05.

Where a bona fide response to an examiner's action is filed before the expiration of a permissible period, but through an apparent oversight or inadvertence some point necessary to a complete response has been omitted,—such as an amendment or argument as to one or two of several claims involved or signature to the amendment,—the examiner, as soon as he notes the omission, should require the applicant to complete his response within a specified time limit (usually one month) if the period has already expired or insufficient time is left to take action before the expiration of the period. If this is done the application should not be held abandoned even though the prescribed period has expired. See rule 135(c). Similarly, where there is an informality as to the fee in connection with an amendment presenting additional claims in a case filed on or after October 25, 1965, the applicant is notified by the clerk on form POL 319. See §§ 607 and 714.10.

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The examiner must exercise discretion in applying this practice to safeguard against abuses thereof.

The practice outlined above does not apply where there has been a deliberate omission of some necessary part of a complete response. For example, if an election of species has been required and applicant does not make election because he holds the requirement to be wrong, the amendment on its face is not a "bona fide attempt to advance the case to final action" (rule 135), and the examiner is without authority to postpone decision as to abandonment.

If there is ample time for applicant's reply to be filed within the time period, no reference is made to the time for response other than to note in the letter that the response must be completed within the period for response dating from the last Office action.

714.04 Claims Presented in Amendment With No Attempt To Point Out Patentable Novelty [R–25]

In the consideration of claims in an amended case where no attempt is made to point out the patentable novelty, the claims should *not* be allowed. (See Rule 111, § 714.02.)

An amendment failing to point out the patentable novelty which the applicant believes to exist in his case may be held to be nonresponsive and a time limit set to furnish a proper response if the statutory period has expired or almost expired (§ 714.03). However, if the claims as amended are clearly open to rejection on grounds of record, a final rejection should generally be made.

714.05 Examiner Should Immediately Inspect [R–25]

Actions by applicant, especially those filed near the end of the period for response, should be inspected immediately upon filing to determine whether they are completely responsive to the preceding Office action so as to prevent abandonment of the application. If found inadequate, and sufficient time remains, applicant should be notified of the deficiencies and warned to complete the response within the period. See § 714.03.

All amended cases put on the examiner's desk should be inspected by him at once to determine:

If the amendment is properly signed (§ 714.01).

If the amendment has been filed within the statutory period, set shortened period or time limit (§ 710).

If the amendment is fully responsive. See §§ 714.03 and 714.04.

If the changes made by the amendment warrant transfer. See § 903.08(d).

If the case is special. See § 708.01.

If claims suggested to applicant for interference purposes have been inserted.

If there is a traverse of a requirement for restriction. See § 818.03(a).

If "easily erasable" paper has been used or other non-permanent method of preparation or reproduction. See § 714.07.

If applicant has cited references. See §§ 707.05(b) and 1302.12.

If a terminal disclaimer has been filed. See §§ 508.01, 804.02, 804.03 and 1403.

If any matter involving security has been added. See § 107.01.

Action Crosses Amendment

A supplemental action is usually necessary when an amendment is filed on or before the mailing date of the regular action but reaches the examining group later. The supplemental action should be promptly prepared. It need not reiterate all portions of the previous action that are still applicable but it should specify which portions are to be disregarded, pointing out that the period for response runs from the mailing of the supplemental action. The action should be headed "Responsive to amendment of (date) and supplemental to the action mailed (date)".

714.06 Amendments Sent to Wrong Group

See § 508.01.

714.07 Amendments Not in Permanent Ink [R–39]

Rule 52(a) requires "permanent ink or its equivalent in quality" to be used on papers which will become part of the record and In re Benson, 1959 C.D. 5; 744 O.G. 353 holds that documents on so-called "easily erasable" paper violate the requirement. The fact that rule 52(a) has not been complied with may be discovered as soon as the amendment reaches the examining group or, later, when the case is reached for action. In the first instance, applicant is promptly notified that the amendment is not entered and is required to file a permanent copy within one month or to order a copy to be made by the Patent Office at his expense. Physical entry of the amendment will be made from the permanent copy.

If there is no appropriate response within the one month period, a copy is made by the

Patent Office, applicant being notified and required to remit the charges or authorize charging them to his deposit account.

In the second instance, when the non-permanence of the amendment is discovered only when the case is reached for action, similar steps are taken, but action on the case is not held up, the requirement for a permanent copy of the amendment being included in the Office action.

Office copier or good carbon copies on satisfactory paper are acceptable. But see In re Application Papers Filed Jan. 20, 1956, 706 O.G. 4. Although a good copy is acceptable, signatures must be applied after the copy is made.

See § 608.01 for more discussion on acceptable copies.

714.08 Telegraphic Amendment [R–23]

When a telegraphic amendment is received, the telegram is placed in the file but not entered. If confirmation of this amendment by a properly signed formal amendment does not follow in due time, the applicant is notified that proper confirmation is required; otherwise, the telegram will not be accepted as a response to the former Office action. If he does confirm promptly, the amendment is entered. (See Ex parte Wheary, 1913 C.D. 253; 197 O.G. 534.)

The same test as to completeness of response applies to an amendment sent by telegraph as to one sent by mail. See § 714.02.

714.09 Amendments Before First Office Action [R–39]

An amendment filed before the first Office action, even one filed along with the original application, does not enjoy the status of part of the original disclosure. See § 608.04(b).

In the case of rule 60 (unexecuted) applications, an amendment stating that, "This is a division (continuation) of application Serial No. _____, filed _____." and canceling any irrelevant claims as well as any preliminary amendment should accompany the application. Amendments should either accompany the application or be filed after the application has received its serial number and filing date. See § 201.06(a).

714.10 Claims Added in Excess of Filing Fee [R–36]

The Fee Act, which became effective October 25, 1965, provides for the presentation of claims added in excess of filing fee. On payment of an additional fee (see § 607), these excess claims may be presented any time after the application is filed, which of course, includes the time before the first action. This provision does not apply in the case of applications filed before October 25, 1965.

714.11 Amendment Filed During Interference Proceedings [R–23]

See § 1111.05.

714.12 Amendments After Final Rejection or Action [R–36]

Rule 116. Amendments after final action. (a) After final rejection or action (rule 113) amendments may be made canceling claims or complying with any requirements of form which has been made, and amendments presenting rejected claims in better form for consideration on appeal may be admitted; but the admission of any such amendment or its refusal, and any proceedings relative thereto, shall not operate to relieve the application from its condition as subject to appeal or to save it from abandonment under rule 135.

(b) If amendments touching the merits of the application be presented after final rejection, or after appeal has been taken, or when such amendment might not otherwise be proper, they may be admitted upon a showing of good and sufficient reasons why they are necessary and were not earlier presented.

(c) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in rule 198, or to carry into effect a recommendation under rule 196.

Once a final rejection that is not premature has been entered in a case, applicant no longer has any right to unrestricted further prosecution. This does not mean that no further amendment or argument will be considered. Any amendment that will place the case either in condition for allowance or in better form for appeal may be entered. Also, amendments complying with objections or requirements as to form are to be permitted after final action in accordance with rules 116(a). Ordinarily, amendments filed after the final action are not entered unless approved by the examiner. See §§ 706.07(e), 714.13 and 1207.

The prosecution of an application before the examiner should ordinarily be concluded with the final action. However, one personal interview by applicant may be entertained after such final action if circumstances warrant. Thus, only one request by applicant for a personal interview after final should be granted, but in exceptional circumstances, a second personal interview may be initiated by the *examiner* if in his judgment this would materially assist in placing the application in condition for *allowance.*

Many of the difficulties encountered in the prosecution of patent applications after final rejection may be alleviated if each applicant includes, at the time of filing or no later than the first response, claims varying from the broadest to which he believes he is entitled to the most detailed that he is willing to accept.

714.13 Amendments After Final Rejection or Action, Procedure Followed [R–36]

Final Rejection—Time for Response

The filing of a timely first response to a final rejection having a shortened statutory period for response is construed as including a request to extend the shortened statutory period an additional month, even if previous extensions have been granted, but in no case may the period for response exceed six months from the date of the final action. The additional month may be used to place the application in condition for allowance, to appeal or to file a continuing application.

During the additional month no applicant or attorney initiated interview is normally permitted. Since a timely first response to a final rejection is construed as including a request for an extension of time, any subsequent request for an extension of time is considered to be a second request and must be submitted to the group director.

An object of this practice is to obviate the necessity for appeal or filing a continuing case merely to gain time to consider the examiner's position in reply to an amendment timely filed after final rejection. Failure to file a response during the shortened statutory period results in abandonment of the application.

Entry Not a Matter of Right

It should be kept in mind that applicant cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection (see rule 116) or reinstate previously canceled claims.

Except where an amendment merely cancels claims, adopts examiner suggestions, removes issues for appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under rule 116(b) is expected in all amendments after final rejection. Failure to properly respond to the final rejection results in abandonment unless an amendment is entered in part (§ 714.20, items 3 and 4).

An amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided the total effect of the amendment is to (1) remove issues for appeal, and/or (2) adopt examiner suggestions.

See also §§ 1207 and 1211.

Action by Examiner

In the event that the proposed amendment does not place the case in better form for appeal, nor in condition for allowance, applicant should be promptly informed of this fact, whenever possible, within the statutory period. The refusal to enter the proposed amendment should not be arbitrary. The proposed amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified. Ordinarily, the specific deficiencies of the amendment need not be discussed. The reasons should be concisely expressed. For example:

(1) The claims, if amended as proposed, would not avoid any of the rejections set forth in the last Office action, and thus the amendment would not place the case in condition for allowance or in better condition for appeal.

(2) The claims, if amended as proposed, would avoid the rejection on indefiniteness but would not avoid the rejection on the references. The amendment will be entered upon the filing of an appeal.

(3) The claims as amended present new issues requiring further consideration or search.

(4) Since the amendment presents additional claims without canceling any finally rejected claims it is not considered as placing the application in better condition for appeal; Ex parte Wirt, 1905 C.D. 247; 117 O.G. 599.

Examiners should indicate the status of each claim of record or proposed in the amendment, and which proposed claims would be entered on the filing of an appeal if filed in a separate paper.

Applicant should be notified, if certain portions of the amendment would be acceptable as placing some of the claims in better form for appeal or complying with objections or requirements as to form, if a separate paper were filed containing only such amendments. Similarly, if the proposed amendment to some of the claims would render them allowable, applicant should be so informed. This is helpful in assuring the filing of a brief consistent with the claims as amended. A statement that the final rejection stands and that the statutory period runs from the date of the final rejection is also in order.

Form letter POL–303 should be used to acknowledge receipt of a response from appli-

cant after final rejection where such response is prior to filing of a notice of appeal which does not place the application in condition for allowance. This form has been devised to advise applicant of the disposition of the proposed amendments to the claims and of the effect of any argument or affidavit not placing the application in condition for allowance or which could not be made allowable by a telephone call to clear up minor matters.

Any amendment timely filed after a final rejection should be immediately considered to determine whether it places the application in condition for allowance or in better form for appeal. Examiners are expected to turn in their response to an amendment after final rejection within five days from the time the amendment reaches their desks. In those situations where the amendment reaches the examiner's desk after the expiration of the shortened statutory period, the examiner is expected to return his action to the clerical force within three days. In *all* instances, both before and after final rejection, in which an application is placed in condition for allowance as by an interview or amendment, *before preparing it for allowance*, applicant should be notified promptly of the allowability of all claims by means of form letter POL–327 or an examiner's amendment.

Such a letter is important because it may avoid an unnecessary appeal and act as a safeguard against a holding of abandonment. Every effort should be made to mail the letter before the period for response expires.

If no appeal has been filed within the period for response and no amendment has been submitted to make the case allowable or which can be entered in part (see § 714.20), the case stands abandoned.

It should be noted that, under rule 181(f), the filing of a rule 181 petition will not stay the period for reply to an examiner's action which may be running against an application. See § 1207 for appeal and post-appeal procedure. For after final rejection practice relative to affidavits or declarations filed under rules 131 and 132 see §§ 715.09 and 716.

Hand Delivery of Papers

Any paper which relates to a pending application may be personally delivered to an Examining Group. However, the Examining Group will accept the paper only if: (1) the paper is accompanied by some form of receipt which can be handed back to the person delivering the paper; and (2) the Examining Group being asked to receive the paper is responsible for acting on the paper.

The receipt may take the form of a duplicate copy of such paper or a card identifying the paper. The identifying data on the card should be so complete as to leave no uncertainty as to the paper filed. For example, the card should contain the applicant's name(s), Serial No., filing date and a description of the paper being filed. If more than one paper is being filed for the same application, the card should contain a description of each paper or item.

Under this procedure, the paper and receipt will be date stamped with the Group date stamp. The receipt will be handed back to the person hand delivering the paper. The paper will be correlated with the application and made an official paper in the file, thereby avoiding the necessity of processing and forwarding the paper to the Examining Group via the Mail Room.

The Examining Group will accept and date stamp a paper even though the paper is accompanied by a check or the paper contains an authorization to charge a Deposit Account. However, in such an instance, the paper will be hand carried by Group personnel to the Office of Finance for processing and then made an official paper in the file.

All such papers, together with the cash, checks, or money orders, shall be hand carried to the Cashier's Window, Room 2–1BO1, between the hours of 3:00 p.m. and 4:00 p.m.

The papers shall be processed by the accounting clerk, Office of Finance, for pickup at the Cashier's Window by 3:00 p.m. the following work day. Upon return to the group, the papers will be entered in the application file wrappers.

714.14 Amendments After Allowance of All Claims [R–32]

Under the decision in Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213, after all claims in a case have been allowed the prosecution of the case on the merits is closed even though there may be outstanding formal objections which preclude fully closing the prosecution.

Amendments touching the merits are treated in a manner similar to amendments after final rejection, though the prosecution may be continued as to the formal matters. See §§ 714.12 and 714.13.

See § 607 for additional fee requirements.

714.15 Amendment Received in Examining Group After Mailing of Notice of Allowance [R–32]

Where an amendment, even though prepared by applicant prior to allowance, does not reach the Office until after the notice of allowance has been mailed, such amendment has the status of one filed under rule 312. Its entry is a matter of grace. For discussion of amendments filed under rule 312, see §§ 714.16 to 714.16(e).

If, however, the amendment is filed in the Office prior to the mailing out of the notice of allowance, but is received by the examiner after the mailing of the notice of allowance, it has the same standing in the case as though the notice had not been mailed. Where the case has not been closed to further prosecution, as by final rejection of one or more claims, or by an action allowing all of the claims, applicant may be entitled to have such amendment entered even though it may be necessary to withdraw the application from issue. Such withdrawal, however, is unnecessary if the amendatory matter is such as the examiner would recommend for entry under rule 312.

As above implied, the case will not be withdrawn from issue for the entry of an amendment that would reopen the prosecution if the Office action next preceding the notice of allowance closed the case to further amendment, i.e., by indicating the patentability of all of the claims, or by allowing some and finally rejecting the remainder.

After an applicant has been notified that the claims are all allowable, further prosecution of the merits of the case is a matter of grace and not of right (Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213). To this extent the practice affecting he status of an amendment received in the Office on the date of mailing the notice of allowance, as set forth in Ex parte Miller, 1922 C.D. 36; 305 O.G. 419, is modified.

714.16 Amendment After Notice of Allowance, Rule 312 [R–41]

Rule 312. Amendments after allowance. Amendments after the notice of allowance of an application will not be permitted as a matter of right. However, such amendments may be made if filed not later than the date the issue fee is paid, on the recommendation of the primary examiner, approved by the Commissioner, without withdrawing the case from issue.

The Commissioner has delegated the approval of such recommendation to the Supervisory Primary Examiners.

A supplemental oath is not treated as an amendment under rule 312, see § 603.01.

After the Notice of Allowance has been mailed, the application is technically no longer under the jurisdiction of the primary examiner. He can however, make examiner's amendments. (See § 1302.04) and has authority to enter Order 3311 amendments submitted after Notice of Allowance of an application which embody merely the correction of formal matters in the specification or drawing, or formal matters in a claim without changing the scope thereof, or the cancellation of claims from the application, without forwarding to the Supervisory Primary Examiner for approval.

Amendments other than these require approval by the Supervisory Primary Examiner. The group director establishes group policy with respect to the treatment of Order 3311 amendments directed to trivial informalities which seldom affect significantly the vital formal requirements of any patent; namely, (1) that its disclosure be adequately clear, and (2) that any invention present be defined with sufficient clarity to form an adequate basis for an enforceable contract.

Consideration of an amendment under rule 312 cannot be demanded as a matter of right. Prosecution of a case should be conducted before, and thus be complete *including editorial revision of the specification and claims* at the time of the Notice of Allowance. However, where amendments of the type noted are shown (1) to be needed for proper disclosure or protection of the invention, and (2) to require no substantial amount of additional work on the part of the Office, they may be considered and, if proper, entry may be recommended by the primary examiner.

The requirements of rule 111(c) (§ 714.02) with respect to pointing out the patentable novelty of any claim sought to be added or

amended, apply in the case of an amendment under rule 312, as in ordinary amendments. See §§ 713.04 and 713.10 regarding interviews. As to amendments affecting the disclosure, the scope of any claim, or that add a claim, the remarks accompanying the amendment must fully and clearly state the reasons on which reliance is placed to show: (1) why the amendment is needed; (2) why the proposed amended or new claims require no additional search or examination; (3) why the claims are patentable and, (4) why they were not earlier presented.

NOT TO BE USED FOR CONTINUED PROSECUTION

Rule 312 was never intended to provide a way for the continued prosecution of application after it has been passed for issue. When the recommendation is against entry, a detailed statement of reasons is not necessary in support of such recommendation. The simple statement that the proposed claim is not obviously allowable and briefly the reason why is usually adequate. Where appropriate, any one of the following reasons is considered sufficient: (1) an additional search is required, or (2) more than a cursory review of the record is necessary, or (3) the amendment would involve materially added work on the part of the Office, e.g. checking excessive editorial changes in the specification or claims.

Where claims added by amendment under rule 312 are all of the form of dependent claims, some of the usual reasons for non-entry are less likely to apply although questions of new matter, sufficiency of disclosure, or undue multiplicity of claims could arise.

See §§ 607 and 714.16(c) for additional fee requirements.

714.16(a) Amendments Under Rule 312, Copied Patent Claims [R–21]

See § 1101.02(g) for the procedure to be followed when an amendment is received after notice of allowance which includes one or more claims copied or substantially copied from a patent.

The entry of the copied patent claims is not a matter of right. See § 714.19 item (4).

See §§ 607 and 714.16(c) for additional fee requirements.

714.16(b) Amendment Under Rule 312 Filed With a Motion Under Rule 231 [R–21]

Where an amendment filed with a motion under rule 231(a)(3) applies to a case in issue, the amendment is not entered unless and until the motion has been granted. See § 1105.03.

714.16(c) Amendment Under Rule 312, Additional Claims [R–21]

If the application was filed on or after October 25, 1965, and the amendment under rule 312 adds claims (total and independent) in excess of the number previously paid for, additional fees are required. The amendment is *not* considered by the examiner unless accompanied by the full fee required. See § 607 and 35 U.S.C. 41.

714.16(d) Amendments Under Rule 312, Handling [R–41]

AMENDMENTS NOT UNDER ORDER 3311

Amendments under rule 312 are sent by the Mail and Correspondence Branch to the Patent Issue Division which, in turn, forwards the proposed amendment, file, and drawing (if any) to the group which allowed the application. In the event that the class and subclass in which the application is classified has been transferred to another group after the application was allowed, the proposed amendment, file and drawing (if any) are transmitted directly to said other group and the Patent Issue Division notified. If the examiner who allowed the application is still employed in the Patent Office but not in said other group, he may be consulted about the propriety of the proposed amendment and given credit for any time spent in giving it consideration.

The amendment is PROMPTLY considered by the examiner who indicates whether or not its entry is recommended by writing "Enter–312", "Do Not Enter" or "Enter In Part" thereon in red ink in the upper left corner.

If the amendment is favorably considered, it is entered and a notice of entry (POL–271) is prepared. No "Entry Recommended under Rule 312" stamp is required on the amendment or on the notice of entry in view of the use of form (POL–271). The primary examiner indicates his recommendation by stamping and signing his name on the notice of entry form (POL–271).

If the examiner's recommendation is completely adverse, a report giving the reasons for non-entry is typed on the notice of disapproval (POL–271) and signed by the primary examiner.

The file, drawing, and unmailed notices are forwarded to the supervisory primary examiner for consideration, approval, and mailing.

For entry-in-part, see § 714.16(e).

The filling out of the appropriate form by the clerk does not signify that the amendment

has been admitted; for, though actually entered it is not officially admitted unless and until approved by the supervisory primary examiner.

See §§ 607 and 714.16(c) for additional fee requirements.

Petitions to the Commissioner relating to the refusal to enter an amendment under rule 312 will be decided by the group director.

AMENDMENTS UNDER ORDER 3311

The examiner indicates approval of amendments concerning merely formal matters by writing "Enter-3311" thereon. Such amendments do not require submission to the supervisory primary examiner prior to entry. See § 714.16. The notice of entry (POL–271) is date stamped and mailed by the examining group. If such amendments are disapproved either in whole or in part, they are handled like those not under Order 3311.

714.16(e) Amendments Under Rule 312, Entry in Part [R–21]

The general rule that an amendment cannot be entered in part and refused in part should not be relaxed, but when, under rule 312, an amendment, for example, is proposed containing a plurality of claims or amendments to claims, some of which may be entered and some not, the acceptable claims or amendments should be entered in the case. If necessary, the claims should be renumbered to run consecutively with the claims already in the case. The refused claims or amendments should be canceled in lead pencil on the amendment.

The examiner should then submit a report (POL–271) recommending the entry of the acceptable portion of the amendment and the nonentry of the remaining portion together with his reasons therefore. The claims entered should be indicated by number in this report.

Handling is similar to complete entry of a rule 312 amendment.

If the application was filed on or after October 25, 1965, entry in part is not recommended unless the full additional fee required, if any, accompanies the amendment. See §§ 607 and 714.16(c).

714.17 Amendment Filed After the Period for Response Has Expired [R–35]

When an application is not prosecuted within the period set for response and thereafter an amendment is filed, such amendment shall be endorsed on the file wrapper of the application, but not formally entered. The examiner shall immediately notify the applicant, by form letter POL–327, that the amendment was not filed within the time period and therefore cannot be entered and that the application is abandoned. See § 711.02.

The Patent Office has been receiving an excessivly large volume of petitions to revive based primarily on the late filing of amendments and other responses to official actions. Many of these petitions indicate that the late filing was due to unusual mail delays; however, the records generally show that the filing was only two or three days late.

In order to alleviate, for applicants and the Office, the problems and expenditures of time and effort occasioned by abandonments and petitions to revive, it is suggested that responses to official action be mailed to the Patent Office at least one, and preferably two, week(s) prior to the expiration of the period within which a response is required. This suggestion is made in the interest of improving efficiency, thereby providing better service to the public.

714.18 Entry of Amendments [R–41]

Amendments are stamped with the date of their receipt in the group. It is important to observe the distinction which exists between the stamp which shows the date of receipt of the amendment in the group ("Group Date" stamp) and the stamp bearing the date of receipt of the amendment by the Office ("Office Date" stamp). The latter date, placed in the left-hand corner, should always be referred to in writing to the applicant with regard to his amendment.

All amendments received in the clerical sections are processed and with the applications delivered to the supervisory primary examiner for his review and distribution to the examiners.

Every mail delivery should be carefully screened to remove all amendments responding to a final action in which a time period is running against the applicant. Such amendments should be processed within the next 24 hours.

The purpose of this procedure is to ensure uniform and prompt treatment by the examiners of all cases where the applicant is awaiting a reply to a proposed amendment after final action. By having all of these cases pass over the supervisory primary examiner's desk, he will be made aware of the need for any special treatment, if the situation so warrants. For example, the supervisory primary examiner will know whether or not the examiner in each

case is on extended leave or otherwise incapable of moving the case within the required time periods (5 or 3 days; see § 714.13). In cases of this type, the applicant should receive a Patent Office communication in sufficient time to adequately consider his next action if the case is not allowed. Consequently, the clerical handling will continue to be special when these cases are returned by the examiners to the clerical sections.

The amendment or letter is placed in the file, given its number as a paper in the application, and its character endorsed on the file wrapper in red ink.

When several amendments are made in an application on the same day no particular order as to the hour of the receipt or the mailing of the amendments can be assumed, but consideration of the case must be given as far as possible as though all the papers filed were a composite single paper.

After entry of the amendment the application is "up for action." It is placed on the examiner's desk, and he is responsible for its proper disposal. The examiner should immediately inspect the amendment as set forth in § 714.05. After inspection if no immediate or special action is required, the application awaits re-examination in regular order.

714.19 List of Amendments, Entry Denied [R–41]

The following types of amendments are ordinarily denied entry:

1. An amendment presenting an unpatentable claim, or a claim requiring a new search or otherwise raising a new issue in a case whose prosecution before the primary examiner has been closed, as where

(a) All claims have been allowed,

(b) All claims have been finally rejected (for exceptions see §§ 714.12, 714.13, and 714.20(4)),

(c) Some claims allowed and remainder finally rejected. See §§ 714.12 to 714.14.

2. Substitute specification that has not been required and is not needed. See rule 125, §§ 608.01(q) and 714.20. If the examiner approves, it may be entered.

3. A patent claim suggested by the examiner and not presented within the time limit set or a reasonable extension thereof, unless entry is authorized by the Commissioner. See § 1101.02(f).

4. While copied patent claims are generally admitted even though the case is under final rejection or on appeal, under certain conditions, the claims may be refused entry. See § 1101.02(g).

5. An unsigned or improperly signed amendment or one signed by a disbarred attorney.

6. An amendment filed in the Patent Office after the expiration of the statutory period or set time limit for response. See § 714.17.

7. An amendment so worded that it cannot be entered with certain accuracy. See § 714.23.

8. An amendment cancelling all of the claims and presenting no substitute claim or claims. See § 711.01.

9. An amendment in a case no longer within the examiner's jurisdiction with certain exceptions in applications in issue, except on approval of the Commissioner. See § 714.16.

10. Amendments to the drawing held by the examiner to contain new matter are not entered until the question of new matter is settled. This practice of non-entry because of alleged new matter, however, does not apply in the case of amendments to the specification and claims.

11. An amendatory paper containing objectionable remarks that, in the opinion of the examiner, brings it within the condemnation of rule 3, will be submitted to the Commissioner with a view toward its being returned to applicant. See § 714.25.

12. Amendments not in permanent ink. Amendments on so-called "easily erasable paper." See § 714.07.

13. In an application filed before October 25, 1965, an amendment filed before the first action increasing the number of claims when the total of claims would be in excess of those supported by the filing fee. See § 714.10.

14. In an application filed on or after October 25, 1965, an amendment presenting claims (total and independent) in excess of the number previously paid for, and

(a) not accompanied by *any portion* of the fee required, or

(b) prior to the first Office action or not in response to an Office action, and not accompanied by the *full* fee required, or

(c) the authorization for a charge against a Deposit Account is not in the form of a separate paper (2 copies).

15. Examiners will not cancel claims on the basis of an amendment which argues for certain claims and, alternatively, purports to authorize their cancellation by the examiner if other claims are allowed, in re Willingham, 127 USPQ 211.

While amendments falling within any of the foregoing categories should not be entered by the examiner at the time of filing, a subsequent showing by applicant may lead to entry of the amendment.

714.20 List of Amendments Entered in Part [R–32]

To avoid confusion of the record the general rule prevails that an amendment should not be entered in part. As in the case of most other rules, the strict observance of its letter may sometimes work more harm than would result from its infraction, especially if the amendment in question is received at or near the end of the period for response. Thus,

(1) An "amendment" presenting an uncalled-for and unnecessary substitute specification along with amendatory matter, as amendments to claims or new claims, should be entered in part, rather than refused entry *in toto*. The substitute specification should be denied entry and so marked, while the rest of the paper should be entered. The case as thus amended is acted on when reached in its turn, the applicant being advised that the substitute specification has not been required and is not necessary and therefore has not been entered, and that any desired changes in the original specification must be made by specific amendments. See also rule 125, and § 608.01(q).

It may be noted in this connection, however, that the fact that a substitute specification, in the opinion of the examiner, contains new matter is not in itself a proper reason for refusing entry thereof.

(2) An amendment under rule 312, which in part is approved and in other part disapproved, is entered only as to the approved part. See § 714.16(e).

(3) In a case having some claims allowed and others finally rejected, where an amendment is received at or near the close of the period for response cancelling the finally rejected claims and presenting one or more new ones which the examiner cannot allow, the amendment, after the period for response has ended, is entered to the extent only of cancelling the finally rejected claims. Of course, if any of the new claims were, in the examiner's opin-

ion, patentable, they too would be entered. The applicant is notified that the new claims which are held unpatentable have not been admitted, and at the same time the case is passed for issue. This procedure applies only where there has been no appeal.

(4) Where all of the claims are under final rejection and the amendment cancels these claims and presents new ones, only some of which are deemed allowable by the examiner, the same practice is followed as indicated in (3), assuming no appeal has been taken.

(5) In a case having all claims allowed and some formal defect noted, where an amendment is presented at or near the close of the statutory period curing the defect and adding one or more claims some or all of which are in the opinion of the examiner not patentable, or will require a further search, the procedure indicated in (3) is followed. After the statutory period has ended, the amendment in such a case will be entered only as to the formal matter and to any of the newly presented claims that may be deemed patentable.

(6) In an amendment accompanying a motion granted only in part, the amendment is entered only to the extent that the motion was granted. See § 1108.

NOTE: The examiner writes "Enter" in ink and his initials in the left margin opposite the enterable portions. [R–22]

714.21 Amendments Inadvertently Entered, No Legal Effect [R–22]

If the clerk inadvertently enters an amendment when it should not have been entered, such entry is of no legal effect, and the same action is taken as if the changes had not been actually made, inasmuch as they have not been legally made. Unless such unauthorized entry is deleted, suitable notation should be made on the margin of the amendatory paper, as "Not Officially Entered".

If it is to be retained in the file an amendatory paper, even though not entered, should be given a paper number and listed on the file wrapper with the notation "Not Entered". See Rule 3 and § 714.25, for an instance of a paper which may be returned.

714.22 Entry of Amendments, Directions for [R–35]

Rule 121. Manner of making amendments. (a) Erasures, additions, insertions, or alterations of the Office file of papers and records must not be physically entered by the applicant. Amendments to the application (excluding the claims) are made by filing a paper (which should conform to rule 52), directing or requesting that specified amendments be made. The exact word or words to be stricken out or inserted by said amendment must be specified and the precise point indicated where the deletion or insertion is to be made.

(b) Except as otherwise provided herein, a particular claim may be amended only by directions to cancel or by rewriting such claim with underlining below the word or words added and brackets around the word or words deleted. The rewriting of a claim in this form will be construed as directing the cancellation of the original claim; however, the original claim number followed by the parenthetical word "amended" must be used for the rewritten claim. If a previously rewritten claim is rewritten, underlining and bracketing will be applied in reference to the previously rewritten claim with the parenthetical expression "twice amended," "three times amended," etc., following the original claim number.

(c) A particular claim may be amended in the manner indicated for the application in paragraph (a) of this rule to the extent of corrections in spelling, punctuation, and typographical errors. Additional amendments in this manner will be admitted provided the changes are limited to (1) deletions and/or (2) the addition of no more than five words in any one claim. Any amendment submitted with instructions to amend particular claims but failing to conform to the provisions of paragraphs (b) and (c) of this rule may be considered non-responsive and treated accordingly

(d) Where underlining or brackets are intended to appear in the printed patent or are properly part of the claimed material and not intended as symbolic of changes in the particular claim, amendment by rewriting in accordance with paragraph (b) of this rule shall be prohibited.

(e) In reissue applications, both the descriptive portion and the claims are to be amended as specified in paragraph (a) of this rule.

The term "brackets" set forth in rule 121 means angular brackets, thus: [ ]. It does not encompass and is to be distinguished from parentheses ( ). Any amendment using parentheses to indicate canceled matter in a claim rewritten under rule 121(b) may be held nonresponsive in accordance with rule 121(c).

Where, by amendment under rule 121(b), a dependent claim is rewritten to be in independent form, the subject matter from the prior independent claim should be considered to be "added" matter and should be underlined.

714.23 Entry of Amendments, Directions for, Defective [R–22]

The directions for the entry of an amendment may be defective, as, inaccuracy in the line designated, or lack of precision where the word to which the amendment is directed occurs more than once in the specified line. If it is clear from the context what is the correct

place of entry, the amendatory paper will be properly amended in the examining group, and notation thereof, initialed in ink by the examiner, who will assume full responsibility for the change, will be made on the margin of the amendatory paper. In the next Office action the applicant should be informed of this alteration in his amendatory paper and the entry of the amendment as thus amended. He will also be informed of the nonentry of an amendment where defective directions and context leave doubt as to the intent of applicant.

714.24 Amendment of Amendment [R–25]

Rule 124. Amendment of amendments. When an amendatory clause is to be amended, it should be wholly rewritten and the original insertion canceled, so that no interlineations or deletions shall appear in the clause as finally presented. Matter canceled by amendment can be reinstated only by a subsequent amendment presenting the canceled matter as a new insertion.

However, where a relatively small amendment to a previous amendment can be made easily without causing the amendatory matter to be obscure or difficult to follow, such small amendment should be entered.

714.25 Discourtesy of Applicant or Attorney [R–25]

Rule 3. Business to be conducted with decorum and courtesy. Applicants and their attorneys or agents are required to conduct their business with the Patent Office with decorum and courtesy. Papers presented in violation of this requirement will be submitted to the Commissioner and will be returned by his direct order. Complaints against examiners and other employees must be made in communications separate from other papers.

All papers received in the Patent Office should be briefly reviewed by the clerk, before entry, sufficiently to determine whether any discourteous remarks appear therein.

If the attorney is discourteous in the remarks or arguments in his amendment, either the discourtesy should be entirely ignored or the paper submitted to the group director with a view toward its being returned.

715 Swearing Back of Reference-Affidavit or Declaration Under Rule 131 [R–25]

Rule 131. Affidavit or declaration of prior invention to overcome cited patent or publication. (a) When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath or declaration as to facts showing a completion of the invention in this country before the filing date of the application on which the domestic patent issued, or before the date of the foreign patent, or before the date of the printed publication, then the patent or publication cited shall not bar the grant of a patent to the applicant, unless the date of such patent or printed publication be more than one year prior to the date on which the application was filed in this country.

(b) The showing of facts shall be such, in character and weight, as to establish reduction to practice prior to the effective date of the reference, or conception of the invention prior to the effective date of the reference coupled with due diligence from said date to a subsequent reduction to practice or to the filing of the application. Original exhibits of drawings or records, or photocopies thereof, must accompany and form part of the affidavit or declaration or their absence satisfactorily explained.

Any printed publication dated prior to an applicant's effective filing date, or any domestic patent of prior filing date, which is in its disclosure pertinent to the claimed invention, is available for use by the examiner as a reference, either basic or auxiliary, in the rejection of the claims of the application.

Such a rejection may be overcome, in certain instances noted below, by applicant's filing of an affidavit or declaration under rule 131, known as "swearing back" of the reference.

Affidavits or declarations under rule 131 may be used:

(1) Where the date of the foreign patent or that of the publication is less than one year prior to applicant's effective filing date.

(2) Where the reference, a U.S. Patent, with a patent date less than one year prior to applicant's effective filing date, shows but does not claim the invention.

An affidavit or declaration under rule 131 is not appropriate in the following situations:

(1) Where reference publication date is more than one year back of applicant's effective filing date. Such a reference is a "statutory bar".

(2) Where the reference U.S. patent claims the invention. See § 1101.02(a).

(3) Where reference is a foreign patent for the same invention to applicant or his legal representatives or assigns issued prior to the filing date of the domestic application on an

application filed more than twelve months prior to the filing date of the domestic application.

(4) Where the effective filing date of applicant's parent application or an International Convention proved filing date is prior to the effective date of the reference, affidavit or declaration under rule 131 is unnecessary because the reference is not used. See §§ 201.11 to 201.15.

(5) Where the reference is a prior U.S. patent to the same entity, claiming the same invention, the question involved is one of "double patenting."

(6) Where the reference is the disclosure of a prior U.S. patent to the same party, not copending, the question is one of dedication to the public.

Should it be established that the portion of the patent disclosure relied on as the reference was introduced into the patent application by amendment and as such was new matter, the date to be overcome by the affidavit or declaration is the date of the amendment. In re Willien et al., 1935 C.D. 229; 24 USPQ 210.

It should be kept in mind that it is the *rejection* that is withdrawn and not the reference.

715.01 Reference Claims Foreign Filing Date [R–22]

The effective date of a United States Patent for use as a prior art reference is not affected by the foreign filing date to which the patentee may be entitled under 35 U.S.C. 119. In re Hilmer, 833 O.G. 13, 149 USPQ 480 (CCPA 1966); Lily et al. v. Brenner, 153 USPQ 95 (C.A.D.C. 1967). The reference patent is effective as of the date the application for it was filed in the United States (35 U.S.C. 102(e) and 103). Hazeltine Research, Inc. et al. v. Brenner, 824 O.G. 8; 147 USPQ 429; 382 U.S. 252 (U.S. Supreme Court 1965).

715.01(a) Reference a Joint Patent to Applicant and Another [R–25]

When subject matter disclosed but not claimed in a patent issued jointly to S and another is claimed in a later application filed by S, the joint patent is a valid reference unless overcome by affidavit or declaration under rule 131. In re Strain, 1951 C.D. 252; 89 USPQ 156; 38 CCPA 933. Disclaimer by the other patentee should not be required. But see § 201.06.

715.01(b) Reference and Application Have Common Assignee [R–29]

The mere fact that the reference patent which shows but does not claim certain subject matter and the application which claims it are owned by the same assignee does not avoid the necessity of filing an affidavit or declaration under rule 131. The common assignee does not obtain any rights in this regard by virtue of common ownership which he would not have in the absence of common ownership. In re Beck et al., 1946 C.D. 398; 590 O.G. 357; Pierce v. Watson, 124 USPQ 356; In re Frilette and Weisz, 162 USPQ 163.

715.01(c) Reference Is Publication of Applicant's Own Invention [R–29]

Unless it is a statutory bar, a rejection on a publication may be overcome by a showing that it was published either by applicant himself or in his behalf, Ex parte Lemieux, 1957 C.D. 47; 725 O.G. 4; Ex parte Powell et al., 1938 C.D. 15; 489 O.G. 231.

When the unclaimed subject matter of a patent is applicant's own invention, a rejection on that patent may be removed by the patentee filing an affidavit establishing the fact that he derived his knowledge of the relevant subject matter from applicant. Moreover, applicant must further show that he himself made the invention upon which the relevant disclosure in the patent is based. In re Mathews, 161 USPQ 276; 56 CCPA 1033. In re Facius, 161 USPQ 294; 56 CCPA 1348. See also § 201.06.

Co-authorship

Where the applicant is one of the co-authors of a publication, cited against his application, he is not required to file an affidavit or declaration under rule 131. The publication may be removed as a reference by filing a disclaiming affidavit or declaration of the other authors. Ex parte Hirschler, 110 USPQ 384.

715.02 General Rule as to Generic Claims [R–22]

A reference applied against generic claims may (in most cases) be antedated as to such claims by an affidavit or declaration under rule 131 showing completion of the invention of only a single species, within the genus, prior to the effective date of the reference (assuming, of course, that the reference is not a statutory bar or a patent claiming the same invention). See, however, § 715.03 for practice relative to chemical cases.

715.03 Practice Relative to Chemical Cases [R–34]

In chemical cases, where generic claims have been rejected on a reference which discloses a species not antedated by the affidavit or declaration, the rejection will not ordinarily be withdrawn unless the applicant is able to establish that he was in possession of the generic invention prior to the effective date of the reference. In other words, the affidavit or declaration under rule 131 must show as much as the minimum disclosure required by a patent specification to furnish support for a generic claim.

"The principle is well established in chemical cases, and in cases involving compositions of matter, that the disclosure of a species in a cited reference is sufficient to prevent a later applicant from obtaining generic claim." In re Steenbock, 1936 C.D. 594; 473 O.G. 495.

Where the only pertinent disclosure in the reference is a single species, which species is antedated by the affidavit or declaration, the reference is overcome. In re Stempel, 1957 C.D. 200; 717 O.G. 886.

Markush Type Claim

Where a claim reciting a Markush group is rejected on a reference disclosing but not claiming a specific member of the group, the reference cannot be avoided by an affidavit or declaration under rule 131 showing different members of the group.

715.04 Who May Make Affidavit or Declaration [R–22]

A. The Inventor.

B. One of two joint inventors is accepted where suitable excuse is given for failure of the other applicant to sign. In re Carlson et al, 1936 C.D. 95; 462 O.G. 479.

C. The Assignee or other party in interest when it is not possible to produce the affidavit or declaration of the inventor. Ex parte Foster, 1903 C.D. 213; 105 O.G. 261.

715.05 Patent Claiming Same Invention [R–29]

When the reference in question is a non-commonly owned patent claiming the same in-

vention as applicant and its issue date is less than one year prior to the filing date of the application being examined, applicant's remedy, if any, must be by way of rule 204 instead of rule 131. The examiner should therefore take note whether the status of the patent as a reference is that of a PATENT or a PUBLICATION. If the patent is claiming the same invention as the application, this fact should be noted in the Office action. The reference patent can then be overcome only by way of interference. Note, however, 35 U.S.C. 135, § 1101.02 (f).

715.07 Facts and Documentary Evidence [R–22]

The essential thing to be shown under rule 131 is priority of invention and this may be done by any satisfactory evidence of the fact. *FACTS*, not conclusions, must be alleged, and they must be shown by evidence in the form of exhibits accompanying the affidavit or declaration. Each exhibit relied upon should be specifically referred to in the affidavit or declaration, in terms of what it is relied upon to show. For example, the allegations of fact might be supported by submitting as evidence one or more of the following:

(1) attached sketches;
(2) attached blueprints;
(3) attached photographs;
(4) attached reproductions of notebook entries;
(5) an accompanying model;
(6) attached supporting statements by witnesses, where verbal disclosures are the evidence relied upon.

If the dates of the exhibits have been removed or blocked off, the matter of dates can be taken care of in the body of the oath or declaration.

The dates in the oath or declaration may be the actual dates or, if the applicant does not desire to disclose his actual dates, he may merely allege that the acts referred to occurred prior to a specified date.

A general allegation that the invention was completed prior to the date of the reference is not sufficient. Ex parte Saunders, 1883 C.D. 23; 23 O.G. 1224.

"If the applicant made sketches he should so state, and produce and describe them; if the sketches were made and lost, and their contents remembered, they should be reproduced and furnished in place of the originals. The same course should be pursued if the disclosure was by means of models. If neither sketches nor models are relied upon, but it is claimed that verbal disclosures, sufficiently clear to indicate definite conception of the invention, were made the witness should state as nearly as possible the language used in imparting knowledge of the invention to others." *Ex parte* Donovan, 1890 C.D. 109; 52 O.G. 309.

The affidavit or declaration must state FACTS and produce such documentary evidence and exhibits in support thereof as are available to show conception and completion of invention IN THIS COUNTRY, at least the conception being at a date prior to the effective date of the reference. Where there has not been reduction to practice prior to the date of the reference, the applicant must also show diligence in the completion of his invention from a time just prior to the date of the reference continuously up to the date of an actual reduction to practice or up to the date of filing his application (filing constitutes a *constructive* reduction to practice, rule 131).

A conception of an invention, though evidenced by disclosure, drawings, and even a model, is not a complete invention under the patent laws, and confers no rights on an inventor, and has no effect on a subsequently granted patent to another, UNLESS HE FOLLOWS IT WITH REASONABLE DILIGENCE BY SOME OTHER ACT, such as an actual reduction to practice or filing an application for a patent. Automatic Weighing Mach. Co. v. Pneumatic Scale Corp., Limited, 1909 C.D. 498; 139 O.G. 991.

Conception is the mental part of the inventive act, but it must be capable of proof, as by drawings, complete disclosure to another person, etc. In Mergenthaler v. Scudder, 1897 C.D. 724; 81 O.G. 1417, it was established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also.

The facts to be established under rule 131 are similar to those to be proved in interference. The difference lies in the way in which the evidence is presented. If applicant disagrees with a holding that the facts are insufficient to overcome the rejection, his remedy is by appeal from the continued rejection.

Disclosure Documents (§ 1706) may be used as documentary evidence.

715.07(a) Diligence [R–22]

Where conception occurs prior to the date of the reference, but reduction to practice is afterward it is not enough merely to allege that applicant had been diligent. Ex parte Hunter, 1889 C.D. 218; 49 O.G. 733.

What is meant by diligence is brought out in Christie v. Seybold, 1893 C.D. 515; 64 O.G.

1650. In patent law, an inventor is either diligent at a given time or he is not diligent; there are no degrees of diligence. A man may be diligent within the meaning of the patent law when he is doing nothing, if his lack of activity is excused.

Note, however, that only diligence *before* reduction to practice is a material consideration. The "lapse of time between the completion or reduction to practice of an invention and the filing of an application thereon" (Ex parte Merz, 75 USPQ 296) is not relevant to a rule 131 affidavit or declaration.

715.07(b) Interference Testimony Sometimes Used [R–25]

In place of an affidavit or declaration the testimony of the applicant in an interference may be sometimes used to antedate a reference in lieu of a rule 131 affidavit or declaration.

The part of the testimony to form the basis of priority over the reference should be pointed out. Ex parte Bowyer, 1939 C.D. 5; 42 USPQ 526.

715.07(c) Acts Relied Upon Must Have Been Carried Out in This Country [R–44]

The affidavit or declaration must contain an allegation that the acts relied upon to establish the date prior to the reference were carried out *in this country*. See 35 U.S.C. 104.

35 U.S.C. § 104. Invention made abroad. In proceedings in the Patent and Trademark Office and in the courts, an applicant for a patent, or a patentee, may not establish a date of invention by reference to knowledge or use thereof, or other activity with respect thereto, in a foreign country, except as provided in section 119 of this title. Where an invention was made by a person, civil or military, while domiciled in the United States and serving in a foreign country in connection with operations by or on behalf of the United States, he shall be entitled to the same rights of priority with respect to such invention as if the same had been made in the United States.

715.07(d) Disposition of Exhibits [R–34]

Exhibits, such as those filed as part of an affidavit or declaration under rule 131, that are too bulky to be placed in the application file are retained in the examining group until the case is finally disposed of. When the case goes to issue (or abandonment) the exhibits are sent to the Supply and Receiving Section, notation to this effect being made on the margin of the affidavit or declaration. See § 608.03(a).

715.08 Passed Upon by Primary Examiner [R–44]

The question of sufficiency of affidavits or declarations under rule 131 should be reviewed and decided by a primary examiner.

Review of questions of formal sufficiency and propriety are by petition to the Commissioner. Such petitions are answered by the group directors. (§ 1002.02(c), item 4(e))

Review on the merits of a rule 131 affidavit or declaration is to the Board of Appeals.

715.09 Seasonable Presentation [R–25]

Affidavits or declarations under rule 131 must be timely presented in order to be admitted. Affidavits and declarations submitted prior to a final rejection are considered timely.

An affidavit or declaration presented with a first response after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection is entered and considered without a showing under rule 116(b). No other affidavit or declaration under rule 131 presented after final rejection will be considered unless a satisfactory showing is made under rule 116(b) or 195.

All admitted affidavits and declarations are acknowledged and commented upon by the examiner in his next succeeding action.

For affidavits or declarations under rule 131 filed after appeal see rule 195 and § 1212.

716 Affidavits or Declarations Traversing Rejections, Rule 132 [R–25]

Rule 132. Affidavits or declarations traversing grounds of rejection. When any claim of an application is rejected on reference to a domestic patent which substantially shows or describes but does not claim the invention, or on reference to a foreign patent, or to a printed publication, or to facts within the personal knowledge of an employee of the Office, or when rejected upon a mode or capability of operation attributed to a reference, or because the alleged invention is held to be inoperative or lacking in utility, or frivolous or injurious to public health or morals, affidavits or declarations traversing these references or objections may be received.

NOTE THAT RULE 132 IS NOT APPLICABLE TO A REJECTION BASED ON A U.S. PATENT WHICH CLAIMS THE REJECTED INVENTION.

It is the responsibility of the primary examiner to personally review and decide whether affidavits or declarations submitted under rule 132 for the purpose of traversing grounds of

rejection, are responsive to the rejection and present sufficient facts to overcome the rejection.

This rule sets forth the general policy of the Office consistently followed for a long period of time of receiving affidavit evidence traversing rejections or objections, Ex parte Grosselin, 1896 C.D. 39; 76 O.G. 1573. The enumeration of rejections in the rule is merely exemplary. All affidavits or declarations presented which do not fall within or under other specific rules are to be treated or considered as falling under this rule.

Affidavits or declarations under rule 132 must be timely presented in order to be admitted. Affidavits and declarations submitted prior to a final rejection are considered timely.

An affidavit or declaration presented with a first response after final rejection for the purpose of overcoming a new ground of rejection or requirement made in the final rejection is entered and considered without a showing under rule 116(b). No other affidavit or declaration under rule 132 presented after final rejection will be considered unless a satisfactory showing is made under rule 116(b) or 195.

All admitted affidavits and declarations are acknowledged and commented upon by the examiner in his next succeeding action.

The following criteria are applicable to all affidavits or declarations submitted under rule 132:

(1) Affidavits or declarations must be timely or seasonably filed to be entitled to consideration. In re Rothermel et al., 1960 C.D. 204; 125 USPQ 328. Affidavits or declarations not timely filed must meet the requirements of rule 195.

(2) Affidavits or declarations must set forth facts, not merely conclusions. In re Pike et al., 1950 C.D. 105; 84 USPQ 235. The facts presented in the affidavits or declarations must be pertinent to the rejection. In re Renstrom, 1949 C.D. 306; 81 USPQ 390. Otherwise, the affidavits or declarations have no probative value.

(3) Affidavits or declarations should be scrutinized closely and the facts presented weighed with care. The affiant's or declarant's interest is a factor which may be considered, but the affidavit or declaration cannot be disregarded solely for that reason. In re McKenna et al., 1953 C.D. 251; 97 USPQ 348; 203 F.2d 717; Bullard & Co. v. Coe, 1945 C.D. 13; 64 USPQ 359; 147 F.2d 568.

Rule 132 affidavits or declarations may be classified in five groups, and such affidavits or declarations must conform, in addition, to the established criteria and standards for the group into which they fall. These groups and the applicable standards are:

1. Comparative Tests or Results

Affidavits or declarations comparing applicant's results with those of the prior art must relate to the reference relied upon and not other prior art—Blanchard v. Ooms, 1946 C.D. 22; 68 USPQ 314; 153 F.2d 651, and the comparison must be with disclosure identical (not similar) with that of the reference. In re Tatincloux, 1956 C.D. 102; 108 USPQ 125; 43 CCPA 722. Otherwise, the affidavits or declarations have no probative value.

Where the comparison is not identical with the reference disclosure, deviations therefrom should be explained—in re Finley, 1949 C.D. 284; 81 USPQ 383; 36 CCPA 999 and if not explained should be noted and evaluated, and if significant, explanation should be required. In re Armstrong, 1960 C.D. 422; 126 USPQ 281; 47 CCPA 1084. Otherwise, the affidavits or declarations may be entitled to little weight.

Where the comparison shows unexpected results or advantages, it should be compared with the application disclosure, since recitals of the specification are controlling. Abbott v. Coe, 1940 C.D. 13; 109 F.2d 449. In re Rossi, 1957 C.D. 130; 112 USPQ 479; 44 CCPA 750. Advantages not disclosed carry little or no weight in establishing patentability.

Affidavits or declarations setting forth advantages and asserting that despite familiarity with the art, the claimed subject matter was not obvious to affiants or declarants, do not afford evidence of non-obviousness, where the advantages relied upon are merely those which would result from following the teaching of the prior art. In re Henrich, 1959 C.D. 353; 122 USPQ 388; 46 CCPA 933.

2. Operability of Applicant's Disclosure

Since it is the examiner's duty to pass upon the operativeness of any invention which he is called upon to examine he is free to express his opinion on that question so long as he gives reasons for his holding with clarity and completeness. Therefore, he need not support every rejection on inoperativeness with references, affidavits or declarations. In re Quattlebaum, 84 USPQ 383.

Affidavits or declarations attempting to show that the structure deemed inoperative was seen in operation by persons who vouch for its operability, are insufficient. In re Perrigo, 1931 C.D. 512, 48 F.2d 965.

Where the invention involved is of such a nature that it cannot be tested by known scientific principles, theoretical arguments in affidavit or declaration form are unacceptable, and the only satisfactory manner of overcoming the rejection is to demonstrate the operability

by construction and operation of the invention. Buck v. Ooms, 1947 C.D. 33; 72 USPQ 211; 159 F.2d 462. In re Chilowsky, 1956 C.D. 155; 108 USPQ 321; 43 CCPA 775.

3. Inoperability of References

Since every patent is presumed valid (35 U.S.C. 282), and since that presumption includes the presumption of operability—Metropolitan Eng. Co. v. Coe, 1935 C.D. 54; 78 F.2d 199. Examiners should not express any opinion on the operability of a patent. Therefore affidavits or declarations attacking the operability of a patent cited as a reference, though entitled to consideration, should be treated, not as conclusive of the factual matter presented, but

rather as an expression of opinion by an expert in the art. In re Berry, 137 USPQ 353; 50 CCPA 1196. See also In re Lurelle Guild, 1953 C.D. 310; 98 USPQ 68. Opinion affidavits or declarations need not be given any weight. In re Pierce, 1930 C.D. 34; 35 F.2d 781; In re Reid, 1950 C.D. 194; 84 USPQ 478.

Further, since in a patent it is presumed that a process if used by one skilled in the art will produce the product or result described therein, such presumption is not overcome by a mere showing that it is possible to operate within the disclosure without obtaining the alleged product. It is to be presumed also that skilled workers would as a matter of course, if they do not immediately obtain desired results, make certain experiments and adaptations, within the skill of the competent worker. The failures of experimenters who have no interest in succeeding should not be accorded great weight. Bullard v. Coe, 1945 C.D. 13; 64 USPQ 359: In re Michalek, 1947 C.D. 458; 74 USPQ 107; 34 CCPA 1124: In re Reid, 1950 C.D. 194; 84 USPQ 478; 37 CCPA 884.

Where the affidavit or declaration presented asserts inoperability in some features of the patent as to which it was not relied upon, the matter is of no concern. In re Wagner, 1939 C.D. 581; 26 CCPA 1193; 103 F.2d 414.

Where the affidavit or declaration asserts inoperability of the process disclosed in the reference for producing the claimed product, which product is fully disclosed in the reference, the matter is of no concern. In re Attwood, 1958 C.D. 204; 117 USPQ 184; 45 CCPA 824.

Where the affidavit or declaration presented asserts that the reference relied upon is inoperative, it is elementary that the claims presented by applicant must distinguish from the alleged inoperative reference disclosure; therefore the matter is of no concern. In re Crecelius, 1937 C.D. 112; 24 CCPA 718; 86 F.2d 399: In re Perrine, 1940 C.D. 465; 27 CCPA 1127; 111 F.2d 177: In re Crosby, 1947 C.D. 35; 71 USPQ 73; 34 CCPA 701.

Affidavit or declaration by patentee that he did not intend his device to be used as claimed by applicant is immaterial. In re Pio, 1955 C.D. 59; 104 USPQ 177; 42 CCPA 746.

4. Commercial Success

Affidavits or declarations submitting evidence of commercial success can have no bearing in a case where the patentability over the prior art is not in doubt. In re Jewett et al, 1957 C.D. 420; 115 USPQ 134; 247 F.2d 953: In re Troutman, 1960 C.D. 308; 126 USPQ 56; 47 CCPA 308.

Affidavits or declarations showing commercial success of a structure not related to the claimed subject matter has neither significance nor pertinence. In re Kulieke, 1960 C.D. 281; 125 USPQ 578; 47 CCPA 943.

Affidavits or declarations attribute commercial success to the invention "described and claimed" or other equivalent indefinite language have little or no evidenciary value. In re Troutman, 1960 C.D. 308; 126 USPQ 56; 47 CCPA 308.

Where affidavits or declarations show commercial success it must appear that such success resulted from the invention as claimed. In re Hollingsworth, 1958 C.D. 210; 117 USPQ 182; 45 CCPA 830. Otherwise the affidavit or declaration showing is non-pertinent.

5. Sufficiency of Disclosure

Affidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. In re Smyth, 1951 C.D. 449; 90 USPQ 106; 38 CCPA 1130.

Affidavits or declarations purporting to explain the disclosure or to interpret the disclosure of a pending application are usually not considered. In re Oppenauer, 1944 C.D. 587; 62 USPQ 297; 31 CCPA 1248.

717 File Wrapper

717.01 Papers in File Wrapper [R–22]

Full details for processing file wrapper papers are given in the Manual of Clerical Procedures. Papers that do not become a permanent part of the record should not be entered on the "Contents" of the file wrapper. No paper legally entered on the "Contents" should ever be withdrawn or returned to applicant without special authority of the Commissioner. Certain oaths executed abroad are returned but a copy is retained in the file. See § 604.04(a).

717.01(a) Arrangement of Papers in File Wrapper [R–40]

Until revision for allowance, the specification, amendments and all other communications from applicant are fastened to the left side (center fold) of the file wrapper. They are in inverse chronological order; that is, the communication with the latest "Mail Room" date is on top. A similar arrangement is followed on the right side, where Office actions and other communications from the Office are fastened, except that the print is always kept on top for the convenience of the examiner.

Where amendments are submitted in duplicate, the carbon copy is destroyed except where the duplicate is received within the time period for response and the original is late. In this latter situation both copies are placed in the file. The "original" (ribbon copy) is entered with reference made to the carbon copy.

At allowance, only those papers required by the printer are placed in the left side (center section) of the file wrapper.

The use of return self-addressed post cards as a receipt is covered in § 503.

717.01(b) Prints [R–40]

The prints of the drawing are fastened inside the file wrapper by the Customer Services Division. A paper number is assigned by the clerk of the group.

The white paper prints shall always be kept on top of the papers on the right of the file wrapper.

All prints and inked sketches subsequently filed to be part of the record should be endorsed with the date of their receipt in the office and given their appropriate paper number. Note § 608.02(m).

717.02 Data Entered on File Wrapper [R–37]

See also §§ 707.10, 717.01.

If the examiner notices an error in any of the data originally entered on the file wrapper, he should have it corrected by the Application Division.

If an error is noticed in the name or address of the assignee, it should be corrected by the Assignment Division.

All of the above entries are either typed or made in black ink. Such changes by amendment as change of address or of attorney are entered in red ink by the clerk of the group, the original entry being canceled but not erased.

717.02(b) Name or Residence of Inventor or Title Changed [R–37]

The distinction between "residence" and Post Office address should not be lost sight of.

Section 605.04(c) explains the procedure to be followed concerning sending the application to the Assignment Division and the Application Division when applicant changes name.

Unless specifically requested by applicant, the residence will not be changed on the file. For example, if a new oath gives a different residence from the original, the file will not be changed.

717.03 Classification During Examination [R–40]

When a new case is received in an examining group, the classification of the case and the initials or name of the examiner who will examine it or other assigned docket designation are noted in pencil in the upper lefthand corner of the first sheet of the "heavy paper" (pink or buff) print and in the designated spaces on the file wrapper. These notations should be kept current.

717.04 Index of Claims [R–42]

Constant reference is made to the "Index of Claims" found in the inside of the file wrapper of all applications. It should be kept up to date so as to be a reliable index of all claims standing in a case, and of the amendment in which the claims are to be found.

The preprinted series of claim numbers appearing on the file wrapper refer to the claim numbers as originally filed while the adjacent column should be used for the entry of the final numbering of the allowed claims.

Independent claims should be designated in the Index of Claims by encircling the claim number in red ink.

A line in red ink should be drawn below the number corresponding to the number of claims originally presented. Thereafter, a line in red ink should be drawn below the number corresponding to the highest numbered claim added by each amendment. Just outside the Index of Claims form opposite the number corresponding to the first claim of each amendment there should be placed the letter designating the amendment.

If the claims are amended in rewritten form under rule 121(b), the original claim number should not be stricken from the Index of Claims but a notation should be made in red ink in the margin to the left of the original claim number, i.e. "Amend. 1"; if the claim is rewritten a second time, "Amend. 1" should be changed by striking out "1" and inserting "2" above it.

As any claim is canceled a line in red ink should be drawn through its number.

A space is provided for completion by the examiner to indicate the date and type of each Office action together with the resulting status of each claim. A list of codes for identifying each type of Office action appears below the Index. At the time of allowance, the examiner places the final patent claim numbers in the column marked "Final".

717.05 Field of Search [R–18]

In each action involving a search, the examiner shall endorse, on the flap of the file wrapper, the classes and subclasses and publications searched, the date when the search was made or was brought up to date and the examiner's initials, all entries being in BLACK INK. Great care should be taken, inasmuch as this record is important to the history of the application.

717.06 Foreign Filing Dates [R–38]

See §§ 201.14(c), 202.03 and 201.14(d).

717.07 Related Applications [R–38]

The file wrapper should identify earlier filed related applications. See §§ 202.02 and 202.03.

720 Public Use Proceedings [R–42]

Rule 292. Public use proceedings. (a) When a petition for the institution of public use proceedings, supported by affidavits or declarations, is filed by one having information of the pendency of an application and is found, on reference to the primary examiner, to make a prima facie showing that the invention involved in an interference or claimed in an application believed to be on file had been in public use or on sale one year before the filing of the application, or before the date alleged by an interfering party in his preliminary statement or the date of invention established by such party, a hearing may be had before the Commissioner to determine whether a public use proceeding should be instituted. If instituted, times may be set for taking testimony, which shall be taken as provided by rules 271 to 286. The petitioner will be heard in the proceedings but after decision therein will not be heard further in the prosecution of the application for patent.

(b) The petition and accompanying papers should be filed in duplicate, or served upon the applicant, his attorney or agent of record, and petitioner should offer to bear any expense to which the Office may be put in connection with the proceeding.

Public use proceedings are provided for in Rule 292. The institution of public use proceedings is discretionary with the Commissioner. This section is intended to provide guidance when a question concerning public use proceedings arises.

A petition is required to initiate consideration of whether to institute a public use proceeding. The petitioner ordinarily has information concerning a pending application which claims subject matter that the petitioner alleges was in "public use" or "on sale" in this country more than one year prior to the effective United States filing date of the pending application (see 35 U.S.C., Section 119, 1st paragraph, and Section 120). He thus asserts that a statutory bar (35 U.S.C. 102(b)) exists which prohibits the patenting of the subject matter of the application.

There are two types of public use proceedings: *ex parte* and *inter partes*. It is important to understand the difference. In the *ex parte* situation, the petitioner is not entitled, as a matter of right, to inspect the pending application. Thus, he stands in no better position than any other member of the public regarding access to the pending application. In the *inter partes* situation, the petitioner is involved in an interference with the pending application, and now wishes to assert that the claims of the pending application (often the counts of the interfer-

ence) are barred by public use or sale. In the *inter partes* situation, the petitioner is privy to the contents of the pending application (Rule 226). Thus, as pointed out below, the petitioner in the *inter partes* situation participates in the public use proceedings to a greater degree than in the *ex parte* situation. A petitioner who was once involved in a terminated interference with a pending application is no longer privy to the application contents and will accordingly be treated as an *ex parte* petitioner.

720.01 Preliminary Handling [R–42]

A petition filed under rule 292 should be forwarded to the Solicitor's Office, and served in accordance with rule 292(b). In addition, all other papers filed relating to the petition or subsequent public use proceeding must be served in accordance with rules 247 and 248. A member of the Solicitor's staff will ascertain whether the formal requirements of rule 292 have been fulfilled. In particular, the petition will be reviewed to see if the alleged use or sale occurred more than one year before the effective filing date of the application, whether the petition contains affidavits and exhibits to establish the facts alleged, whether there is an offer to bear expenses, whether there is an offer to produce witnesses having knowledge of the public use or sale, and whether the papers have been filed in duplicate, or one copy has been served on applicant. The application file is ordered and its status ascertained so that appropriate action may be taken. Where the application is involved in an interference, the interference proceedings will not normally be suspended if the proceeding has entered the testimony period. Whether the interference proceeding is suspended for institution of the public use proceeding is normally determined by the patent interference examiner.

In those *ex parte* situations where a petitioner cannot identify the pending application by serial number, the petition papers will be forwarded to the appropriate group director for an identification search. Once the application file(s) is located, it should be forwarded to the Solicitor's Office.

720.02 Examiner Determination of Prima Facie Showing [R–42]

Once the Solicitor's staff member has determined that the petition meets the formal requirements of rule 292, and the application's status warrants consideration of the petition, he will prepare a letter for the Assistant Commissioner for Patents, forwarding the petition and the application file to the examiner for determination of whether a *prima facie* case of public use or sale of claimed subject matter is established by the petition, regardless of whether a related interference is suspended. Any other papers that have been filed by the parties involved, such as a reply by the applicant or additional submissions by the petitioner, will also be forwarded to the examiner. Whether additional papers are accepted is within the discretion of the Solicitor's staff member. However, protracted paper filing is discouraged since the parties should endeavor to present their best case as to the *prima facie* showing at the earliest possible time. No oral hearings or interviews will be granted at this stage, and the examiner is cautioned not to answer any inquiries by the petitioner or applicant.

A *prima facie* case is established by the petition if the examiner finds that the facts asserted in the affidavit(s), as supported by the exhibits, if later proved true by testimony taken in the public use proceeding, would result in a statutory bar to the claims under 35 U.S.C. 102(b).

To make this determination, the examiner must identify exactly *what* was in public use or on sale, whether it was in use or on sale more than one year before the effective filing date, and whether the pending claims "read" on what has been shown to be in public use or on sale. On this last point, the examiner should compare all pending claims with the matter alleged to have been in use or on sale, not just the claims identified by petitioner. While the public use bar arises under 35 U.S.C. 102(b), the examiner should also consider the evidence for possible later use in a 35 U.S.C. 103 rejection based on obviousness of the claimed invention in light of what has been established to be in public use or on sale.

After having made his determination, the examiner will forward a memorandum to the Assistant Commissioner for Patents, stating his findings and his decision as to whether a *prima facie* case has been established. His findings should include a summary of the alleged facts, a comparison of at least one claim with the device alleged to be in public use or sale, and any other pertinent facts which will aid the Assistant Commissioner in conducting the preliminary hearing. The report should be prepared in triplicate and addressed to the Assistant Commissioner for Patents.

720.03 Preliminary Hearing [R–42]

Where the examiner concludes that a *prima facie* showing has not been established, both the petitioner and the applicant are so notified and the application proceedings are resumed without giving the parties an opportunity to be heard on the correctness of the examiner's deci-

sion. Where the examiner concludes that a *prima facie* case has been established, the Commissioner may hold a preliminary hearing. In such case, the parties will be notified by letter of the examiner's conclusion and of the time and date of the hearing. In an *inter partes* case the hearing will not normally be set until after suspension of the interference. The patent interference examiner will notify the Office of the Solicitor when the interference is suspended. While not so specifically captioned, the notification of this hearing amounts to an order to show cause why a public use proceeding should not be held. No new evidence is to be introduced or discussed at this hearing. The format of the hearing is established by the member of the Solicitor's staff, and the Assistant Commissioner for Patents presides. The examiner may attend as an observer only.

Where the hearing is held in the *ex parte* situation, great care will be taken to avoid discussion of any matters of the application file which are not already of knowledge to petitioner. Of course, applicant may of his own action or consent notify the petitioner of the nature of his claims or other related matters.

After the hearing is concluded, the Assistant Commissioner for Patents will decide whether public use proceedings are to be initiated, and he will send appropriate notice to the parties.

720.04 Public Use Proceeding Testimony [R–42]

When the Assistant Commissioner for Patents decides to institute public use proceedings, the case is referred to the examiner who will conduct all further proceedings. The fact that the affidavits and exhibits presented with the petition for institution of the public use proceedings have been held to make out a *prima facie* case does not mean that the statutory bar has been conclusively established. The statutory bar can only be established by testimony taken in accordance with normal rules of evidence, including the right of cross-examination. The affidvits are not to be considered part of the testimony and in no case can they be used as evidence on behalf of the party submitting them.

The procedure for taking testimony in a public use proceeding is substantially the same as that for taking testimony in an interference. Normally, no representative of the Commissioner need be present at the taking of the testimony.

The examiner will set a schedule of times for taking testimony and for filing the record and briefs on the basis of the following:

Petitioner's testimony to close—60 days;

Rebuttal testimony by applicant to close—30 days later;

An original and one copy of the Record to be filed—30 days later;

Petitioner's brief to be filed—30 days later; and

Applicant's brief to be filed—20 days later. Upon proper showing, the examiner may grant appropriate extensions of time.

After all testimony has been filed, and briefs have been filed, or the time for filing applicant's brief has expired and he has not filed a brief, a time will be set for an oral hearing to be conducted by the examiner in *inter partes* cases. In *ex parte* cases, an oral hearing is ordinarily not held. In *inter partes* cases the hearing will be conducted substantially in accordance with rule 256 except that oral argument will ordinarily be limited to one-half hour per side. Arguments are to be restricted to the evidence adduced and the related law. No new evidence will be accepted.

720.05 Final Decision [R–42]

The final decision of the examiner should be "analogous to that rendered by the * * * [Board of Patent Interferences] in an interference proceeding, analyzing the testimony and stating * * * conclusions * * *", *In re Townsend*, 1913 C.D. 55. In reaching his decision, the examiner is not bound by the prior finding that a *prima facie* case has been established.

If the examiner concludes that a public use or sale bar exists, he will enter a rejection to that effect in the application file, predicating that rejection on the evidence considered and the findings and decision reached in the public use proceeding. Where the application is involved in a suspended interference and the examiner's conclusion applies to one or more of the claims corresponding to the counts of the interference, the examiner must dissolve the interference under rule 237 as to those counts on the basis of the public use or sale. The twenty-day period for arguments, referred to in rule 237, is not applicable where the dissolution is based on the finding of public use, inasmuch as full consideration has already been given to the issue. Where the examiner concludes that there is no public use, or where the public use proceeding has been conducted concurrently with the interference proceeding, the examiner will address a memorandum to the patent interference examiner, notifying him of his decision in the public use proceeding. The interference will continue or be terminated in accordance with the action taken by the examiner. The examiner will enter the appropriate rejection after the application is returned to an *ex parte* status.

There is no review from the final decision of the examiner in the public use proceedings. A petition under rule 181, requesting that the Commissioner exercise his supervisory authority and vacate the examiner's decision, will not be entertained except where there is a showing of clear error. See *Ex Parte Hartley*, 1908 C.D. 224. Once the application returns to its *ex parte* status, appellate review under 35 U.S.C. 134 and 141–145 may be had of any adverse decision rejecting claim(s), as a result of the examiner's decision as to public use or sale.

721 Fraud on the Patent and Trademark Office [R–43]

37 CFR 1.56. *Improper applications.* Any application signed or sworn to in blank, or without actual inspection by the applicant, and any application altered or partly filled in after being signed or sworn to, and also any application fraudulently filed or in connection with which any fraud is practiced or attempted on the Patent and Trademark Office, may be stricken from the files.

This section deals with the manner in which an application, having a question of "fraud" appearing therein, is to be examined.

General

The following language has been extracted from the CCPA decision of Norton v. Curtiss, 167 USPQ 532 (1970), because it reflects the theme of the recent court decisions and writings on the matter of fraud and inequitable conduct in patent prosecution.

> "The * * * term 'fraud' in Rule 56 * * * refers to the very same types of conduct which the courts, in patent infringement suits, would hold fraudulent * * *. (T)raditionally, the concept of 'fraud' has most often been used by the courts, in general, to refer to a type of conduct so reprehensible that it could alone form the basis of an actionable wrong (e.g., the common law action for deceit). That narrow range of conduct, now frequently referred to as 'technical' or 'affirmative' fraud, is looked upon by the law as quite serious. Because severe penalties are usually meted out to the party found guilty of such conduct, technical fraud is generally held *not* to exist unless the following indispensable elements are found to be present: (1) a representation of a material fact, (2) the falsity of that representation, (3) the intent to deceive or, at least, a state of mind so reckless as to the consequences that it is held to be the equivalent of intent (scienter), (4) a justifiable reliance upon the misrepresentation by the party deceived which induces him to act thereon, and (5) injury to the party deceived as a result of his reliance on the misrepresentation * * *.
>
> "But the term 'fraud' is also commonly used to define that conduct which may be raised as a defense in an action at equity for enforcement of a specific obligation. In this context, it is evident that the concept takes on a whole new scope. Conduct constituting what has been called earlier 'technical fraud' will, of course, always be recognized as a defense. However, in these situations, failure, for one reason or another, to satisfy all the elements of the technical offense often will not necessarily result in a holding of 'no fraud'. Rather the courts appear to look at the equities of the particular case and determine whether the conduct before them—which might have been admittedly less than fraudulent in the technical sense—was still so reprehensible as to justify the court's refusing to enforce the rights of the party guilty of such conduct. It might be said that in such instances the concept of fraud becomes intermingled with the equitable doctrine of 'unclean hands'. A court might still evaluate the evidence in light of the traditional elements of technical fraud, but will now include a broader range of conduct within each of those elements, giving consideration to the equities involved in the particular case.
>
> "In suits for patent infringement, unenforceability, as well as noninfringement or invalidity under the patent laws, is a statutory defense. See 35 U.S.C. 282(1). * * * (U)nenforceability due to fraudulent procurement is a rather common defense. In such circumstance, * * * the courts are generally applying equitable principles in evaluating the charges of misconduct alleged to be fraudulent. Thus, in suits involving patents, today, the concept of 'fraud' on the Patent Office (at least where a patentee's conduct pertaining to the relative merits of his invention is concerned), encompasses not only that which * * * (has been earlier) termed 'technical' fraud, but also a wider range of 'inequitable' conduct found to justify holding a patent unenforceable. The courts differ as to the conduct they will recognize as being sufficiently reprehensible so as to carry with it the consequences of technical fraud."

As might be expected, the courts have had considerable difficulty in evaluating the conduct of applicants before the Office to ascertain whether their dealings were such as to constitute fraud or inequitable conduct. Most often, the question reduces itself to whether the applicant failed to disclose to the Office either facts or prior art known to the applicant, but not known to the examiner. The fact that such a duty-to-disclose exists has been emphasized in two Supreme Court Decisions: *Precision Instrument Mfg. Co.* v. *Automotive Maintenance Machine Co.*, 65 U.S.P.Q. 133 (1945) and *Kingsland* v. *Dorsey*, 83 U.S.P.Q. 330 (1949).

However, it is difficult to state presently with clarity exactly what prior art or facts the patent

applicants, and their attorneys or agents must call to the attention of the Office. Moreover, it is difficult to enumerate the various types of circumstances which should be recognized by the examiner as raising a question of fraud in a pending application for the purpose of examining the application in the manner set forth below. Prior applications which have been called to the attention of the Office reveal that a question of fraud is most likely to appear in one of the following situations:

A. *Reissue application.* The majority of "fraud" questions arise in reissue applications where the patent is involved in litigation. The reissue application may, or may not, contain changes to the specification, drawings or claims of the patent. Frequently, the reissue application will be filed merely to bring to the attention of the Office, prior art which was not considered during the examination of the parent application. The decision of the Court of Customs and Patent Appeals in *In re Wittry*, 180 USPQ 320, decided January 10, 1974, indicates that the statutes afford no authority for reissue where there has been a failure to assert a difference in scope between the original and reissue claims or where there has been an inclusion of new reissue claims of the same scope as those already granted.

B. *Protests to the grant of a patent.* Another instance in which the issue of "fraud" may be raised is through a protest under 37 CFR 1.291. The protester may be a party to litigation involving a patent and thereby has obtained knowledge of a pending reissue application, or simply a third party who has obtained a knowledge of a pending application and has submitted facts which he thinks would make the grant of a patent improper.

721.01 Examination of Patent Applications Having an Issue of Fraud [R–43]

In the event that a question of "fraud" is present in an application, the application should be examined in accordance with the following guidelines:

1. *Forwarding to the Assistant Commissioner for Patents.*

Any application in which, or in relation to which, some facts or representations are made bearing on the question of "fraud" should be forwarded to the Office of the Assistant Commissioner for Patents as soon as the facts or representations are discovered. Such a forwarded application should be accompanied by a brief memorandum, signed by the group director, pointing out the fact or representation giving rise to the question of "fraud."

2. *No immediate action required.*

In situations where immediate action is not necessary on the issue of "fraud," the application will be returned to the group director along with a memorandum directing that the examiner examine the application in accordance with Office practice. In such cases, the examination should be completed as to all matters except that any issues relating to possible "fraud" will not be considered by the examiner. The Office action in such applications should contain an indication of the facts or representations bearing on the question of "fraud" and include a statement that "Consideration of any questions relating to possible fraud or improper conduct are being deferred pending resolution of all other matters (rejections, objections, appeal, etc.) in favor of applicant. No claim will be indicated as "allowable" or "allowed" in these cases since the application will not be in condition for allowance, even if the claims are otherwise patentable, until after the "fraud" question is resolved. The action by the examiner should, where appropriate only indicate that the designated claims avoid the prior art, the rejections of record, etc. A statement by the examiner that the claims are allowable would be inappropriate where a substantial issue such as fraud remains unresolved.

If the application is a reissue application, the action by the examiner may extend to a determination that the "error" required by 35 U.S.C. 251 has not been shown. However, no comment should be made by the examiner as to whether or not any "error" found in the application was with or without "deceptive intention."

When all matters, except any issues relating to possible "fraud" have been overcome, the examiner should close the prosecution of the application on its merits using the following language in his Office action.

"In view of applicant's communication filed ———, claims ——— are considered to avoid the rejections of record in the application. Accordingly, prosecution before the examiner on the merits of this application is closed. However, a determination of the issues relating to the question of fraud remains outstanding.

The application is being referred to the Office of the Assistant Commissioner for Patents for further consideration in regard to the question of fraud. Applicant will be sent further communications in due course."

In a situation involving an application which would have been in condition for allowance on a first action except for an issue relating to possible "fraud" the examiner should close the

prosecution of the application on the merits using the following language in his Office action.

"Prosecution before the examiner on the merits of this application is closed. However, a determination of any issues relating to the question of fraud remains outstanding.

"The application is being referred to the Office of the Assistant Commissioner for Patents for further consideration in regard to the question of fraud. Applicant will be sent further communications in due course."

After mailing of the Office action, the application should be transmitted by the group director to the Office of the Assistant Commissioner for Patents for consideration of the question of fraud. If additional information from the examiner is necessary, or desirable, to the proper conduct of the investigation, the application may be returned to the examiner, by way of the group director, to supply such information.

3. *Order to show cause issued.*

If the investigation reveals that a prima facie case of 'fraud' exists, an "Order to Show Cause" why the application should not be stricken under 37 CFR 1.56 will be issued.

A. *Stricken.* If no satisfactory answer to such an "Order to Show Cause" is received, the application will be stricken in accordance with 37 CFR 1.56.

B. *Not Stricken.* If a prima facie case of fraud does not exist, or the alleged fraud is adequately rebutted, a decision will be entered in the application file stating that the Office has found no evidence of fraud necessitating striking the application under 37 CFR 1.56. After a decision not to strike, the application will be returned to the examining group for allowance of the application or for any other action as may be appropriate.

4. *Immediate action required.*

In the event immediate action on the question of fraud is necessary, the normal ex parte prosecution by the examiner will be delayed until action on the question of fraud has been completed.

5. *Abandonment of application*

If the application should become abandoned for any reason, the application, along with a memorandum by the group director setting forth any information relevant to the reasons for abandonment, should be transmitted to the Office of the Assistant Commissioner prior to the forwarding of the application to the Abandoned Files Unit.

Chapter 800 Restriction; Double Patenting

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801 Introduction

The subject of restriction and double patenting are herein treated under U.S.C. Title 35, which became effective January 1, 1953, and the revised Rules of Practice that became effective January 1, 1953.

802 Basis for Practice in Statutes and Rules [R–38]

The basis for restriction and double patenting practice is found in the following statute and rules:

35 U.S.C. 121. Divisional applications. If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. If the other invention is made the subject of a divisional application which complies with the requirements of section 120 of this title it shall be entitled to the benefit of the filing date of the original application. A patent issuing on an application with respect to which a requirement for restriction under this section has been made, or on an application filed as a result of such a requirement, shall not be used as a reference either in the Patent Office or in the courts against a divisional application or against the original application or any patent issued on either of them, if the divisional application is filed before the issuance of the patent on the other application. If a divisional application is directed solely to subject matter described and claimed in the original application as filed, the Commissioner may dispense with signing and execution by the inventor. The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention.

Rule 141. Different inventions in one application. Two or more independent and distinct inventions may not be claimed in one application, except that more than one species of an invention, not to exceed five, may be specifically claimed in different claims in one application, provided the application also includes an allowable claim generic to all the claimed species and all the claims to each species in excess of one are written in dependent form (rule 75) or otherwise include all the limitations of the generic claim.

Rule 142. Requirement for restriction. (a) If two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant in his response to that action to elect that invention to which his claims shall be restricted, this official action being called a requirement for restriction (also known as a requirement for division). If the distinctness and independence of the inventions be clear, such requirement will be made before any action on the merits; however, it may be made at any time before final action in the case, at the discretion of the examiner.

(b) Claims to the invention or inventions not elected, if not cancelled, are nevertheless withdrawn from further consideration by the examiner by the election, subject however to reinstatement in the event the requirement for restriction is withdrawn or overruled.

Rules 141 through 146 outline Office practice on questions of restriction.

802.01 Meaning of "Independent", "Distinct"

35 U.S.C. 121 quoted in the preceding section states that the Commissioner may require restriction if two or more "independent and distinct" inventions are claimed in one application. In rule 141 the statement is made that two or more "independent and distinct inventions" may not be claimed in one application.

This raises the question of the subjects as between which the Commissioner may require restriction. This in turn depends on the construction of the expression "independent and distinct" inventions.

"Independent," of course, means *not dependent.* If "distinct" means the same thing, then its use in the statute and in the rule is redundant. If "distinct" means something different, then the question arises as to what the difference in meaning between these two words may be. The hearings before the committees of Congress considering the codification of the patent laws indicate that section 121: "enacts as law existing practice with respect to division, at the same time introducing a number of changes."

The report on the hearings does not mention as a change that is introduced, the subjects between which the Commissioner may properly require division.

The term "independent" as already pointed out, means *not dependent.* A large number of subjects between which, in the past, division has been proper, are dependent subjects, such, for example, as combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc. If section 121 were intended to direct the Commissioner never to approve division

between dependent inventions, the word "independent" would clearly have been used alone. If the Commissioner has authority or discretion to restrict independent inventions only, then restriction would be improper as between dependent inventions, e.g., such as the ones used for purpose of illustration above. Such was clearly, however, not the intent of Congress. Nothing in the language of the statute and nothing in the hearings of the committees indicate any intent to change the substantive law on this subject. On the contrary, joinder of the term "distinct" with the term "inpendent", indicates lack of such intent. The law has long been established that dependent inventions (frequently termed related inventions) such as used for illustration above may be properly divided if they are, in fact "distinct" inventions, even though dependent.

While in ordinary parlance, two inventions that are "independent" (i.e., not dependent) might also be considered as accurately termed "distinct", the converse is not true. Inventions that may be "distinct" may be dependent, and thus the term "independent" could not accurately be used in referring to the same. For the purpose of this manual, these terms are used as defined below.

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more subjects disclosed, that is, they are unconnected in design, operation or effect, for example, (1) species under a genus which species are not usable together as disclosed or (2) process and apparatus incapable of being used in practicing the process, etc.

The term "distinct" means that two or more subjects as disclosed are related, for example as combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc., but are capable of separate manufacture, use or sale as claimed, AND ARE PATENTABLE OVER EACH OTHER (though they may each be unpatentable because of the prior art). It will be noted that in this definition the term "related" is used as an alternative for "dependent" in referring to subjects other than independent subjects.

It is further noted that the terms "independent" and "distinct" are used in decisions with varying meanings. All decisions should be read carefully to determine the meaning intended.

802.02 Definition of Restriction

Restriction, a generic term, includes that practice of requiring an election between distinct or dependent inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions, for example, an election of species.

803 Restriction—When Proper [R-41]

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (§§ 806.04–806.04(j)) or distinct (§§ 806.05–806.05(g)).

If it is demonstrated that two or more claimed inventions have no disclosed relationship ("independent"), restriction should be required, and it is not necessary to further show that the claimed inventions are distinct. If it is demonstrated that two or more claimed inventions have a disclosed relationship ("dependent"), then a showing of distinctness is required to substantiate a restriction requirement.

Where inventions are neither independent nor distinct, one from the other, or they are not sufficiently different to support more than one patent, their joinder in a single application must be permitted.

Practice re Markush-Type Claims

This sub-section deals with Markush-type claims which include a plurality of alternatively usable substances or members. In most cases this recitation by enumeration is used because there is no appropriate or true generic language.

Where an application claims two or more independent and distinct inventions, the Commissioner, under the provisions of 35 U.S.C. 121, may require the application to be restricted to one of the inventions.

A Markush-type claim is directed to "independent and distinct inventions," if two or more of its members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C. 103 with respect to the other member(s).

If the claim is of that nature, the examiner is authorized to reject it as an improper Markush claim and for misjoinder under 35 U.S.C. 121 and to require the applicant to restrict the application to a single invention. In making such a requirement, the examiner will (1) clearly delineate the members or groups of members believed to constitute improperly joined inventions, and (2) state reasons fully explaining why they are independent and distinct. Applicant's response to such a requirement should be an election of a single adequately disclosed and supported invention, with or without re-

striction of the claim(s) to that invention. Of course, the response must not introduce new matter into the application. See 35 U.S.C. 132 and *In re Welstead*, 59 CCPA 1105, 463 F. 2d 1110, 174 USPQ 449 (1972). A refusal to elect a single invention will be treated as a non-responsive reply.

If the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner is encouraged to examine it on the merits, even though it is directed to independent and distinct inventions. In such a case, the examiner will not follow the procedure outlined in the preceding paragraph and will not require restriction.

Where the examiner has rejected the claim and required restriction and the applicant has responded without restricting the claim(s) to a single invention, the examiner shall, if the position is adhered to, again reject the claim and any other Markush claims not restricted to the elected invention. No further examination of these claims is required unless and until such rejection has been overcome. However, if the search of the single elected invention develops prior art which would render both the elected invention and the improper Markush claim(s) unpatentable, such prior art may be applied in rejections of both without a complete search of the subject matter of the improper Markush claim(s). Otherwise, only true generic claims and those restricted to the elected invention will be examined in the usual manner.

Review of the rejection will be by appeal to the Board of Appeals under 35 U.S.C. 134.

803.01 Review by Primary Examiner [R–39]

Requirements for restriction under Title 35 U.S.C. 121 being discretionary with the Commissioner, it becomes very important that the practice under this section be carefully administered. Notwithstanding the fact that this section apparently protects the applicant against the dangers that previously might have resulted from compliance with an improper requirement for restriction, IT STILL REMAINS IMPORTANT FROM THE STANDPOINT OF THE PUBLIC INTEREST THAT NO REQUIREMENTS BE MADE WHICH MIGHT RESULT IN THE ISSUANCE OF TWO PATENTS FOR THE SAME INVENTION. Therefore to guard against this possibility, the primary examiner must personally review all final requirements for restriction.

804 Definition of Double Patenting [R–41]

There are two types of double patenting rejections. One is the "same invention" type double patenting rejection based on 35 U.S.C. 101 which states in the singular that an inventor "may obtain a patent." This has been interpreted as meaning only one patent.

The other type is the "obviousness" type double patenting rejection which is a judicially created doctrine based on public policy rather than statute and is primarily intended to prevent prolongation of monopoly by prohibiting claims in a second patent not patentably distinguishing from claims in a first patent. In re White et al., 160 USPQ 417; In re Thorington et al., 163 USPQ 644. Note also §§ 804.01 and 804.02.

The Court of Customs and Patent Appeals has held that a terminal disclaimer is ineffective in the first type, where it is attempted to twice claim the same invention. However, the "obviousness" type double patenting rejection may be obviated by a terminal disclaimer.

The term "double patenting" is properly applicable only to cases involving two or more applications and/or patents having the same inventive entity and where an invention claimed in one case is the same as, or not patentably distinct from, an invention already claimed. The term "double patenting" should not be applied to situations involving commonly owned cases of different inventive entities.

The inventive entity is the sole inventor or the joint inventors listed on a patent or patent application. A sole inventor in one application and joint inventors in another application cannot constitute a single or the same entity, even if the sole inventor is one of the joint inventors. Likewise, two sets of joint inventors do not constitute a single inventive entity if any individual inventor is included in one set who is not also included in the other set. Commonly-owned cases of different inventive entities are to be treated in the manner set out in § 804.03.

804.01 Nullification of Double Patenting Rejection [R–20]

35 U.S.C. 121, third sentence, provides that where the Office requires restriction, the patent of either the parent or any divisional application thereof conforming to the requirement cannot be used as a reference against the other. This apparent nullification of double patenting as a ground of rejection or invalidity in such cases imposes a heavy burden on the Office to guard against erroneous requirements for restriction where the claims define essentially the

same inventions in different language and which, if acquiesced in, might result in the issuance of several patents for the same invention.

The apparent nullification of double patenting as a ground of rejection or invalidity raises many troublesome questions as to meaning and situations where it applies.

A. Situations Where 35 U.S.C. 121 Does Not Apply

(a) The applicant voluntarily files two or more cases without requirement by the examiner.

(b) The claims of the different applications or patents are not consonant with the requirement made by the examiner, due to the fact that the claims have been changed in material respects from the claims at the time the requirement was made.

(c) The requirement was made subject to the nonallowance of generic or other linking claims and such linking claims are subsequently allowed.

B. Situations Where 35 U.S.C. 121 Apparently Applies

It is considered that the prohibition against holdings of double patenting applies to requirements for restriction between the related subjects treated in §§ 806.04 through 806.05(g), namely, between combination and subcombination thereof, between subcombinations disclosed as usable together, between process and apparatus for its practice, between process and product made by such process and between apparatus and product made by such apparatus, etc., *so long as the claims in each case filed as a result of such requirement are limited to its separate subject.*

804.02 Terminal Disclaimer Avoiding Double Patenting Rejection [R–41]

If two or more cases are filed by a single inventive entity, and if the expiration dates of the patents, granted or to be granted, are the same, either because of a common issue date or by reason of the filing of one or more terminal disclaimers, two or more patents may properly be granted, provided the claims of the different cases are not drawn to the same invention (In re Knohl, 155 USPQ 586; In re Griswold, 150 USPQ 804).

Claims that differ from each other (aside from minor differences in language, punctuation, etc.), whether or not the difference is obvious, are not considered to be drawn to the same invention for double patenting purposes. In cases where the difference in claims is obvious, terminal disclaimers are effective to overcome rejections on double patenting. However, such terminal disclaimers must include a provision that the patent shall expire immediately if it ceases to be commonly owned with the other application or patent. Note rule 321(b).

Where there is no difference, the inventions are the same and a terminal disclaimer is ineffective.

Rule 321(b). A terminal disclaimer, when filed in an application to obviate a double patenting rejection, must include a provision that any patent granted on that application shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection. See rule 21 for fee.

See § 1403 for form.

804.03 Terminal Disclaimer Not Applicable—Commonly Owned Cases of Different Inventive Entities [R–39]

Rule 78(c). Where two or more applications, or an application and a patent naming different inventors and owned by the same party contain conflicting claims, the assignee may be called upon to state which named inventor is the prior inventor. In addition to making said statement, the assignee may also explain why an interference should be declared or that no conflict exists in fact.

In view of 35 U.S.C. 135, it is necessary to determine priority of invention whenever two different inventive entities are claiming a single inventive concept, including variations of the same concept each of which would be obvious in view of the other. This is true regardless of ownership and the provision of rule 201(c) that interferences will not be declared or continued between commonly owned cases unless good cause is shown therefor. A terminal disclaimer can have no effect in this situation, since the basis for refusing more than one patent is 35 U.S.C. 102 or 103, and is not connected with any extension of monopoly.

Accordingly, the assignee of two or more cases of different inventive entities, containing conflicting claims must maintain a line of demarcation between them. If such a line is not maintained, the assignee should be called on to state which entity is the prior inventor of that subject matter and to limit the claims of the other application accordingly. If the assignee does not comply with this requirement, the case in which the requirement to name the prior inventor was made will be held abandoned.

An application in which a requirement to name the prior inventor has been made will not be held abandoned where a timely response indicates that the other application is abandoned or will be permitted to become abandoned. Such a response will be considered sufficient since it renders the requirement to identify the prior inventor moot because the existence of conflicting claims is eliminated.

If after taking out a patent, a common assignee presents claims for the first time in a copending application not patentably distinct from the claims in the patent, the claims of the application should be rejected on the ground that the assignee, by taking out the patent at a time when the application was not claiming the patented invention, is estopped to contend that the patentee is not the prior inventor.

If a patent is inadvertently issued on one of two commonly owned applications by different inventive entities which at the time when the patent issued were claiming inventions which are not patentably distinct, the assignee should be called on to make a determination of priority as in the case of pending applications. If the determination indicates that the patent issued to the senior entity a rejection under 35 U.S.C. 102 or 103 should be made. An election of the applicant (senior entity) as the first inventor should not be accepted without a complete (not terminal) disclaimer of the conflicting claims in the patent.

804.04 Submission to Group Director [R–38]

In order to promote uniform practice, every action containing a rejection on the ground of double patenting of either a parent or a divisional case (where the divisional case was filed because of a requirement to restrict by the examiner under 35 U.S.C. 121, including a requirement to elect species, made by the Office) must be submitted to the group director for approval prior to mailing. When the rejection on the ground of double patenting is disapproved, it shall not be mailed but other appropriate action shall be taken. Note § 1003, item 4.

805 Effect of Improper Joinder in Patent [R–16]

35 U.S.C. 121, last sentence provides: "The validity of a patent shall not be questioned for failure of the Commissioner to require the application to be restricted to one invention." In other words, under this statute, no patent can be held void for improper joinder of inventions claimed therein.

806 Determination of Distinctness or Independence of Claimed Inventions [R–20]

The general principles relating to distinctness or independence are elementary, and may be summarized as follows:

1. Where inventions are independent (i.e., no disclosed relation therebetween), restriction, to one thereof is ordinarily proper, §§ 806.04–806.04(j), though up to 5 species may be claimed when there is an allowed claim generic thereto, rule 141, §§ 809.02–809.02(e).

2. Where inventions are related as disclosed but are distinct as claimed, restriction may be proper.

3. Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper. Since, if restriction is required by the Office double patenting cannot be held, it is imperative the requirement should never be made, where related inventions as claimed are not distinct. For (2) and (3) see §§ 806.05–806.05(g) and 809.03.

806.01 Compare Claimed Subject Matter

In passing upon questions of double patenting and restriction, it is the *claimed* subject matter that is considered and such *claimed* subject matter must be *compared* in order to determine the question of distinctness or independence.

806.02 Patentability Over the Prior Art Not Considered [R–29]

For the purpose of a decision on the question of restriction, and for this purpose only, the claims are ordinarily assumed to be in proper form and patentable over the prior art.

This assumption, of course, is not continued after the question of restriction is settled and the question of patentability of the several claims in view of prior art is taken up.

806.03 Single Embodiment, Claims Defining Same Essential Features

Where the claims of an application define the same essential characteristics of a *single* disclosed embodiment of an invention, restriction therebetween should never be required. This is because the claims are but different definitions of the same disclosed subject matter, varying in breadth or scope of definition.

Where such claims appear in different appli-

cations optionally filed by the same inventor, disclosing the same embodiments, only one application can be allowed.

806.04 Independent Inventions [R-38]

If it can be shown that the two or more inventions are in fact independent, applicant should be required to restrict the claims presented to but one only of such independent inventions. For example:

1. Two different combinations, not disclosed as capable of use together, having different modes of operation, different functions or different effects are independent. An article of apparel such as a shoe, and a locomotive bearing would be an example. A process of painting a

house and a process of boring a well would be a second example.

2. Where the two inventions are process and apparatus, and the apparatus cannot be used to practice the process or any part thereof, they are independent. A specific process of molding is independent from a molding apparatus which cannot be used to practice the specific process.

3. Where species under a genus are independent. For example, a genus of paper clips having species differing in the manner in which a section of the wire is formed in order to achieve a greater increase in its holding power.

SPECIES ARE TREATED EXTENSIVELY IN THE FOLLOWING SECTIONS

806.04(a) Species—Genus [R–38]

The statute (35 U.S.C. 121) lays down the general rule that restriction may be required to one of two or more independent inventions. Rule 141 makes an exception to this, providing that up to five species may be claimed in one application if the other conditions of the rule are met.

806.04(b) Species May Be Related Inventions

Species, while usually independent may be related under the particular disclosure. Where inventions as disclosed and claimed, are both (a) species under a claimed genus and (b) related, then the question of joinder must be determined by both the restriction practice applicable to election of species and the practice applicable to other types of restrictions. If restriction is improper under either practice it should not be required.

For example, two different subcombinations usable with each other may each be a species of some common generic invention. In ex parte Healy 1898 C.D. 157; 84 O.G. 1281, a clamp for a handle bar stem and a specifically different clamp for a seat post both usable together on a bicycle were claimed. In his decision, the commissioner considered both the restriction practice under election of species and the practice applicable to restriction between combination and subcombinations.

As a further example, species of carbon compounds may be related to each other as intermediate and final product. Thus these species are not independent and in order to sustain a restriction requirement, distinctness must be shown. Distinctness is proven if it can be shown that the intermediate product is useful other than to make the final product. Otherwise, the disclosed relationship would preclude their being issued in separate patents.

806.04(c) Subcombination Not Generic to Combination

The situation is frequently presented where two different combinations are disclosed, having a subcombination *common to each.* It is frequently puzzling to determine whether a claim readable on two different combinations is generic thereto.

This was early recognized in Ex parte Smith 1888 C.D. 131; 44 O.G. 1183, where it was held that a subcombination was not generic to the different combinations in which it was used.

To exemplify, a claim that defines only the subcombination, e.g., the mechanical structure of a joint, is not a generic or genus claim to two forms of a combination, e.g., two different forms of a doughnut cooker each of which utilize the same form of joint.

806.04(d) Definition of a Generic Claim

In an application presenting three species illustrated, for example, in Figures 1, 2 and 3 respectively, a generic claim should read on each of these views; but the fact that a claim does so read is not conclusive that it is generic. It may define only an element or subcombination common to the several species.

It is not possible to define a generic claim with that precision existing in the case of a geometrical term. In general, a generic claim should include no material element additional to those recited in the species claims, and must comprehend within its confines the organization covered in each of the species.

For the purpose of obtaining claims to more than one species in the same case, the generic claim cannot include limitations not present in each of the added species claims. Otherwise stated, the claims to the species which can be included in a case in addition to a single species must contain all the limitations of the generic claim.

Once a claim that is determined to be generic is allowed, the claims restricted to species in addition to one but not to exceed four additional species, provided they comply with the requirements, will ordinarily be obviously allowable in view of the allowance of the generic claim, since the additional species will depend thereon or otherwise include all of the limitations thereof.

When all or some of the claims directed to one of the species in addition to the first do not include all the limitations of the generic claim, then that species cannot be claimed in the same case with the other species, see § 809.02(c) (2).

806.04(e) Claims Restricted to Species [R–38]

Claims are never species. Claims are definitions of inventions. Claims may be restricted to a single disclosed embodiment (i.e. a single species, and thus be designated *a specific species claim*), or a claim may include two or more of the disclosed embodiments within the breadth of scope of definition (and thus be designated *a generic or genus claim*).

Species are always the specifically different embodiments.

Species are *usually* but not always independent as disclosed (see § 806.04(b)) since there is usually no disclosure of relationship therebetween. The fact that a genus for two different embodiments is capable of being conceived and defined, does not affect the independence of the embodiments, where the case under consideration contains no disclosure of any community of operation, function or effect.

806.04(f) Claims Restricted to Species, by Mutually Exclusive Characteristics

Claims to be restricted to different species must be mutually exclusive. The general test as to when claims are restricted respectively to different species is the fact that one claim recites limitations which *under the disclosure* are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not the first. This is frequently expressed by saying that claims to be restricted to different species, must recite the mutually exclusive characteristics of such species.

806.04(h) Species Must Be Patentably Distinct From Each Other and From Genus [R–38]

Where an applicant files a divisional application claiming a species previously claimed but nonelected in the parent case, pursuant to and consonant with a requirement to restrict, there should be no determination of whether or not the species claimed in the divisional application is patentable over the species retained in the parent case since such a determination was made before the requirement to restrict was made.

In an application containing claims directed to more than five species, the examiner should not require restriction to five species unless he is satisfied that he would be prepared to allow claims to each of the claimed species over the parent case, if presented in a divisional application filed according to the requirement. Restriction should not be required if the species claimed are considered clearly unpatentable over each other.

In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

Where generic claims are allowed, applicant may claim in the *same application* additional species as provided by rule 141. As to these, the patentable distinction between the species or between the species and genus is not rigorously investigated, since they will issue in the same patent. However, the practice stated in § 706.03 (k) may be followed if the claims differ from the allowed genus only by subject matter that can be shown to be old by citation of prior art.

Where, however, an applicant optionally files another application with claims to a different species, or for a species disclosed but not claimed in a parent case as filed and first acted upon by the examiner, there should be close investigation to determine the presence or absence of patentable difference. See §§ 804.01 and 804.02.

806.04(i) Generic Claims Rejected When Presented for First Time After Issue of Species [R–18]

Where an applicant has separate applications for plural species, but presents no generic claim until after the issue of a patent for one of the species, the generic claims cannot be allowed, even though the applications were copending.

806.04(j) Generic Claims in One Patent only [R–18]

Generic claims covering two or more species which are separately claimed in two or more patents to the same inventor issued on copending applications *must all be present in a single one of the patents.* If present in two or more patents, the generic claims in the later patents are void. Thus generic claims in an application should be rejected on the ground of double patenting in view of the generic claims of the patent.

806.05 Related Inventions [R–18]

Where two or more related inventions are being claimed, the principal question to be determined in connection with a requirement to restrict or a rejection on the ground of double patenting is whether or not the inventions as claimed are distinct. If they are not distinct,

restriction is never proper. If claimed in separate applications or patents, double patenting must be held, except where the additional applications were filed consonant with a requirement to restrict.

The various pairs of related inventions are noted in the following sections.

806.05(a) Combination or Aggregation and Subcombination or Element [R–25]

A combination or an aggregation is an organization of which a subcombination or element is a part.

The distinction between combination and aggregation is not material to questions of restriction or to questions of double patenting. Relative to questions of restriction where a combination is alleged, the claim thereto must be assumed to be allowable as pointed out in § 806.02, in the absence of a holding by the examiner to the contrary. When a claim is found in a patent, it has already been found by the Office to be for a combination and not an aggregation and must be treated on that basis.

Combination claims (other than combination claims which are also genus claims linking species claims) whether allowable, allowed, or not allowed and considered the subject of a proper restriction requirement should be grouped as a separate invention, see § 806.05(c).

Combination claims which under past practice may have served as a basis for joining claimed inventions are not considered to be linking claims. Likewise rejoinder of restricted inventions, should any combination claim be allowed, will not be permitted.

806.05(b) Old Combination—Novel Subcombination [R–25]

Restriction is ordinarily not proper between a combination (AB) that the examiner holds to be old and unpatentable and the subcombination (B) in which the examiner holds the novelty, if any, to reside, ex parte Donnell 1923 C.D. 54, 315 O.G. 398. (See § 820.01.)

806.05(c) Criteria of Distinctness for Combination, Subcombination or Element of a Comination—Related Inventions [R–18]

To support a requirement to restrict between the claimed inventions of two or more combinations; of two or more subcombinations; of two or more elements of a combination; of a combination and subcombination; or a combination and an element of a combination, the examiner must demonstrate by appropriate explanation one of the following criteria for distinctness;

(1) Separate classification thereof:

This shows that each distinct subject has attained a recognition in the art as a separate subject for inventive effort, and also a separate field of search.

(2) A separate status in the art when they are classifiable together:

Even though they are classified together, as shown by appropriate explanation, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate effort by inventors.

(3) A different field of search:

Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims.

806.05(e) Process and Apparatus for Its Practice—Distinctness [R–18]

Process and apparatus for its practice can be shown to be distinct inventions, if either or both of the following can be shown: (1) that the process *as claimed* can be practiced by another materially different apparatus or by hand, or (2) that the apparatus *as claimed* can be used to practice another and materially different process.

806.05(f) Process and Product Made—Distinctness [R–18]

A process and a product made by the process can be shown to be distinct inventions if either or both of the following can be shown: (1) that the process *as claimed* is not an obvious process of making the product *and* the process *as claimed* can be used to make other and different products, or (2) that the product *as claimed* can be made by another and materially different process.

806.05(g) Apparatus and Product Made—Distinctness [R–25]

The criteria are the same as in § 806.05(f) substituting apparatus for process.

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807 Patentability Report Practice Has No Effect on Restriction Practice [R–25]

Patentability report practice (§ 705), has no effect upon, and does not modify in any way, the practice of restriction, being designed merely to facilitate the handling of cases in which restriction can not properly be required.

808 Reasons for Insisting Upon Restriction

Every requirement to restrict has two aspects, (1) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct, and (2) the reasons for insisting upon restriction therebetween.

808.01 Independent Inventions [R–25]

Where the inventions claimed are independent, i.e., where they are not connected in design, operation or effect under the disclosure of the particular application under consideration (§ 806.04), *the facts relied upon for this conclusion are in essence the reasons for insisting upon restriction.* This situation, except for species, is but rarely presented, since persons will seldom file an application containing disclosures of independent things.

808.01(a) Species [R–38]

Where there is no disclosure of relationship between species (see § 806.04(b)), they are independent inventions and election of one following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable distinction between the species as claimed, see § 806.04(h). Thus the reasons for insisting upon election of one species, are the facts relied upon for the conclusion that there are claims restricted respectively to two or more patentably different species that are disclosed in the application, and it is not necessary to show a separate status in the art or separate classification.

A single disclosed species must be elected as a prerequisite to applying the provisions of rule 141 to four additional species if a generic claim is allowed.

Even though the examiner rejects the generic claims, and even though the applicant cancels the same and thus admits that the genus is unpatentable, where there is a relationship disclosed between species such disclosed relation must be discussed and reasons advanced leading to the conclusion that the disclosed relation does not prevent restriction, in order to establish the propriety of restriction.

Election of species should not be required if the species claimed are considered clearly unpatentable over each other. In making a requirement for restriction in an application claiming plural species, the examiner should group together species considered clearly unpatentable over each other, with the statement that restriction as between those species is not required.

Election of species should be required prior to a search on the merits (1) in all applications containing claims to a plurality of species with no generic claims, and (2) in all applications containing both species claims and generic or Markush claims.

In all applications in which no species claims are present and a generic claim recites such a multiplicity of species that an unduly extensive and burdensome search is required, a requirement for an election of species should be made prior to a search of the generic claim.

In all cases where a generic claim is found allowable, the application should be treated as indicated in §§ 809.02(b), (c) or (e). If an election is made pursuant to a telephone requirement, the next action should include a full and complete action on the elected species as well as on any generic claim that may be present.

808.02 Related Inventions [R–38]

Where, as disclosed in the application, the several inventions claimed are related, and such related inventions are not patentably distinct as claimed, restriction under 35 U.S.C. 121 is never proper (§ 806.05). If applicant optionally restricts, double patenting may be held.

Where the related inventions as claimed involve different statutory classes (e.g., process and apparatus for its practice, process and product made, or apparatus and product made) and are shown to be distinct under the criteria of §§ 806.05(e–g), the examiner, in order to establish reasons for insisting upon restriction, must show by appropriate explanation one of the following additional criteria for distinctness:

(1) Separate classification thereof:

This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search.

(2) A separate status in the art when they are classifiable together;

Even though they are classified together, as shown by the appropriate explanation each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors.

(3) A different field of search:

Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims.

Where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions. This is particularly true in the manufacturing arts where manufacturing processes and the resultant product are classified together, e.g. Carbon Compounds Class 260. Under these circumstances, applicant may optionally restrict to one of plural distinct inventions since double patenting will not be held, and restriction will not be required.

Where the related inventions involve combinations, subcombinations, elements of a combination, combination and subcombination, or combination and elements of a combination, the reasons for insisting upon restriction therebetween are implicit in the showing of distinctness under the criteria of § 806.05(c).

809 Claims Linking Distinct Inventions [R–38]

Where, upon examination of an application containing claims to distinct inventions, linking claims are found, restriction should nevertheless be required. See § 809.03 for definition of linking claims.

It should be noted that a claim drawn to an aggregation or combination does not link claims to two or more elements thereof, or to two or more subcombinations, see § 806.05(a).

A letter including only a restriction requirement or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered linking. See § 812.01 for telephone practice in restriction requirements.

No art will be indicated for this type of linking claim and no rejection of these claims made.

A 30-day shortened statutory period will be set for response to a written requirement. Such action will not be an "action on the merits" for the purpose of the second action final program.

To be complete, a response to a requirement made according to this section need only include a proper election.

A basic policy of the present examining program is that the second action on the merits should be made final whenever proper, § 706.07(a). In those applications wherein a requirement for restriction or election is accompanied by a complete action on the merits of all the claims, such action will be considered to be an action on the merits and the next action by the examiner should be made final. When preparing a final action in an application where applicant has traversed the restriction requirement, see § 821.01.

In stating a requirement for restriction, there should be no citation of patents to show separate status or classification or utility. The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass.

The linking claims *must* be examined with the invention elected, and should any *linking* claim be allowed, rejoinder of the divided inventions *must be* permitted.

809.02 Generic Claim Linking Species [R–25]

Under rule 141, an allowed generic claim may link up to five disclosed species embraced thereby.

The practice is stated in rule 146:

Rule 146. Election of species. In the first action on an application containing a generic claim and claims restricted separately to each of more than one species embraced thereby, the examiner, if of the opinion after a complete search on the generic claims that no generic claim presented is allowable, shall require the applicant in his response to that action to elect that species of his invention to which his claims shall be restricted if no generic claim is finally held allowable. However, if such application contains claims directed to more than five species, the examiner may require restriction of the claims to not more than five species before taking any further action in the case.

The last sentence of rule 146, that the examiner may require restriction of the claims so that not more than five species are separately claimed, is permissive. It may be used in aggravated cases of a multiplicity of species, without acting on generic claims, to narrow the issues down to five species. But see § 806.04(h).

809.02(a) Election Required [R–25]

Where generic claims are present, a letter including only a restriction requirement or a telephoned requirement to restrict (the latter being encouraged) should be effected. See § 812.01 for telephone practice in restriction requirements.

Action as follows should be taken:

(1) Identify generic claims or indicate that no generic claims are present. See § 806.04(d) for definition of a generic claim.

(2) Clearly identify each (or in aggravated cases at least exemplary ones) of the disclosed species, *to which claims are restricted.* The species are preferably identified as the species of figures 1, 2 and 3 or the species of examples I, II and III, respectively. In the absence of distinct figures or examples to identify the several species, the mechanical means, the particular material, or other distinguishing characteristic of the species should be stated for each species identified. If the species *cannot be more conveniently identified*, the claims may be grouped in accordance with the species to which they are restricted.

(3) Applicant should then be required to elect a single disclosed species under 35 U.S.C. 121, and advised as to the requisites of a complete response and his rights under rule 141.

For generic claims, a search should not be made and art should not be cited.

A 30-day shortened statutory period will be set for response when a written requirement is made without an action on the merits. Such action will not be an "action on the merits" for purpose of the second action final program.

To be complete, a response to a requirement made according to this section need only include a proper election.

In those applications wherein a requirement for restriction is accompanied by an action on all claims, such action will be considered to be an action on the merits and the next action should be made final.

The following form paragraphs are suggested:

"Generic claims . . . (identify) are present in this application. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species to which his claims shall be restricted if no generic claim is finally held allowable."

"Applicant is advised that his response must include, an identification of the *disclosed* species that he elects consonant with the requirement, and a listing of all claims readable thereon. An argument that a generic claim is allowable, or that all claims are generic or amended to be generic, unless accompanied by an election, is nonresponsive."

"Upon the allowance of a generic claim applicant will be entitled to consideration of claims to not more than four species in addition to the single elected species, provided all the claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by rule 141."

If claims are added after the election, applicant must indicate which are readable on the elected species.

How Expressed

The following text is ordinarily sufficient in requiring election of species:

"Applicant is required (1) to elect a single disclosed species under 35 U.S.C. 121, even though this requirement be traversed and (2) to list all claims readable thereon, including any claims subsequently added. Section 809.-02(a) Manual of Patent Examining Procedure."

This may be used instead of the three quoted paragraphs in part (3) of this section except where applicant is prosecuting his own case or there are other reasons for believing that the short form would not be understood.

It is necessary to (1) identify generic claims or state that none are present, and (2) to clearly identify each species involved.

809.02(b) Election Required—Generic Claim Allowable [R–18]

When a claim generic to two or more claimed species is found to be allowable on the first or any subsequent action on the merits *and election of a single species has not been made*, applicant should be informed that the claim is allowable and generic, and a requirement should be made that applicant elect a single species *embraced by the allowed genus* unless the species claims are all in the form required by rule 141 and no more than five species are claimed. Substantially the following should be stated:

"Applicant is advised that his response to be complete must include an identification of the single, *disclosed* species *within the allowed genus* that he elects and a listing of all claims readable thereupon. Applicant is entitled to consideration of claims to not more than *four* disclosed species in addition to the elected species, *which species he must identify* and list all claims *restricted to* each, provided *all* the claims to each additional species are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by rule 141."

809.02(c) Action Following Election [R–18]

An examiner's action subsequent to an election of species should include a complete action on the merits of all claims readable on the elected species.

(1) When the *generic claims are rejected*, all claims not readable on the elected species should be treated substantially as follows:

"Claims _____ are held to be withdrawn from further consideration under rule 142(b) as not readable on the elected species."

(2) When a *generic claim* is subsequently found to be *allowable*, and not more than 4 additional species are claimed, treatment should be as follows:

When any claim directed to one of said additional species *embraced* by an allowed generic claim is not in the required form, *all* claims to that species should be held to be withdrawn from further consideration by the examiner. The holding should be worded somewhat as follows:

"Claims _____ directed to species _____ are withdrawn from further consideration in this case, since *all* of the claims to this species do not depend upon or otherwise include all of the limitations of an allowed generic claim as required by rule 141."

When the case is *otherwise ready for issue*, an additional paragraph worded somewhat as follows should be added to the holding:

"This application is in condition for allowance except for the presence of such claims. Applicant is given one month from the date of this letter to amend the claims in conformance to rule 141 or take other action (rule 144). Failure to take action during this period will be treated as authorization to cancel claims to the nonelected species by Examiner's Amendment and pass the case to issue. The prosecution of this case is closed except for consideration of the above matter."

Claims directed to species *not embraced* by an allowed generic claim should be treated as follows: Claims _____ are for species not embraced by allowed generic claims _____ as required by rule 141 and are withdrawn from further consideration in this case, rule 142(b).

809.02(d) No Species Claims [R–18]

Where only generic claims are presented no restriction can be required except in those cases where the generic claims recite such a multiplicity of species that an unduly extensive and burdensome search is necessary. See § 808.01(a).

If after an action on only generic claims with no restriction requirement, applicant presents species claims to more than one species of the invention he must at that time indicate an election of a single species.

809.02(e) Generic Claim Allowable in Substance [R–18]

Whenever a generic claim is found to be allowable in substance, even though it is objected to or rejected on merely formal grounds, action on the species claims shall thereupon be given as if the generic claim were allowed.

The treatment of the case should be as indicated in §§ 809.02 (b), (c), or (d).

809.03 Linking Claims [R–34]

There are a number of situations which arise in which an application has claims to two or more properly divisible inventions, so that a requirement to restrict the application to one would be proper, but presented in the same case are one or more claims (generally called "linking" claims) inseparable therefrom and thus linking together the inventions otherwise divisible. It should be noted that a claim drawn to an aggregation or combination does not link the claims of two or more elements thereof, or of two or more subcombinations, see § 806.05(a).

The most common types of linking claims which, if allowed, act to prevent restriction between inventions that can otherwise be shown to be divisible, are:

Genus claims linking species claims.

A claim to the necessary process of making a product linking proper process and product claims.

A claim to "means" for practicing a process linking proper apparatus and process claims.

Where linking claims exist, a letter including a restriction requirement only or a telephoned requirement to restrict (the latter being encouraged) will be effected, specifying which claims are considered to be linking.

809.04 Retention of Claims to Non-Elected Invention [R–34]

Where the requirement is predicated upon the non-allowability of generic or other type of linking claims, applicant is entitled to retain in the case claims to the non-elected invention or inventions.

If a linking claim is allowed, the examiner must thereafter examine species if the linking claim is generic thereto, or he must examine the claims to the nonelected inventions that are

linked to the elected invention by such allowed linking claim.

When a final requirement is contingent on the non-allowability of the linking claims, applicant may petition from the requirement under rule 144 without waiting for a final action on the merits of the linking claims; or he may defer his petition until the linking claims have been finally rejected, but not later than appeal, rule 144, § 818.03(c).

810 Action on Novelty [R–18]

In general, when a requirement to restrict is made, no action on novelty and patentability is given.

810.01 Not Objectionable When Coupled With Requirement [R–18]

Although an action on novelty and patentability is not necessary to a requirement, it is not objectionable, ex parte Lantzke 1910 C.D. 100; 156 O.G. 257.

However, *except* as noted in § 809, if an action is given on novelty, *it must be given on all claims.*

810.02 Usually Deferred

The Office policy is to defer action on novelty and patentability until after the requirement is complied with, withdrawn or made final.

Ex parte Pickles, 1904 C.D. 126; 109 O.G. 1888

Ex parte Snyder, 1904 C.D. 242; 110 O.G. 2636

Ex parte Weston, 1911 C.D. 218; 173 O.G. 285

810.03 Given on Elected Invention When Requirement Is Made Final

Rule 143 last sentence states: "If the requirement is repeated and made final, the examiner will at the same time act on the claims to the elected invention." Thus, action is ordinarily given on the elected invention in the action making the requirement final.

811 Time for Making Requirement

Rule 142(a), 2nd sentence: "If the distinctness and independence of the inventions be clear, such requirement (i.e. election of the invention to be claimed as required by 1st sentence) will be made before any action upon the merits; however, it may be made at any time before final action in the case, at the discretion of the examiner."

This means, make a proper requirement as early as possible in the prosecution, in the first action if possible, otherwise as soon as a proper requirement develops.

811.02 Even After Compliance With Preceding Requirement

Since the rule provides that restriction is proper at any stage of prosecution up to final action, a second requirement may be made when it becomes proper, even though there was a prior requirement with which applicant complied (Ex parte Benke, 1904 C.D. 63; 108 O.G. 1588).

811.03 Repeating After Withdrawal—Proper

Where a requirement to restrict is made and withdrawn, because improper, when it becomes proper at a later stage in the prosecution, restriction may again be required.

811.04 Proper Even Though Grouped Together in Parent Case

Even though inventions are grouped together in a requirement in a parent case, restriction thereamong may be required in the divisional case if proper.

812 Who Should Make the Requirement

The requirement should be made by an examiner who would examine at least one of the inventions.

An examiner ordinarily should not require restriction in an application *none* of the claimed subject matter of which is classifiable in his group. Such an application should be transferred to a group to which at least some of the subject matter belongs.

812.01 Telephone Restriction Practice [R–34]

If an examiner determines that a requirement for restriction should be made in an application, he should formulate a draft of such restriction requirement including an indication of those claims considered to be linking or generic. No search or rejection of the linking claims should be made. Thereupon, he should telephone the attorney of record and ask if he will make an oral election, with or without

traverse if desired, after the attorney has had time to consider the restriction requirement. The examiner should arrange for a second telephone call within a reasonable time, generally within three working days. If the attorney objects to making an oral election, or fails to respond, the usual restriction letter will be mailed, and this letter should NOT contain any reference to the unsuccessful telephone call. See §§ 809 and 809.02(a).

When an oral election is made, the examiner will then proceed to incorporate into his letter a formal restriction requirement including the date of the election, the attorney's name, and a complete record of the telephone interview, followed by a complete action on the elected claims including linking or generic claims if present.

If on examination the examiner finds the elected claims to be allowable and no traverse was made, the letter should be written on POL–37 (Examiner's Amendment) and should include cancellation of the non-elected claims, a statement that the prosecution is closed and that a notice of allowance will be sent in due course. Correction of formal matters in the above-noted situation which cannot be handled by a telephone call and thus requires action by the applicant should be handled under the *Ex parte* Quayle practice, using POL–326; these would usually be drawing corrections or the like requiring payment of charges.

Should the elected claims be found allowable in the first action, and an oral traverse was noted, the examiner should include in his action a statement under § 821.01, making the restriction final and giving applicant one month to either cancel the non-elected claims or take other appropriate action (rule 144). Failure to take action will be treated as an authorization to cancel the non-elected claims by an examiner's amendment and pass the case to issue. Prosecution of this application is otherwise closed.

In either situation (traverse or no traverse), caution should be exercised to determine if any of the allowed claims are linking or generic before cancelling the non-elected claims.

Where the respective inventions are located in different groups the requirement for restriction should be made only after consultation with and approval by all groups involved. If an oral election would cause the application to be examined in another group, the initiating group should transfer the application with a signed memorandum of the restriction requirement and a record of the interview. The receiving group will incorporate the substance of this memorandum in its official letter as indicated above. Differences as to restriction should be settled by the existing chain of command, e.g. supervisory primary examiner or group director.

This practice is limited to use by examiners who have at least negotiation authority. Other examiners must have the prior approval of their supervisory primary examiner.

814 Indicate Exactly How Application Is To Be Restricted

A. *Species.* The mode of indicating how to require restriction between species is set forth in § 809.02(a).

As pointed out in ex parte Ljungstrom 1905 C.D. 541; 119 O.G. 2335, the particular limitations in the claims and the reasons why such limitations are considered to restrict the claims to a particular disclosed species should be mentioned if necessary to make the requirement clear.

B. *Inventions other than species.* It is necessary to read all of the claims in order to determine what the claims cover. When doing this, the claims directed to each separate subject should be noted along with a statement of the subject matter to which they are drawn.

This is the best way to most clearly and precisely indicate to applicant how the application should be restricted. It consists in identifying each separate subject amongst which restriction is required, and grouping each claim with its subject.

While every claim should be accounted for, the omission to group a claim, or placing a claim in the wrong group will not affect the propriety of a final requirement where the requirement is otherwise proper and the correct disposition of the omitted or erroneously grouped claim is clear.

C. *Linking claims.* The generic or other linking claims should not be associated with any one of the linked inventions since such claims must be examined with any one of the linked inventions that may be elected. This fact should be clearly stated.

815 Make Requirement Complete [R–18]

When making a requirement every effort should be made to have the requirement complete. If some of the claimed inventions are classifiable in another art unit and the examiner has any doubt as to the proper line among the same, he should refer the application to the examiner of the other art unit for information on that point and such examiner should render the necessary assistance.

816 Give Reasons for Holding of Independence or Distinctness [R–18]

The particular reasons relied upon by the examiner for his holding that the inventions as claimed are either independent or distinct, should be concisely stated. A mere statement of conclusion is inadequate. The reasons upon which the conclusion is based should be given.

The separate inventions should be identified by a grouping of the claims with a short description of the total extent of the invention claimed in each group, specifying the type or relationship of each group as by stating the group is drawn to a process, or to subcombination, or to product, etc., and should indicate the classification or separate status of each group, as for example, by class and subclass. See § 809.

817 Outline of Letter for Restriction Requirement between Distinct Inventions [R–38]

The statement in §§ 809.02 through 809.02(d) is adequate indication of the form of letter when election of species is required.

No outline of a letter is given for other types of independent inventions since they rarely occur.

The following outline of a letter for a requirement to restrict is intended to cover every type of original restriction requirement between related inventions including those having linking claims.

OUTLINE OF LETTER

A. Statement of the requirement to restrict and that it is being made under 35 U.S.C. 121
   - Identify each group by Roman numeral
   - List claims in each group
     - Check accuracy of numbering
       - Look for same claims in two groups
       - Look for omitted claims
   - Give short description of total extent of the subject matter claimed in each group
   - Point out critical claims of different scope
   - Identify whether combination, subcombination, process, apparatus or product
   - Classify each group

B. Take into account claims not grouped, indicating their disposition.
   - Linking claims
     - Indicate—(make no action)
     - Statement of groups to which linking claims may be assigned for examination
   - Other ungrouped claims
     - Indicate disposition
       - e.g., previously nonelected, nonstatutory, canceled, etc.

C. Allegation of distinctness
   - Point out *facts* which show distinctness
     - Treat the inventions as *claimed*, don't merely state your conclusion that inventions in fact are distinct
   - (1) Subcombination or Element—Subcombination or Element
     - Each are separately classified, have attained a separate status in the art, or involve different fields of search
   - (2) Combination—Subcombination or Element
     - The same as (1) above
   - (3) Combination—Combination
     - The same as (1) above
   - (4) Process—Apparatus
     - Process can be carried out by hand or by other apparatus
       - Demonstrate by examiner's suggestion

       OR

     - Demonstrate apparatus can be used in other process (rare).
   - (5) Process and/or apparatus—Product
     - Demonstrate claimed product can be made by other process (or apparatus)
     - By examiner's suggestion

       OR

     - Process (or apparatus) can produce other product (rare)

D. Allegation of reasons for insisting upon restriction—For combination, subcombination, and elements of a combination the reasons are implicit in the determination of distinctness, see § 806.05(c)
   - Separate classification
   - Separate status in the art
   - Different fields of search

E. Summary statement
   - Summarize (1) distinctness and (2) reasons for insisting upon restriction, if applicable.
   - Include paragraph advising as to response required.
   - Indicate effect of allowances of linking claims, if any present.

818 Election and Response [R–38]

Election is the designation of the particular one of two or more disclosed inventions that will be prosecuted in the application.

A response is the reply to each point raised by the examiner's action, and may include a traverse or compliance.

A traverse of a requirement to restrict is a statement of the reasons upon which the applicant relies for his conclusion that the requirement is in error.

To be complete, a response to a requirement which merely specifies the linking claims need only include a proper election.

Where a rejection or objection is included with a restriction requirement, applicant, besides making a proper election must also distinctly and specifically point out the supposed errors in the examiner's rejection or objection. See rule 111.

818.01 Election Fixed by Action on Claims

Election becomes fixed when the claims in an application have received an action on their merits by the Office.

818.02 Election Other Than Express

Election may be made in other ways than expressly in response to a requirement.

818.02(a) By Originally Presented Claims

Where claims to another invention are properly added and entered in the case before an action is given, they are treated as original claims for purposes of restriction only.

The claims originally presented *and acted upon* by the Office on their merits determine the invention elected by an applicant, and subsequently presented claims to an invention other than that acted upon should be treated as provided in § 821.02.

818.02(b) Generic Claims Only—No Election of Species [R–38]

Where only generic claims are first presented and prosecuted in an application in which no election of a single invention has been made, and applicant later presents species claims to more than one species of the invention he must at that time indicate an election of a single species. The practice of requiring election of species in cases with only generic claims of the unduly extensive and burdensome search type is set forth in § 808.01(a).

818.02(c) By Optional Cancellation of Claims

Where applicant is claiming two or more inventions (which may be species or various types of related inventions) and as a result of action on the claims he cancels the claims to one or more of such inventions, leaving claims to one invention, and such claims are acted upon by the examiner, the claimed invention thus acted upon is elected.

818.03 Express Election and Traverse

Rule 143. Reconsideration of requirement. If the applicant disagrees with the requirement for restriction, he may request reconsideration and withdrawal or modification of the requirement, giving the reasons therefor (see rule 111). In requesting reconsideration the applicant must indicate a provisional election of one invention for prosecution, which invention shall be the one elected in the event the requirement becomes final. The requirement for restriction will be reconsidered on such a request. If the requirement is repeated and made final, the examiner will at the same time act on the claims to the invention elected.

Election in response to a requirement may be made either with or without an accompanying traverse of the requirement.

818.03(a) Response Must Be Complete

As shown by the first sentence of rule 143, the traverse to a requirement must be complete as required by rule 111(b) which reads in part: "In order to be entitled to reexamination or reconsideration, the *applicant must make request therefor in writing*, and he *must distinctly and specifically point out the supposed errors* in the examiner's action; the applicant *must respond to every ground* of objection and rejection of the prior office action_____ and the applicant's action *must appear throughout to be a bona fide attempt to advance the case to final action.* The *mere allegation* that the examiner has erred will not be received as a proper reason for such reexamination or reconsideration."

Under this rule, the applicant is required to specifically point out the reasons on which he bases his conclusion that a requirement to restrict is in error. A mere broad allegation that the requirement is in error does not comply with the requirement of rule 111. Thus the required provisional election (See § 818.03(b)) becomes an election without traverse.

818.03(b) Must Elect, Even When Requirement Is Traversed [R–18]

As noted in the second sentence of rule 143, a provisional election must be made even though the requirement is traversed.

All requirements should have as a concluding paragraph a sentence stating in substance:

> "Applicant is advised that his response to be complete must include an election consonant with the requirement, see rule 143."

The suggested concluding statement should be reworded to fit the facts of the particular requirement, e.g., as in § 809.02(a) second form paragraph under (3).

818.03(c) Must Traverse To Preserve Right of Petition

Rule 144. Petition from requirement for restriction. After a final requirement for restriction, the applicant, in addition to making any response due on the remainder of the action, may petition the Commissioner to review the requirement. Petition may be deferred until after final action on or allowance of claims to the invention elected, but must be filed not later than appeal. A petition will not be considered if reconsideration of the requirement was not requested. (See rule 181.)

818.03(d) Traverse of Non-Allowance of Linking Claims [R–18]

A traverse of the non-allowance of the linking claims is not a traverse of the requirement to restrict, it is a traverse of a holding of non-allowance.

Election combined with a traverse of the non-allowance of the linking claims only is an agreement with the position taken by the Office that restriction is proper if the linking type claim is not allowable and improper if they are allowable. If the Office allows such a claim it is bound to withdraw the requirement and to act on all linked inventions. *But once all linking claims are canceled rule 144 would not apply*, since the record would be one of agreement as to the propriety of restriction.

Where, however, there is a traverse on the ground that there is some relationship (other than and in addition to the linking type claim) that also prevents restriction, *the merits of the requirement are contested and not admitted.* Assume a particular situation of process and product made where the claim held linking is a claim to product limited by the process of making it. The traverse may set forth particular reasons justifying the conclusion that restriction is improper since the process necessarily makes the product and that there is no other present known process by which the product can be made. If restriction is made final in spite of such traverse, the right to petition is preserved even though all linking claims are canceled.

818.03(e) Applicant Must Make His Own Election

Applicant must make his own election. The examiner will not make the election for him, rule 142, rule 143, second sentence.

819 Office Generally Does Not Permit Shift

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. When claims are presented which the examiner holds are drawn to an invention other than elected he should treat the claims as outlined in § 821.03.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the non-elected invention, Ex parte Loewenbach 1904 C.D. 170, 110 O.G. 857, and In re Waugh 1943 C.D. 411; 553 O.G. 3 (CCPA).

819.01 Office May Waive Election and Permit Shift [R–38]

While applicant, as a *matter of right*, may not shift from claiming one invention to claiming another, the Office is not precluded from permitting a shift. It may do so where the shift results in no additional work or expense, and particularly where the shift reduces work as by simplifying the issues (Ex parte Heritage Pat. No. 2,375,414 decided January 26, 1944). If the examiner has accepted a shift from claiming one invention to claiming another, the case is not abandoned (Meden v. Curtis, 1905 C.D. 272; 117 O.G. 1795).

820 Not an Election; Permissible Shift

Where the Office rejects on the ground that the process is obvious, the only invention being in the product made, presenting claims to the product is not a shift (Ex parte Trevette, 1901 C.D. 170; 97 O.G. 1173).

Product elected—no shift where examiner holds invention to be in process (Ex parte Grier, 1923 C.D. 27; 309 O.G. 223).

Genus allowed, applicant may elect up to four additional species thereunder, in accordance with Rule 141, this not constituting a shift (Ex parte Sharp et al., Patent No. 2,232,739).

820.01 Old Combination Claimed—Not an Election

Where an application originally presents claims to a combination (AB), the examiner holding the novelty if any, to reside in the subcombination (B) per se only (see § 806.05(b)), and these claims are rejected on the ground of "old combination," subsequently presented claims to subcombination (B) of the originally claimed combination should not be rejected on the ground of previous election of the combination, nor should this rejection be applied to such combination claims if they are reasserted. Final rejection of the reasserted "old combination" claims is the action that should be taken. The combination and subcombination as defined by the claims under this special situation are not for distinct inventions. (See § 806.05(c).)

820.02 Interference Issues—Not an Election

Where an interference is instituted prior to an applicant's election, the subject matter of the interference issues is not elected. An applicant may, after the termination of the in-

terference, elect any one of the inventions that he claimed.

821 Treatment of Claims Held to be Drawn to Non-Elected Inventions [R–38]

Claims held to be drawn to non-elected inventions, including claims to non-elected species, are treated as indicated in §§ 821.01 through 821.03. However, for treatment of claims held to be drawn to species non-elected without traverse in applications not ready for issue (where such holding is not challenged), see §§ 809.02(c) through 809.02(e).

The propriety of a requirement to restrict, if traversed, is reviewable by petition under rule 144, In re Hengehold, 169 US PQ 473.

All claims that the examiner holds are not directed to the elected subject matter should be withdrawn from further consideration by the examiner as set forth in § 809.02(c) and §§ 821.01 through 821.03. As to one or more of such claims the applicant may traverse the examiner's holding that they are not directed to the elected subject matter. The propriety of this holding, if traversed, is *appealable*. Thus, if the examiner adheres to his position after such traverse, he should *reject* the claims to which the traverse applies on the ground that they are not directed to the elected subject matter. Claims for which no traverse is presented should be withdrawn under rule 142(b) as indicated in the other, above noted, section.

821.01 After Election With Traverse [R–26]

Where the initial requirement is traversed, it should be reconsidered. If, upon reconsideration, the examiner is still of the opinion that restriction is proper he shall repeat and make final the requirement in the next Office action. (See § 803.01). In doing so, the examiner should reply to the reasons or argument advanced by applicant in his traverse. If the examiner, upon reconsideration, is of the opinion that the requirement for restriction is improper he should state in the next Office action that the requirement for restriction is withdrawn and give an action on all the claims.

If the requirement is repeated and made final, in that and in each subsequent action, the claims to the nonelected invention should be treated substantially as follows:

"Claims _____ stand withdrawn from further consideration by the examiner, rule 142(b), as being for a nonelected invention (or species), the requirement having been traversed in paper No. _____."

This will show that applicant has retained the right to petition from the requirement under rule 144. (See § 818.03(c).)

When the case is otherwise ready for issue, and has not received a final action, the examiner should treat the case substantially as follows:

"Claims _____ stand allowed.

"This application is in condition for allowance except for the presence of claims _____ to an invention (or species) nonelected with traverse in paper No. _____. Applicant is given one month from the date of this letter to cancel the noted claims or take other appropriate action (rule 144). Failure to take action during this period will be treated as authorization to cancel the nonelected claims by examiner's amendment and pass the case for issue.

"The prosecution of this case is closed except for consideration of the above matter."

When preparing a final action in an application where there has been a traversal of a requirement for restriction, the examiner should indicate in his action that a complete response must include cancellation of the claims drawn to the non-elected invention, or other appropriate action (rule 144). Where a response to a final action has otherwise placed the application in condition for allowance, the failure to cancel claims drawn to the non-elected invention or to take appropriate action will be construed as authorization to cancel these claims by examiner's amendment and pass the case to issue after the expiration of the period for response.

Note that the petition under rule 144 must be filed "not later than appeal". This is construed to mean appeal to the Board of Appeals. If the case is ready for allowance *after* appeal and no petition has been filed, the examiner should simply cancel the non-elected claims by examiner's amendment, calling attention to the provisions of rule 144.

821.02 After Election Without Traverse

Where the initial requirement is not traversed, if adhered to, appropriate action should be given on the elected claims and the claims to the nonelected invention should be treated substantially as follows:

"Claims _____ stand withdrawn from further consideration by the examiner, rule 142(b), as being for a nonelected invention (or species). Election was made *without* traverse in paper No. _____."

This will show that applicant has *not* retained the right to petition from the requirement under rule 144.

Under these circumstances, when the case is otherwise ready for issue, the claims to the nonelected invention, including nonelected species, may be canceled by an examiner's amendment, and the case passed for issue. The examiner's amendment should state in substance:

"In view of the fact that this application is in condition for allowance except for the presence of claims _____ to an invention (or species) nonelected without traverse in paper No. _____, these claims have been canceled."

821.03 Claims for Different Invention Added After an Office Action [R–26]

Claims added by amendment following action by the examiner, §§ 818.01, 818.02(a), to an invention other than previously claimed, should be treated as indicated by rule 145.

Rule 145. Subsequent presentation of claims for different invention. If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in rules 143 and 144.

The action should take substantially the following form:

"I. Claims _____ are directed to _____ (identify the invention) elected by _____ (indicate how the invention was elected, as by original presentation of claims, election with (or without) traverse in paper No. _____, etc.) and applicant has received an action on such claims.

II. Claims _____ are for _____ (identify invention, give factual showing of reasons why, as claimed, it is distinct from elected invention, show separate classification or status, etc., i.e., make complete showing of propriety of requirement in manner similar to an original requirement).

Applicant is required to restrict the claims to the invention previously elected, and thus the claims of group II are held withdrawn from further consideration by the examiner by the prior election, rule 142(b)."

Of course, a complete action on all claims to the elected invention should be given.

Note that the above practice is intended to have no effect on the practice stated in § 1101.01.

An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the non-elected invention should not be entered. Such an amendment is non-responsive. Applicant should be notified as directed in §§ 714.03 and 714.05.

822 Claims to Inventions That Are Not Distinct in Plural Applications of Same Incentive Entity [R–29]

The treatment of plural applications of the *same inventive entity*, none of which has become a patent, is treated in rule 78 as follows:

(b) Where two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in more than one application.

See § 304 for conflicting subject matter in two applications, same inventive entity, one assigned.

See §§ 305 and 804.03 for conflicting subject matter, different inventors, common ownership.

See § 706.03(k) for rejection of one claim on another in the same application.

See §§ 706.03(w) and 706.07(b) for res judicata.

See § 709.01 for one application in interference.

See §§ 806.04(h) to 806.04(j) for species and genus in separate applications.

Wherever appropriate, such conflicting applications should be joined. This is particularly true, where the two or more applications are due to, and consonant with, a requirement to restrict which the examiner now considers to be improper.

822.01 Co-pending Before the Examiner [R–26]

Under rule 78(b) the practice relative to overlapping claims in applications copending before the examiner (and not the result of and consonant with a requirement to restrict, for which see § 804.01), is as follows:

Where claims in one application are unpatentable over claims of another application of the same inventive entity because they recite the same invention, a complete examination should be made of the claims of one application. The claims of the other application may be rejected on the claims of the one examined, *whether the claims of the one examined are allowed or not.*

In aggravated situations no other rejection need be entered on the claims held unpatentable over the claims of the other application. However, any additional claims in the one application that are not rejected on the claims of the other should be fully treated.

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901 Prior Art [R–30]

Note rule 104(a) in § 707.

901.01 Canceled Matter in U.S. Patent Files [R–18]

Canceled matter in the application file of a U.S. patent is not a proper reference as of the filing date under 35 U.S.C. 102e, see Ex parte Stalego, 154 USPQ 52. However, matter canceled from the application file wrapper of a U.S. patent may be used as prior art as of the patent date in that it then constitutes prior public knowledge under 35 U.S.C. 102(a).

901.02 Abandoned Applications [R–30]

Rule 108. Abandoned applications not cited. Abandoned applications as such will not be cited as references except those which have become abandoned as a result of the filing and acceptance of a request under rule 139.

Where an abandoned application is referred to in an issued U.S. patent the disclosure of the application is incorporated by reference into the disclosure of the patent and is available to the public. See rule 14(b).

In re Heritage, 1950 C.D. 419; 86 USPQ 160 holds that where a patent refers to and relies upon the disclosure of a copending abandoned application, such disclosure is available as a reference. See also In re Lund et al., 153 USPQ 625; 54 CCPA 1361.

It has also been held that where the reference patent refers to a copending but abandoned application which discloses subject matter in common with the patent, the effective date of the reference as to the common subject matter is the filing date of the abandoned ap-

plication. Ex parte Clifford, 49 USPQ 152; Ex parte Peterson, 63 USPQ 99; and In re Switzer et al., 612 O.G. 11; 77 USPQ 156.

Published abstracts, abbreviatures and defensive publications are references (§ 901.06(d)).

901.03 Pending Applications [R–30]

Except as provided in rule 11(b) pending U.S. applications are preserved in secrecy (rule 14(a)) and are not available as references. However, claims in one application may be rejected on the claimed subject matter of a copending application of the same inventive entity. For applications having a common assignee and different inventive entities claiming a single inventive concept see § 804.03.

Applications abandoned under rule 139 are treated as pending applications for limited time periods regarding interferences and the filing of a continuing application. (See § 711.06.)

901.04 U.S. Patents [R–35]

The following different series of U.S. patents are being, or in the past have been issued. The date of patenting given on the face of each copy is the publication date and is the one usually cited. The filing date, in most instances also given on the face of the patent, is ordinarily the effective date as a reference (35 U.S.C. 102(e)).

X-Series. These are the approximately 10,000 patents issued between 1790 and July 4, 1836. They were not originally numbered, but have been arbitrarily assigned numbers in the sequence in which they were issued. The number should *not* be cited. When copies are ordered, the patentee's name and date of issue suffice for identification. Copies in stock are arranged chronologically.

1836 Series. The mechanical, electrical, and chemical patents issued since 1836 and frequently designated as "utility" patents, are included in this series. A citation by number only is understood to refer to this series. This series comprises the bulk of all U.S. patents issued. Some U.S. patents issued in 1861 bear two numbers but only the larger number should be cited.

Reissue Series. Reissued patents (§ 1401) have been given a separate series of numbers preceded by "Re." In citing, the letters and the number must be given, e.g., Re 1776. The date that it is effective as a reference is the effective date of the original patent application, not the filing date of the reissue application.

A. I. Series. From 1838 to 1861, patents covering an inventor's improvement on his own patented device were given a separate series of numbers preceded by "A.I." to indicate Additional Improvement. In citing, the letters and the number must be given, e.g., A.I. 113. About 300 such patents were issued.

Plant Patent Series. When the statutes were amended to provide for patenting certain types of plants (Chapter 1600) these patents were given a separate series of numbers. In citing, the letters "P.P." and the number must be given, e.g., P.P. 13.

Design Patents. Patents for designs (Chapter 1500) are issued under a separate series of numbers. In citing, the letter "D" and the number must be given, e.g., D. 140,000.

ICIREPAT Numbers for Identification of Bibliographic Data on the First Page of Patent and Like Documents

The Paris Union Committee for International Cooperation in Information Retrieval Among Patent Offices (ICIREPAT) has approved revisions in INID Codes (ICIREPAT Numbers for Identification of Data) which became effective for use by the countries which apply such codes to their documents on January 1, 1973. A complete list of the Codes, as revised, appears below.

Changes in INID Codes which particularly affect their application to U.S. patents consist of the provision of the new codes [75] and [76] that are intended primarily for use by countries in which the national laws require that the inventor and applicant are normally the same. Use of the code [72] which was heretofore applied to U.S. patents has been discontinued and, in lieu thereof, codes [75] and [76], as appropriate, has been used effective with the patent issue of January 2, 1973.

The purpose of INID Codes is to provide a means whereby the various data appearing on the first page of patent and like documents can be identified without knowledge, of the language used and the laws applied. They are now used by a number of Patent Offices and have been applied to U.S. patents since Aug. 4, 1970. Some of the codes are not pertinent to the documents of a particular country and some which are may, in fact, not be used. Those codes which are not applicable to U.S. patents or not used are identified in the list below.

[10] *Document identification*

- [11] Number of the document
- [19] ICIREPAT country code, or other identification, of the country publishing the document

[20] *Domestic filing data*

- [21] Number(s) assigned to the application(s), e.g. "Numero d'enregistrement national," "Aktenzeichen"
- [22] Date(s) of filing application(s)
- [23] Other date(s) of filing, including exhibition filing date and date of filing complete specification following provisional specification[1]

See footnotes on following page.

[30] *Convention priority data* [2]

[31] Number(s) assigned to priority application(s) [1]

[32] Date(s) of filing of priority application(s) [1]

[33] Country (countries) in which priority application(s) was (were) filed [1]

[40] *Date(s) of making available to the public*

[41] Date of making available to the public by viewing, or copying on request, an unexamined document, on which no grant has taken place on or before the said date [1]

[42] Date of making available to the public by viewing, or copying on request, an examined document, on which no grant has taken place on or before the said date [1]

[43] Date of publication by printing or similar process of an unexamined document, on which no grant has taken place on or before the said date [1]

[44] Date of publication by printing or similar process of an examined document, on which no grant has taken place on or before the said date [1]

[45] Date of publication by printing or similar process of a document, on which grant has taken place on or before the said date

[46] Date of publication by printing of similar process of the claim(s) only of a document [1]

[47] Date of making available to the public by viewing, or copying on request, a document on which grant has taken place on or before the said date [1]

[50] *Technical information*

[51] International Patent Classification

[52] Domestic or national classification

[53] Universal Decimal Classification [1]

[54] Title of the invention

[55] Keywords [1]

[56] List of prior art documents, if separate from descriptive text

[57] Abstract or claim

[58] Field of search

[60] *Reference(s) to other legally related domestic document(s)* [3]

[61] Related by addition(s) [1]

[62] Related by division(s)

[63] Related by continuation(s)

[64] Related by reissue(s)

[70] *Identification of parties concerned with the document*

[71] Name(s) of applicant(s) [1]

[72] Name(s) of inventor(s) if known to be such [1]

[73] Name(s) of grantee(s)

[74] Name(s) of attorney(s) or agent(s) [1]

[75] Name(s) of inventor(s) who is(are) also applicant(s)

[76] Name(s) of inventor(s) who is(are) also applicant(s) and grantee(s)

Codes [75] and [76] are intended primarily for use by countries in which the national laws require that the inventor and applicant are normally the same. In other cases [71] and [72] or [71], [72] and [73] should generally be used.

Notes concerning the application of INID Codes to U.S. patents:

[1] This item is either not applicable to U.S. patents or, if applicable, is either not coded or not assigned this code.

[2] The respective specific data elements within this category are not individually coded. They are printed in a particular format under the caption "Foreign Application Priority Data" which is identified by the INID Code [30].

[3] The specific data applicable to a particular patent is printed under the caption "Related U.S. Application Data." Where the relationship is due solely to division or to continuation and/or continuation-in-part, the data is identified by the appropriate specific INID Code, i.e., [62] or [63], respectively. Where the relationship is due to any combination of these two specific sub-categories, the data is identified by use of the generic INID Code [60].

901.05 Foreign Patents

All countries do not issue their patent specifications in printed form. In some countries, there is a delay between the date of the patent grant and the date of publication. Generally, a foreign patent should not be cited as a reference unless the examiner has seen the patent.

Citation data pertaining to those countries from which the most patent publications are received are given in the following sections. Additional information can be obtained from the Scientific Library.

901.05(a) Citation Data

Foreign patent publications that use Arabic and Roman numerals in lieu of names to indicate the date, show in order the day, month, and year. Roman numerals always refer to the month.

Japanese patent application publications show the date in Arabic numerals, by indicating in order the year of the reign of the present Emperor, the month, and the day. To convert the Japanese year of the Emperor to the Western calendar year, add 1925 to the Japanese year. For example: 40·3·6=March 6, 1965.

Foreign language, alphabetical lists of the names of the months, and of the names and abbreviations for the United States of America are shown on the following page. The lists set forth only selected, commonly encountered foreign language names, and do not include those which are similar to the English language names and thus easily translatable.

In using the lists, identification of the foreign language (except for Russian), is not necessary. The translation into English is ascertained by alphabetically locating the foreign language name on the list.

The list of the foreign language names and abbreviations for the United States is useful in determining whether a foreign language patent publication indicates the filing of a similar application in the United States.

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Alphabetical List of Selected Foreign Language Names of Months

aaosto	August	maggio	May
goût	August	Mai	May
augusti	August	Maj	May
avřil	April	maja	May
březen	March	maraskuu	November
června	June	marca	March
července	July	mars	March
czerwca	June	Marts	March
décembre	December	März	March
dicembre	December	marzo	March
dubna	April	mei	May
elokuu	August	ottobre	October
febbraio	February	pazdziernika	October
Feber	February	prosinca	December
februari	February	října	October
février	February	settembre	September
gennaio	January	sierpnia	August
giugno	June	srpna	August
grudnia	December	stycznia	January
heinäkuu	July	syyskuu	September
helmikuu	February	tammikuu	January
huhtikuu	April	toukokuu	May
Jänner	January	unora	February
janvier	January	września	September
joulukuu	December	zari	September
juillet	July		
juin	June	RUSSIAN	
kesäkuu	June		
kvetna	May	август	August
kwietnia	April	апрель	April
leden	January	декабрь	December
lipca	July	июль	July
listopad	November	июнь	June
listopada	November	май	May
lokakuu	October	март	March
luglio	July	ноябрь	November
lutego	February	октябрь	October
maaliskuu	March	сентябрь	September
maart	March	февраль	February
		январь	January

Alphabetical List of Selected Foreign Language Names and Abbreviations for the United States of America

Amerikas Forenta Stater
De Forenete Stater av Amerika
EE. UU.
E.U.
E.U.A.
E.U.d'Am.
Etats-Unis d'Amérique
Sp.St.A.
Spoj. St.Am.
Spojene Staty Americke
Stany Zjednoczone Ameryki
Stati Uniti d'America
S.U.
S.U.A.
S.Z.A.
V.St.A.
V.St.v.A.
Ver.St.V.Am(erika)
Vereenigde Staten Van Amerika
Vereenigde Staten Van Noord-Amerika
Vereinigten Staaten Von Amerika
Vorenede Stater i Amerika

ICIREPAT Country Identification Code Letters

AU	Australia	FR	France	OE	Austria
BE	Belgium	GB	Great Britain	PO	Poland
CA	Canada	HU	Hungary	RU	Rumania
CH	Switzerland	IN	India	SF	Finland
CS	Czechoslovakia	IT	Italy	SU	USSR
DK	Denmark	JA	Japan	SW	Sweden
DL	East Germany	NL	Netherlands	US	USA
DT	Germany, Fed. Rep.	NO	Norway	YU	Yugoslavia
EI	Ireland				

901.05(b) Other Significant Data [R–44]

Occasionally, the exact date of foreign patenting becomes material. In the case of Australia, Austria, East Germany, India, Ireland, United Kingdom and U.S.S.R., it does not appear on the printed copies of the patents. If necessary, this information can be secured from the Scientific Library.

For the effective dates of Belgian patents, see the Memorandum of March 2, 1959, which has been reproduced in 41 J.P.O.S. at page 440.

For the effective dates of Italian patents, see the Memorandum of October 25, 1960 distributed to all examiners and published in 42 J.P.O.S. 795–8.

Comments concerning German, French and Belgian procedure in granting patents are found in Ex parte Gruschwitz et al., 138 USPQ 505. This case did not involve anticipation but the bar of foreign patenting under 35 U.S.C. 102(d). The Board of Appeals has held that a Japanese application was "patented" upon its publication date, Ex parte Iizuka, 171 USPQ 50.

A German Offenlegungsschriften publication is not considered to be a patent under 35 U.S.C. 103(d), Ex parte Links, 184 USPQ 429 (Bd. of Appls. 1974). However, a German Auslegeschrift publication is considered to provide the legal effect of a patent under 35 U.S.C. 102(d), Ex parte Beik and Thiele, 161 USPQ 795 (Bd. of Appls. 1968).

Some countries issue patents of addition and they should be identified as such and, when separately numbered as in France, the number of the addition patent should be cited.

"Patents of addition" generally cover improvements of a patented parent invention and can be obtained by the proprietor of the parent invention. Inventiveness in relation to the parent invention need not be demonstrated and the term is governed by the term of the parent patent.

For citation of the number of pages of drawing and specification, see § 707.05(e).

Some foreign countries list the references cited during the prosecution. These, especially if they are U.S. patents, may be helpful, either as references of interest to the examiner or to suggest an overlooked field of search.

For additional information on foreign patent practices see "Foreign Patent Material" by P. J. Federico, 54 JPOS 102 and 147, February and March, 1972.

Federal Republic of Germany

German allowed applications have been issued in printed form beginning September 1, 1955. Those printed from this date up to December 31, 1956, are captioned "Patentanmeldung." They should be cited as "German printed applications" and identified by the name of the applicant, the serial number of the application, and the date of publication. They are printed on white paper. The applications printed after January 1, 1957, are printed on green paper and are captioned "Auslegeschrift" and have an additional number which is larger than 1,000,000 and which will be the number of the patent, if issued. This new number should be used instead of the original serial number. When and if the patent is granted, the specification is printed again on white paper with the same number.

On October 1, 1968, the West German Patent Office shifted to a deferred examination procedure. Under this procedure all pending applications are printed on yellow paper at 18 months after the filing or claimed priority date as "Offenlegungsschriften". The numbering system is larger than 1,400,000.

German Utility Models (Gebrauchsmuster) may be used as references as prior patents, but not as prior printed publications since the full specifications are not printed effective as of their registration date. When necessary, the Librarian will obtain the complete text of the specification from the German Patent Office. A file of such copies is maintained in the Scientific Library.

Netherlands

Netherlands applications, unless withdrawn, are printed beginning January 1, 1964. They are captioned "Octrooiaanvrage". They should be cited as Netherlands *applications* giving the number, date of publication, "Datum van ter inzagelling", name of applicant, "Aanvrager", and data customarily given in citing foreign patents.

United Kingdom

Certain United Kingdom applications had become void and hence lack a date of acceptance. Nevertheless, they were given a number in the patent series. The date of publication (year only) is given following the statement "Printed for His Majesty's Stationery Office," and this should be cited.

British specifications prior to 1916 have printed in large heavy type at the head of the first page of the specification a number and year, as 1451 A.D. 1912. This, together with the name, as required by the rules, is always the proper citation of the patent. The year given at the head of the specification is either the year of filing or the year of acceptance, but in either case it is the official designation of the patent.

The year printed on the drawing is not always the year for correct designation of the patent. Where it is not, the correct year is shown by a small superior number or exponent placed to the right and above the serial number of the patent, as—

1910—No. 499 [11]
1912—No. 19421 [13]

In instances of this kind the patent should be cited as No. 499 of 1911 or No. 19421 of 1913.

FRANCE

The date of recent French patents to be taken as the effective date *as a patent* for reference purposes is the date of the Official Bulletin of the French Patent Office (Bulletin Officiel de la Propriété Industrielle) in which the granting of the patent was announced. This date does not appear on the printed copies of the specifications of the patents. The printed copies give the date the patent was granted (délivré) and the number of the particular issue of the Official Bulletin in which the granting of the patent was announced. The date of the issue of the Bulletin, if needed, may be obtained from the Bulletin itself in the Library and would be about five or six weeks later than the granting date. The granting date may be used for citation purposes but if the precise date is critical the effective date should also be given.

The date used as the effective date when the patent is used as a patent (rather than as a printed publication which date is later) has been the date on which the patent was granted, indicated on the printed copies by the word "délivré", as was established by decisions of the courts, the Commissioner, and the Board of Appeals. Owing to a change in the practice in the French Patent Office whereby the specifications of granted patents are now not available to the public until the date of the Official Bulletin, it is necessary to apply *In re* Af Ekenstam, 45 CCPA 1022, 256 F.2d 321, 1958 CD 402, 734 OG 290, 118 USPQ 349; and use the date on which the specification became available to the public as the effective date as a reference. This practice will apply to recent French patents, going back to number 1,148,401 announced in the Official Bulletin of July 11, 1957 and back to patent of addition number 67,251. No change in practice is indicated with respect to French patents prior to these numbers.

SWITZERLAND

The effective dates of Swiss patents are discussed in *Ex parte* Reuge, 115 USPQ 51 and in *Ex parte* Appeal No. 194–38, 1966 CD 31, 152 USPQ 70. It should be noted that two different systems are in operation in Switzerland. The majority of patents are issued without search and examination in the light of references, and the date used for these is the publication (veröffentlicht, publié, pubblicato) date. In two fields, inventions relating to time-keeping, and inventions relating to the non-mechanical treatment of textiles and fibers, applications are searched and examined in the light of the prior art and the procedure differs from that followed in the other cases; it follows, in general, the procedure in the Federal Republic of Germany as described in *Ex parte* Gruschwitz et al., 1963 CD 859, 138 USPQ 505. Patents which have been issued under the examination system can be recognized from information given in the heading which refers to the publication of the application (the French and German language applications, Demande publiée and Gesuch bekanntgemacht, respectively). As in the German practice, when a case is found allowable by the examiner the application is published for opposition and the specification is issued in printed form (also referred to as Auslegeschrift, German and Mémoire expose, French). These printed copies have not been received by the Office. If it becomes necessary in connection with a Swiss patent issued under the examination system to establish a date earlier than the date the patent was granted, the library can obtain a copy of the earlier printed application from the Swiss Patent Office.

901.05(c) Obtaining Copies [R–28]

Photocopies of foreign patents can be ordered by an examiner for placement in the shoes of a class in which he examines, if the patents would be of frequent use in that class (§ 905.01).

901.05(d) Translation [R–30]

Examiners may request translators in the Reference Section to assist them orally or with written translations of any specifications in languages with which the examiner is not familiar. (See § 901.06(a), *Translations—Requests for Translations*, and § 903.03, *Classification of Foreign Patents*, below.) Alternative versions of specifications, in English or other languages known to the examiner, can commonly be found. Searches for alternate versions are performed in the Stack Service Section of the Scientific Library. As a substitute for translation, this service materially reduces the apparent problem posed by a foreign language specification.

901.06 Non-Patent Publications [R-28]

All printed publications may be used as references, the date to be cited being the publication date. Recognized abbreviations of names of periodicals may be used in their citation (§ 707.05(e)).

There are some publications kept or circulated in every group and each assistant examiner should ascertain which are available in his group and whether or not any of them is likely to bear on any class assigned to him.

Science Abstracts of London, England provides the Patent Office with certain non-patent literature. This literature includes the following:

A. A copy of the full text of the article;
B. An English language abstract attached to the full text of the article;
C. Bibliographic details;
D. United States Classification including class and subclass, where necessary addi-

tional copies are provided. The International Patent Classification (I.P.C.) is provided on each document by the Scientific Library;

E. A document identification number preceded by the alpha character S followed by an eight digit number (e.g. S00840001).

The United States classification as well as the International Patent Classification (I.P.C.) is placed on each document made of record and stamped "RECORDED" by the Scientific Library. No change in status of the document (e.g. changing classification, cancelling or adding of copies) should be made unless the Scientific Library is notified. Form PO–1122 should be used for this purpose. The form should include the document identification number, group art unit, status change and the name of the examiner. The completed form should be forwarded to the Foreign Patent Services and Records Section of the Scientific Library. If the status change involves placing additional copies of the document, the document should be forwarded along with the completed form to the Scientific Library where the additional copies will be made. If the change in classification places the "RECORDED" non-patent literature document in another examining group, the completed PO–1122 form should be attached to the document and forwarded to the new group. The examiner in the new group should complete the form and forward it to the Scientific Library.

Where a non-patent literature reference with a document identification number is cited, the identification number and the class and subclass should be included on the form PO–892.

The citation should be as follows: (S00840001) Winslow, C.E.A. *Fresh Air and Ventilation* N.Y., E. P. Dutton, 1926, p. 97–112, TH 7653. W5, 315–22.

If the cited document has a document identification number, it is not necessary to enclose a copy in the ROS folder.

901.06(a) Scientific Library [R–30]

35 U.S.C. 8. Library. The Commissioner shall maintain a library of scientific and other works and periodicals, both foreign and domestic, in the Patent Office to aid the officers in the discharge of their duties.

The technical literature, foreign patents and services supplied by the Scientific Library are important to the examiner for two primary reasons. In the first place, they provide material which must be known or searched to determine whether claims of applications are directly anticipated, and therefore unpatentable under the provisions of 35 U.S.C. 102. In the second place, in cases in which the primary search indicates that there is some novelty as compared to any single reference in the art, the library handbooks, textbooks, periodicals, reports and other materials assist in deciding the question of patentable invention (35 U.S.C. 103). They enable the examiner to make a further study to determine whether the features novel in the particular combination searched would be obvious to a person skilled in the art from the general state of knowledge as reflected in the technical literature.

Materials Available

Foreign Patents

The Library receives foreign patents by exchange from almost all countries (26 countries) that print their patents. In most cases, two copies are received: one for the examiners' search files and one for the numerical set in the Library. Since July, 1969, the numerical set for the following countries has been placed on 16 mm microfilm reels: Canada, France (applications and patents), Germany (applications and patents), Great Britain, Japan, Netherlands (applications only), U.S.S.R., and Switzerland. The second copy of the foreign patent, with a translation of the main claim or an English language abstract, is sent to the examining group (§ 903.03). Patents on which there is no date of publication (Australia, France and Italy) show the date of receipt in the Library. Soviet and Bulgarian authors' certificates are date-stamped even though a "date of publication" appears thereon because there is some doubt whether "publication" means "printing."

Foreign Patent Journals

Most foreign countries issue official patent and trademark journals corresponding to the *Official Gazette*. Patent journals are shelved under country names in the patent collections, and with the numerical sets of those countries which print their patents. Trademark journals are retained for only 4 months. Most countries issue name indexes; some also issue classified indexes. These are shelved with the journals.

Books

A representative selection of books published in the United States and Great Britain in the fields of applied technology is systematically acquired by the Library. In addition to the English language books, there is a modest selection from French and German literature, mostly in the field of chemistry. There are also collections in the various examining groups of books and trade catalogs pertinent to the arts which they examine. The Design Patent

Group has a great many manufacturers' catalogs.

In selecting books and periodicals to be ordered, the Librarian and his staff obtain assistance from members of the examining corps, and suggestions concerning materials to be obtained are welcomed at any time. A monthly list of accessions is circulated to all examining groups at the beginning of each month and the books are placed on inspection in the Library for one week thereafter. Duplicate copies of books on this list, or any other pertinent book, may be ordered by examiners for use in the groups by addressing a memorandum to the Chief Librarian via the group director and the cost code clearance officer.

The books and trade catalogs procured for permanent assignment to the examining groups are recorded in the Library's main catalog, and copies of these books sometimes are available in the Library also.

Technical Periodicals

Over 1,500 technical periodicals are received. These include publications of many important scientific and technical societies. The list includes a number of titles in the design patent field and in fields of interest to non-examining areas of the Office.

Most of the periodicals received by the Library are circulated to examining groups. Once each year the Library sends to each group a list of all titles currently circulated to them with request for suggestions for changes. This systematic procedure does not preclude the requesting of subscriptions for new titles at any time, and the Library itself will occasionally add new titles. The Library is alert to new periodical publications and it acquires sample copies which it sends to groups likely to be interested with a request for review and recommendation.

An important part of the duties of each examiner involves constant inspection of non-patent literature pertinent to the class or classes that he examines. The Library has undertaken to assist in this time-consuming activity. In one subject area, articles are being pre-selected and classified under the U.S. system by an outside indexing service. In a subsection of the same subject areas, articles are being pre-selected by library staff members. Before addition to the search files, selections must be assigned a code number and microfilmed so that the library will have a record of search file contents and can reproduce material cited without pulling it from the files or from the library shelves. Before adding any non-patent literature to the files, examiners should forward the literature to the Library for the assignment of code numbers and for filming.

Library Services
Non-Patent Literature

Encyclopedic works, published indexes, and abstracting vehicles which assist searches in patents and technical literatures are constantly increasing in number and quality. The Library welcomes suggestions for acquisition of available or forthcoming aids to searching. In conducting library searches, examiners are encouraged to supplement their own familiarity, skill, and available time by queries addressed to the Reference Section of the Library (Ext. 72957).

The Staff of the Reference Section (Ext. 72957) will assist examiners in the use of the card catalogs and other resources of the Library, in pointing out publications which will help examiners define the limits of the field of search, and in providing information for use in prior art searches. Upon request, it will provide bibliographies on given subjects. It will also accept requests for all information on specific subjects defined by keywords and/or class and subclass designation.

Main Catalog

This card catalog is located in the Reference Room and lists all materials in the Library, the Law Library and examining groups except patent specifications and government reports on microfiche. If an examiner finds that the book he desires is not on the shelf he may be able to ascertain through the card catalog that another copy is available elsewhere in the Office. Examiners sometimes acquire material independently of the Library, and it is important that any such material should be sent to the Library's Technical Processes Branch for cataloging to assure that it may be recorded for the benefit of the entire Office.

The Library of Congress classification scheme is used in classifying the books and bound periodicals. A printed outline of this scheme is kept on one of the reading tables on the second floor and a shorter outline is posted on the end of two of the book stacks. Examiners will find the outline helpful in determining the general subject area of the field in which they are interested. Catalog cards are made for the author, title when distinctive, and subjects. Bound volumes of periodicals are cataloged, classified and maintained on the bookshelves, while those which have not yet been bound are separately located in alphabetical order in a small reading room adjoining the Reference Room. Near the main card catalog, there is a separate card list-

ing of bound periodicals and foreign patent and trademark journals.

Foreign Patent Information

Upon request made to the Foreign Patent Services and Records Section (Ext. 73545) the Library will procure individual typewritten copies of patents from countries which issue, but do not print them. Where applicable, the dates of opening to inspection, of issuance and of publication will be requested of the foreign patent office. The copy of each patent so acquired is retained in a special file in the Foreign Patent Services and Records Section, and a photocopy thereof is submitted to the examiner. As requested by examiners, it performs searches in foreign patent journals to ascertain the dates of opening to public inspection, of grant or sealing, and of publication of specified foreign patent applications. It will also make searches to locate patents with an earlier date or in a more familiar language.

Loan of Books and Other Publications

General

All Library materials other than the books in the main reference collection in the Reference Room may be charged out at the circulation desk. Materials should be kept as briefly as possible, and ordinarily no longer than two weeks. Since all library materials are used for reference purposes, none may be taken outside of the Patent Office. Examiners may use the Commerce Department Library but may not charge out its books. Books needed from that Library for official use should be obtained through the Scientific Library by means of interlibrary loan as described in the following paragraph.

Interlibrary Loans

On request the Reference Section (Ext. 72959) will borrow from other libraries materials not available in the Scientific Library. In return for this service, the Library loans its materials to other libraries in the District of Columbia so that occasionally an examiner may find that the item he desires is unavailable. These materials which are out on interlibrary loan may be recalled for the examiner if required for immediate use. To borrow books from another library is costly in terms of both time and effort; therefore, it is library policy not to borrow materials unless strictly pertinent to official use. Law books cannot be borrowed by the Library for use by examiners in connection with law courses.

When a book or periodical is borrowed from another library, and cited in an Office action, a photocopy of the portion cited should be ordered immediately and placed in an appropriate class and subclass. This class and subclass should be cited in the Office action.

Publication Dates

Requests pertaining to the earliest date of publication or first distribution to the public of publications and patents should be made to the Reference Section. They can obtain the day and month of publication claimed by the copyright owner for United States publications and they will write to the foreign source.

Translations

Requests for Translations

Examiners may consult the translators in the Reference Section at any time for oral assistance in translating foreign patents or literature. Translations are made from all of the principal European languages and from Japanese. The Library will have required translations from other languages made elsewhere. (Ext. 73193)

Card Index of Available Translations

This index lists all translations which have been made by the Reference Section of the Library and a few others gathered from miscellaneous sources. The card file and over 10,000 translations of foreign patents and trademarks with some periodical articles and excerpts from books are located in the Reference Section. Translations, which are available to examiners and non-Office personnel, are indexed by country, patent or trademark number, and patentee or author. A copy of any translations coming to an examiner from outside of the Office should be furnished to the Reference Section so that it may make a copy for its files. In this case the source is indicated on the translation so that it will not be certified as an official translation of the Patent Office.

901.06(b) Borrowed Publications [R–30]

See § 901.06(a), Interlibrary Loans.

901.06(c) Alien Property Custodian Publications [R–23]

Applications vested in the Alien Property Custodian during World War II were published in 1943 even though they had not become patents.

Care must be taken not to refer to these publications as patents; they should be designated as A.P.C. published applications.

An A.P.C. published application may be used by the examiner as a basis for rejection only as a printed publication effective from the date of publication which is printed on each copy.

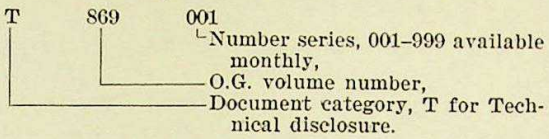
The manner of citing one of these publications is as follows: A.P.C. Application of ----------, Ser. No. ------, Published ------ ----------

The Scientific Library contains a complete set of A.P.C. published applications arranged numerically in bound volumes.

901.06(d) Abstracts, Abbreviatures and Defensive Publications [R–23]

Abstracts and Abbreviatures are Patent Office publications of abandoned applications. Defensive Publications (the O.G. defensive publication and search copy) are Patent Office publications of a provisionally abandoned application wherein the applicant retains his rights to an interference for a limited time period of five years from the earliest effective U.S. filing date. See §§ 711.06 and 711.06(a).

Distinct numbers are assigned to all Defensive Publications published after December 16, 1969, for example.



Defensive Publications are included in subclass lists and subscription orders. The distinct numbers are used for all official reference and document copy requirements.

A conversion table from the application serial number to the distinct number for all Defensive Publications published before December 16, 1969 appears at 869 O.G. 687.

901.07 Arrangement of Art in Examining Groups [R–30]

In the examining groups the U.S. patents are arranged in shoes bearing appropriate labels, each showing the class, sub-class, and usually the lowest and highest numbered patents put in the respective shoe. The patents should be arranged in numerical order.

Some U.S. copies are marked "Cross Reference." These are patents which are classified

in other classes or subclasses but which have disclosures pertinent to the subclasses in which they are placed as cross references. Cross reference copies may be filed in the shoes along with the copies of the original patents to simplify the tasks of searching and filing.

Copies of foreign patents are usually kept in shoes separate from and immediately following the U.S. patents.

All foreign patent documents (patents and published applications) involved in a reclassification project issued after January 1, 1974 are filed by year of publication only, within each subclass. Each such foreign patent document has the year of publication written in red in the upper right-hand corner of the front page. It is anticipated that eventually all the classified foreign patent document search files will be arranged in this manner. This filing arrangement aids the examiner in updating his search as well as the Office of Patent Classification in the maintenance of the integrity of the search files.

Non-patent publications or photocopies thereof containing disclosures for particular subclasses, if numerous, should be filed in shoes following the foreign patents, otherwise at the bottom of the last shoe of foreign patents. [R–39]

901.08 Borrowing References [R–23]

The search files in each examining group should at all times be complete. Where they are incomplete, the examiners using such files and relying upon their completeness may miss valuable references. References removed from the files whether for use in the group or otherwise should, of course, be promptly returned.

901.09 Missing Copies—Replacement [R–42]

When the original or cross-reference hard copy of a reference patent is missing from the examiner's search files, a soft copy request form (PO–14) should be sent to the Office of Patent Classification. The box marked NOTES on PO–14 should include either the expression "Substitute for original" or "Substitute for official cross-reference" and also the classification information for the patent.

When the form PO–14 requesting a substitute copy is received by the Office of Patent Classification, it will provide a hard copy patent. If the original copy is subsequently found, the substitute copy should be removed from the file and discarded.

902 Official Publications and Indices of U.S. Patents

902.01 Manual of Classification [R–23]

The Manual of Classification is published in loose-leaf form, and supplementary sheets containing changes are issued from time to time to replace the original sheets.

All manual changes are effected by a series of Classification Orders each of which is currently published in the Official Gazette to the extent necessary to keep the manuals up to date. As these changes are published, each examiner should enter them in his manual, so that his manual will at all times be complete and up-to-date. As supplementary sheets are issued, the old sheets should be removed, and the new sheets substituted therefor.

There are over 300 classes of utility inventions each having a title descriptive of its subject matter and being identified by one of a series of class numbers (some numbers of the series are blank and not presently assigned to any class). Each class is subdivided into a number of subclasses with each subclass bearing a title descriptive of its subject matter and being identified by a subclass number which in many instances will include decimal fractions. A complete identification of a subclass requires both the class and subclass numbers, the class number appearing first and the subclass number second, e.g., "103–161" identifies Class 103, Subclass 161.

The Manual of Classification has the following parts:

A Brief Statement on the Use of the Manual.

Classes Arranged by Related Subjects. Tabulation of classes, in which the classes are arranged in three major subject groups, with the classes listed under each group by relationship of subject matter. This tabulation is for the purpose of assisting the user in finding the main class pertinent to his search.

Classes Arranged by Examining Groups.

Classes Listed Alphabetically by title.

Classes Listed Numerically with titles.

Subclass Schedules. Complete subclass schedules for each class, the utility classes appearing first in numerical sequence of class numbers, and then the design classes in numerical sequence of design class numbers. Design class alphabetical sequence by class names corresponds to numerical sequence. This is not true of the utility classes.

Alphabetical Index. Words and phrases (frequently called titles) identifying various characters of patentable subjects arranged in alphabetical order, with the citation of a class or both class and subclass in which subject matter identified by the title will be found.

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902.02 Definitions [R–23]

All of the utility classes (i.e., classes devoted to technology) except a few unrevised classes have definitions. None of the design classes has definitions.

Such definitions state the subject matter that is found in each defined class and subclass much more explicitly than it is possible to state in short class and subclass titles.

Each examining group has at least one set of definitions and there are several sets in the Public Search Room. Additional or replacement sheets incorporating all changes and additions are issued from time to time and should be promptly added to each set of definitions.

902.02(a) Search Notes

The definitions have search notes as a part thereof; namely, notes giving information as to where subject matter related to the class will be found (such notes appearing after the class definition), and also notes as to where subject matter pertinent to the subclass will be found (appearing after the subclass definition). These notes are intended to indicate both the relationship and the difference between the separately classified subjects.

Such search notes are not exhaustive and should be regarded as suggestive of additional fields of search, but not as limiting the search.

902.02(b) Search Cards [R–23]

In one shoe of each defined subclass in both the examining group and the Public Search Room is a "Search Card" having the definition of the subclass and the search notes if any.

902.03 U.S. Patent Classification Indices [R–23]

A number of indices of U.S. patents are available and may be used to obtain classification data of U.S. patents.

902.03(a) Numerical [R–42]

A numerical index of domestic patents giving their present original classification is available in the Public Search Room and in the Documentation Service Branch in the form of a microfilm viewer which is controlled by a minicomputer.

There is a separate index for each series, X, 1836, AI, Re, PP and D. Information as to both the original classification and official cross-reference classification of all U.S. patents is available from the patent index telephone, Ext. 73951. This is a multiple line telephone and problems with busy signals should be minimal. Classification information is contained on strip microfilm with quick lookup available by use of a viewer connected to a mini-computer. The data is updated with new issues and reclassification projects.

902.03(b) Blue Slips [R–23]

The "blue" issue classification slips (Form PO–270), starting with patent number 1,987,000, RE. 19,228, D 126,796, P.P. 1, and for all subsequently issued patents, and containing the original classification and cross-references ordered at time of issue are on file in the Documentation Service Branch.

902.03(c) Subclass Lists [R–42]

Tabulated lists for each subclass can be obtained, one list for originals and one list for cross-reference and published abstracts of U.S. applications.

902.03(d) Count [R–39]

In the Service Branch of the Office of Patent Classification, is maintained a subclass "count," giving the number of U.S. patents originally classified in each class and subclass, and a corresponding "count" for cross-referenced U.S. patents.

902.04 Classification Orders and Bulletins [R–23]

Classification Orders are issued from time to time giving all changes in the classification that have been made officially, including every change to be made in the Manual of Classification or in the definition books.

Copies are distributed to all examining groups for immediate use.

Each order, except for those portions pertaining to the amendment of existing definitions, is subsequently printed in the Official Gazette.

These orders are from time to time collected and issued as a Classification Bulletin. As class schedules and definitions are extensively amended to take care of developments subsequent to original classification, they are republished in amended form in Classification Bulletins.

903 Classification

903.01 Statutory Authority [R–23]

The statutory authority for establishing and maintaining a classification is given in the following statute, which states:

35 U.S.C. 9. Classification of patents. The Commissioner may revise and maintain the classification

by subject matter of United States letters patent, and such other patents and printed publications as may be necessary or practicable, for the purpose of determining with readiness and accuracy the novelty of inventions for which applications for patent are filed.

903.02 Basis and Principles of Classification [R–23]

The basis of classification used in the U.S. Patent Office, the principles followed, and the reasons why such principles were adopted are set forth in the booklet *Development and Use of Patent Classification Systems*, which is available in each art unit. Since classification is the basic tool of every examiner, this booklet, particularly as it relates to the present classification system, should be carefully studied.

Unofficial subclasses and digests made by examiners, if made in accordance with the plan of classification, could be defined and issued as an official part of the classification. See § 905.02 for procedure for ordering patent copies for use as unofficial cross-references.

Examiners establishing unofficial subclasses or digests should consult the patent classifier having jurisdiction of the class to the end that, when the work is completed, it can be defined and made official.

903.02(a) New and Revised Classes [R–23]

The establishment of new classes or subclasses and the revision of old classes are done under the supervision of a patent classifier.

The Classifier performing the reclassification secures a set of patent copies of the present classification, by either ordering soft copies or borrowing the Public Search Room copies. With these copies, by study and successive groupings, he develops an arrangement of the patents which is satisfactory for searching.

The lines marking the confines of the new or revised class and its subclasses are determined, and appropriate definitions drawn. Then the examiner's and the Public Search Room's copies of the patents included in the new class are collected, arranged and stamped conformably to the new classification. Official cross-references are also prepared and appropriately stamped.

The patents comprised in the new class are entered upon the numerical and subclass indices.

Notification of the new class or subclass is published in the Official Gazette, and Supplementary sheets necessary to correct the loose leaf Manual of Classification are published.

Definitions of all revised classes and subclasses are found in the Classification Bulletins.

903.02(b) Scope of a Class

In using any classification system, it is necessary to analyze the organization of the class or classes to be included in the search.

The initial analysis should determine which one or ones of the several types of subject matter (manufacture, art, apparatus or starting material) are contained in the class being considered.

Further, relative to each type of subject matter, it is necessary to consider each of the various combinations and subcombinations set out below:

Feature Combined with Basic Subject Matter for Some Added Purpose. The added purpose is in excess of the scope of the subject matter for the class, as defined in the class definition, e.g., adding a sifter to a stone crusher which gives the added function of separating the crushed stone.

Feature Combined to Perfect the Basic Subject Matter. Features may be added to the basic subject matter which do not change the character thereof, but do perfect it for its intended purpose, e.g., an overload release means tends to perfect a stone crusher by providing means to stop it on overload and thus prevent ruining the machine. However, this perfecting combined feature adds nothing to the basic character of the machine.

Basic Subject Matter. The combination of features necessary and essential to the fundamental character of the subject matter treated, e.g., a stone crusher requires a minimum number of features as essential before it can function as such.

Subcombinations Specialized to Basic Subject Matter. Each type of basic subject matter may have subcombinations specialized to use therewith, e.g., the crusing element of a stone crusher.

Subcombinations of General Utility. Each type of basic subject matter may have subcombinations which have utility with other and different types of subject matter, e.g., the machine elements of a stone crusher. Subcombinations of this character usually are provided for in some general class so that the examiner should determine in each instance where they are classified.

903.03 Classification of Foreign Patents [R–26]

Foreign patents are distributed by the Scientific Library to the examining groups with forms 1121 attached. The examiner should indicate the proper classification on both the foreign patent and form 1121.

If the foreign patent is not properly classifiable in his group, the examiner should suggest a group in which he considers it to be classifiable if possible and return it to the Scientific Library. Any indication of classification made by the Library is advisory only, and the final decision as to where the patent is to be placed is made by the examiner in whose art it is classifiable.

All subclasses in which a copy of the foreign patent is desired should be indicated on form 1121. The file clerk will order any necessary additional copies and place the classification indicated on form 1121 on them.

All foreign patents should be classified and forms 1121 returned to the Scientific Library by the due date indicated on form 1121.

If the examiner desires to update the classification of a foreign patent by changing, cancelling or adding copies, he should notify the Scientific Library by forwarding a completed form PO–1122.

It is helpful if the copy is either folded or disassembled and re-stapled so that the most significant sheet of drawing is exposed when the copy is in the shoe case. NOTE: Since the Library retains copies of these and other foreign patents (See § 901.06(a)), a desired foreign patent, known by country and number, can be inspected in the Library or photocopies ordered.

The Search Center forwards to the examining groups all United Kingdom, French, Swiss, German, Japanese and Soviet Union patents or published applications and only those other foreign patents or published applications which do not claim priority elsewhere. Duplicates from these countries should be retained in the files to comply with the minimum documentation requirements of the proposed Patent Cooperation Treaty.

Unnecessary duplicates should be destroyed.

When a partial translation is desired, return the patent to the Translation Section, Scientific Library, with the word "Title" or "Claim" or other specific portion indicated thereon.

The Library invites examiners confronted with language problems in classifying foreign-language patents to call upon its translators for oral language assistance to be provided at the examiners' desks. Examiners are accordingly encouraged to request this help by contacting the Translation Section by phone. Examiners are privileged to ask for specific translators if they so desire.

Time spent in classifying foreign patents is allowed in computing an examiner's output. The method used in classifying foreign patents and the assignment of such work among the examiners of the group are left to the supervisory primary examiners. The hours spent by each examiner on this work are noted on the individual examiner's record of "Other" time (PO–690E).

903.04 Stamping of Examiner's and Search Room Copies [R–38]

Before each application in issue becomes a patent, the Issue and Gazette Division forwards the issue slip and the printed examiner's and Search Room copies of the patent to the Weekly Issue Section for stamping and recording of the classification of the patent, preparation of cross-references and transmittal to the examiner and Search Room on the date of the patent.

After they are so stamped and recorded, the photolithographic copies are retained in the respective classes in the groups and no changes in the classification or the arrangement of the copies are permitted except as set out in § 903.05.

The classification printed in the heading of patents issued since 1933 cannot always be relied upon to be the present original classification, since this data is obtained from the file wrapper of the application at time of issue and will not reflect any changes in classification made after the issuance of the patent.

903.05 Transfer of U.S. Patents [R–38]

The transfer of official copies of U.S. patents, either original or cross-reference, from one class or subclass to another requires the approval of a classifier.

Examiners must submit to the Office of Patent Classification all questions of transfer of patents.

When an examiner desires to transfer official copies of domestic patents to a different class or subclass, he should have a memorandum list prepared for signature of the primary examiner of the numbers of all patents which are to be transferred indicating only the class and subclass into which each is to be placed. Both originals and properly identified official cross-references may be included in the same list and these may involve transfers to or from any number of different classes or subclasses. Additional cross-reference copies of any listed patent may also be requested. This list with the examiner's copies of the patents is routed through any other group involved for its prompt approval or comment and is forwarded to the Office of Patent Classification.

In those instances where a transfer is approved by a patent classifier, the class and subclass designations on both the examiner and Public Search Room copies of the patents are changed and the numerical patent index and subclass lists are altered to agree with the new classification. When the transfer is not approved, the copies of the patents will be returned with a notification thereof.

Unauthorized transfers render the subclasses in the Public Search Room no longer duplicates of those in the examiners' rooms, and also render incorrect the official numerical index and subclass lists.

When it becomes necessary in the course of a transfer to remove copies from the files in the Public Search Room, a dummy a little longer than a patent copy is substituted therefor, and the identification data of the patents withdrawn are written thereon.

The procedure for transferring an entire class or subclass from one group to another is given in the Manual of Clerical Operations.

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903.06 Practice To Be Followed in Ordering Official Cross-References [R–43]

The following alternatives are available for obtaining official cross-reference copies of United States patents.

a. Send to the classification group a list of patents and relative to each patent, indicate the class and subclass in which it is thought each should be cross-referenced.

b. The preferred mode of ordering a cross-reference where the examiner has a soft copy with the pertinent portion marked, is to indicate on the marked soft copy the class and subclass in which it is thought it should be cross-referenced. Such soft copy should be forwarded to the classification group where it will be promptly inspected, the necessary action taken and the soft copy returned within two days of its receipt.

903.06(a) Discovery of New Cross-References [R–43]

Patents which are useful as references may be found either in the course of a search or from inspection of the Official Gazette each week. Copies may be placed in the examiner's search files. See § 905.02.

903.07 Classifying and Cross-Referencing at Allowance [R–43]

It is the duty of each primary examiner to personally review the classification and cross-referencing made by his assistants of every application passed for issue and to print his full name on the blue issue classification slip to show that this review has been made.

Both the blue issue classification slip (PO–270) and the file wrapper provide spaces for the full names of the "Assistant Examiner" and "Primary Examiner."

An examiner with full signatory authority who acts on an application himself and sends it to issue should write his full name on the blue issue slip and stamp and initial the file wrapper *only* in the "Primary Examiner" space. A line should be drawn through the "Assistant Examiner" spaces on both the blue issue slip and the file wrapper to make it clear that the absence of an initial or signature in the box was not an oversight.

The initial classification of pending applications and the drawings thereof will have been indicated in pencil by the supervisory primary examiner. See § 903.08(b).

However, an application, properly classified at the start of examination, may be improperly classified when it is ready for allowance. The allowed claims should be reviewed, in order to determine the subject matter covered thereby. It is the disclosed subject matter covered by the allowed claims that determines the original classification of U.S. patents.

Only the correct official classification should be left on the file and drawing of each application when passed for issue.

The examiner fills out a blue issue classification slip (PO–270) or a salmon slip (PO–328) in the case of designs to indicate the class and subclass in which the patent should be classified and also the classes in which it should appear as a cross reference. The examiner should be certain that all subclasses into which he places cross-references are still in existence. The examiner attaches the blue issue classification slip to the inside of the left fold of the file wrapper to be forwarded to the Patent Issue Division.

The examiner also enters the classification appearing on the issue classification slip in the space provided on the front of the file and in the space provided in the stamping at the left margin of the drawing. Care should be exercised to see that all three entries of the classification are correct and in agreement, particularly after any alteration of one entry, for otherwise the patent will be printed with an erroneous classification or improperly positioned in the Official Gazette.

All examiners are requested to fill in the class and subclass on the drawings in large numerals using as much of the space provided as feasible. In this way the filing of drawings and subsequent retrieval by the Patent Issue Division will be greatly aided. See also § 1302.10.

All examiners must include unofficial subclass designators on the blue issue slips (PO–270) at the time of issue when appropriate (excluding design classes). This applies to both the original classification and the cross-reference classification. Any time that a patent is being issued in or cross-referenced to a subclass containing unofficial subclasses, the alpha designation for the proper unofficial subclass must be included on the blue issue slip. No other designation is permissible. Inclusion of only the numeric designation of an official subclass which includes unofficial subclasses is an incomplete and improper entry on a blue issue slip. All official subclasses which have unofficial subclasses are now designated with an "R" (denoting residual) and if the patent does not fit an indented unofficial subclass, the blue slip should include the "R" designation. It is permissible to

place multiple copies of a patent into a single set of unofficial subclasses.

When the original patent is classified in an unofficial subclass (including the "R" subclass), the front of the file wrapper and the drawing should also include the alpha designation.

Digests should also be included on the blue issue slip, but the original classification must never be a digest. The indication for a copy of a patent in a digest must be in the cross-reference area of the blue issue slip and must be identified by class number, alpha characters DIG and appropriate digest number.

RESUBMISSION

The original classification assignment of an application may have involved a "borderline" situation. The file wrapper of such an application will be stamped, "RESUBMIT TO CLASSIFICATION DIV. ———, etc.", the stamp appearing below the Interference Search box. A "Special" tag should be attached to the file when resubmitted. Note that there should be no resubmission if there is, at the time of allowance, no longer any doubt or dispute about the proper classification.

In the case of oversized patents, where only a minor portion of the disclosure is pertinent to the subclass in which a cross reference is to be placed, the examiner may indicate on the issue classification slip that a digest of the patent should be prepared, thus, 74–340 (digest). After the hard copy is printed, the Issue Section of the Documentation Service Branch inquires of the examiner as to which sheets of the patent should constitute the digest. Where an official Classification Order affects an application already passed to issue, the classification group makes the necessary changes on the file wrapper, blue slip, and drawing, if any. The clerk of the examining group is notified so that the Serial Register card may be similarly changed.

Applications which already have been sent to the printer will be classified by the classification group at the time the patent issues.

903.07(a) Cross-Referencing—Keep Systematic Notes During Prosecution [R–23]

Throughout the examination of the case, systematic notes should be kept as to cross-references needed either due to claimed or unclaimed disclosure. Examiners handling related subject matter should be consulted during prosecution (whether they handle larger unclaimed combinations or claimed or unclaimed, but disclosed, subcombinations), and asked if cross-references are needed. A cross-reference MUST be provided for all CLAIMED disclosure where possible and inserted on the blue issue classification slip at time of issue.

903.07(b) Issuing in Another Examining Group Without Transfer [R–43]

When an examiner issues a prospective patent in another examining group, he notes in the space provided on the blue issue classification slip, *in red ink*, the class and subclass of the other group, and in parenthesis the number of said other group. (The initials of said other primary examiner must also appear in said space.) In the lower left corner, the examiner writes his own group number in black ink. (When the patent issues, the classification group will, as a matter of routine, send the necessary notices to the group involved.)

The sending of cases to issue from one group and assigning them to classes in another group is restricted to those situations where both examiners concur in the proposed classification of the patent, which must be shown by the concurring examiner initialing the issue classification slip, or where there has been a ruling by a patent classifier, who must initial the slip.

903.08 Applications: Assignment and Transfer [R–43]

The examining group to which an application is assigned is responsible for its examination until such time as the application is officially transferred to another group by the classification group.

The primary examiners have full authority to accept any application submitted to them that they believe is properly classifiable in a class in their art unit.

903.08(a) New Applications [R–33]

New applications are assigned to the various examining groups in the first instance by the Application Division.

Upon receiving an application from Application Division, the clerk in charge of processing new applications, should date stamp the file wrapper and the back of the docket register card on the day the file is to be delivered to the supervisory primary examiner. The complete application (file, drawing, and serial register card) are then given to the appropriate supervisory primary examiner. The clerks should not permit these cases to remain overnight before distributing.

If the supervisory primary examiner decides that the application properly belongs in his art unit, it is processed as a new receipt. See § 903.08(b).

When a new application is received which, in the opinion of the primary examiner, does not belong to his group, he may request transfer to another group. See § 903.08(d).

Form PO–447, "Transfer Request" consists of five copies and is used as a transmittal, group charge and notification form.

If the search in connection with the first action develops art showing proper classification elsewhere, the transfer is initiated after a response is received from applicant.

Borderline Classification

The classification assignment of an application to the proper examining group, especially when there is submission to and assignment by the classification groups, often involves a borderline situation. Classifiers in the classification groups, when assigning such borderline cases, will stamp the file wrapper directly below the interference search box when it is their considered opinion that the classification of such an application should be reconsidered on allowance. The stamp will indicate which classification group will reconsider the case on a "Special" basis.

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903.08(b) Classification and Assignment to Examiner [R–35]

Every application, new or amended and including the drawings, if any, when first assigned to a group must be classified and assigned to an examiner for examination.

The supervisory primary examiner normally assigns them, noting in lead pencil in the space provided on the face of the file and in the upper left hand corner of the first sheet of the drawings, if the filing date is before January 1, 1972 or on the first sheet of the "pink" prints, if the filing date is after January 1, 1972, the class and subclass to which the case pertains, and also the name or initials of the examiner or the assigned docket designation. The application file is then turned over to the clerk for processing.

903.08(c) Immediate Inspection of Amendments [R–24]

Upon the receipt of an amendment which makes a transfer proper, steps should be taken promptly in accordance with the transfer procedure outlined in § 903.08(d).

903.08(d) Transfer Procedure [R–35]

Transfers Between Art Units Within the Same Group

All "within the group" transfers must be called to the attention of the group clerk so that the examiner's docket record card and serial register card can be changed to correctly indicate the assignment of the application. The clerk must also report docket changes on the Examiner Docket Activity Report, PO–690.

Where there is a difference of opinion among the supervisory primary examiners as to assignment within the same group, the matter is submitted to the documentation "postman" for resolution. Note § 903.10.

Transfers Between Different Groups

Transfer of undocketed and docketed new and amended applications may be requested between groups via the regular messenger service without submission to, or approval by the Office of Documentation. However, the forwarding group must send the application to the receiving group with a transfer request, PO–447 (only the recent forms dated 9/70 or subsequently should be used), within one calendar week of receipt in the forwarding group. Amended applications must be submitted within two weeks of the group receipt date of the amendment. If an application is not submitted within the time limit, it must be classified, assigned and retained in the original group.

Exceptions to these time limits are:

1. All new applications (docketed and undocketed) transferred to Group 220 purely for security reasons.
2. New undocketed applications which are hand carried.
3. New applications docketed prior to July 14, 1970.

Where a supervisory primary examiner believes an application does not belong in his group, he dates and completes form PO–447 by giving a full explanation of the reasons for classification in the other group art unit. In the space provided on the form at least one of the following must be included:

(1) Identification of the controlling claim examinable in another group.
(2) Identification of any existing informal transfer agreement.
(3) Other reasons—with full explanation.

The supervisory primary examiner may give the complete file with form PO–447 attached, to his transfer clerk for forwarding by regular messenger service, or he may obtain the docket record card from the clerk and hand carry the entire file to the other group art unit. The group clerk retains part PO–447(d) of form PO–447.

If the receiving examiner agrees to accept the application, he classifies and assigns the case and initials the form PO–447 and the face of the file wrapper. The transfer is effected by the clerk in the group which accepts the application by transfer. Application Division is notified by PO–447(a) and the forwarding group is notified by PO–447(e).

If the other examiner does NOT agree to accept the application within one week of receipt, he indicates his reasons and adds his initials on the form PO–447 in any available space. Where acceptance of an application is refused by the second group within one week of receipt in the second group, it may be submitted to the documentation division associated with the forwarding group for decision. If an application is not refused within the time limit, the second group must keep and examine the application.

Failure to fill in the date on the form by either the transmitting examiner or the receiving examiner may result in the assignment of the application to his art unit.

Transfer inquiry after expiration of the time period may be made by hand carrying the ap-

plication directly to the second group for possible acceptance. If it is accepted, the transfer is effected, but if it is refused, the original group must keep and examine the application.

Transfer of amended applications (any application having a response to an action by the Patent Office) may be requested by using the regular messenger service, if transfer is initiated within two weeks from the group receipt date of the response. The procedure for requesting transfer of such an amended application is similar to the procedure for requesting transfer of a new case. The time limit for initiating transfer of an amended application is two weeks from the group receipt date of the response. The procedure for hand carrying an amended application is also similar; if accepted after the two week period, the transfer may be effected, but if refused the case remains in the initiating group. The time limit for refusing the transfer of an amended case is one week, as for new applications.

The question or need for a restriction requirement does not enter into the determination of transfer.

PROCEDURE IN THE DOCUMENTATION DIVISION

The classifier may assign the application in accordance with the forwarding examiner's recommendations or, when this is not appropriate, to some other group. He writes the assigned class and group art unit numbers and his initials on the face of the file wrapper and on PO–447, briefly giving his reasons in the space provided on the form.

Where the change results in assignment of an application to a class under the jurisdiction of another documentation division, the classifier obtains the concurrence and signature on PO–447 of a classifier in the other documentation division.

As heretofore, under certain circumstances a classifier may, contrary to controlling classification rules, assign an application to a class or group which in his judgment is better equipped to examine the application. This is fully described in paragraph 6 and 9 of § 903.08(e); see also the last paragraph of § 903.08(a). Assignment by the classifier becomes final, and no transfer should be accepted without the classifier's initials on the face of the file wrapper.

RECONSIDERATIONS

The supervisory primary examiner of the group art unit to which an application is transferred may request reconsideration provided that group art unit has not seen the application before the transfer, if he believes the classifier's assignment is in error, by briefly stating his reasons on a new form PO–447 and sending it with the application to his documentation division. Only one such request will be accepted. The classifier having jurisdiction of the class in which the application is assigned considers the matter and writes his decision on PO–447. However, reconsideration may not be requested by a forwarding group when an application is returned by a classifier for examination.

Full clerical procedures for transfering applications are set forth in section 1205 of the Manual of Clerical Procedure.

903.08(e) General Regulations Governing the Assignment of Applications for Examination [R–32]

The fact should be borne in mind that the following regulations are only general guides, and exceptions frequently arise because of some unusual condition. The fact should also be kept in view that the patent classifiers as well as the patent examiners are confronted with an already existing classification, made up of newly revised classes, those revised years ago and which have somewhat outgrown their definitions and limits, and still others made a generation ago and never changed. Also, these classes are based on different theories and plans, some on art, some on structure, some on functions, some on the material worked upon, and some apparently, on no theory or plan at all. The patent classifiers cannot change this existing condition as each application comes up for assignment but must seek to dovetail the cases into the patchwork and try to get the applications where they will be best handled. To do this often violates the patent classifier's views as to what constitutes a really proper classification.

1. The assignment of applications follows, as far as possible, the rules or principles governing the classification of patents. (See the booklet *Development and Use of Patent Classification Systems.*)

2. The most comprehensive claim, that is the claim to the most extensive combination, governs, and this is true whether there is only one such claim and a large number of other claims, or whether the sets of claims are more evenly divided. It is regarded as just as vital that one complex claim be searched and adjudicated by an examiner skilled in the art as that a group of such claims be so searched and adjudicated.

3. The claims and statement of invention are generally taken as they read, since any attempt

of a patent classifier to go behind the record and decide the case upon what is deemed the "real invention" would, it is believed, introduce more errors than such action would cure. The patent classifiers cannot possess the specific knowledge of the state of the art in all the classes that the patent examiners collectively possess. Further, such questions are matters of merit for the examiners to determine and are often open to argument and are subject for appeal.

4. The location of the United States patents constituting the prior art is generally controlling over all else. (Note: Where time permits, obvious misplacements of the patents constituting the prior art are corrected, but to straighten all lines as the cases come up for assignment would require the time of several men and would often involve a reclassification of an entire class.)

5. Ordinarily an application cannot be assigned to a class which includes one element or part only of several claimed in combination. The claim is treated in its entirety. The question of aggregation is not reviewed by the patent classifiers.

6. The patent classifiers are authorized in all cases, where they evaluate the facts as warranting it, to assign applications for examination to the group best able to examine the same. Since assignment for examination on this basis will at times be contrary to classification of patents containing the same character of claims, the patent classifiers will indicate the proper classification of the patent, if such claims are allowed.

Thus in cases where there is a claim drawn to hybrid or mixed subject matter and the supervisory primary examiner in one discipline feels that the application requires consideration by, or may be best examined by, a group in one of the other technical disciplines, chemical, electrical, or mechanical, he may submit the application to his patent classifier who *may* assign the application on a "best examinable" basis, in accordance with this subsection.

Some examples of applications which may be thus submitted include:

(1) An application containing a hybrid claim wherein, for instance, a product is defined merely in terms of the process for producing it. See § 705.01(e)(1).

(2) Where an application properly assigned to a mechanical or electrical class contains at least one claim to mixed subject matter, a part of which is chemical, the application *may* be assigned to the appropriate chemical art unit for examination; or where the application is properly assigned to a mechanical class and a claim therein contains electrical subject matter, the application *may* be assigned to the appropriate electrical art unit for examination.

As indicated earlier, when an application which had been assigned for examination in accordance with this subsection ultimately is allowed, it will be classified according to the controling claim. In effect, assignment for examination may be on a "best examinable" basis, but the provisions of this subsection, the patent to the rules of superiority in classification; thus, the search file will have a constant set of rules governing placement of patents therein.

Where an application is being reassigned from one examining discipline to another, under the provisions of this subsection, the patent classifiers are authorized to require the first examiner to cite references pertinent to the claimed features falling under the jurisdiction of the art within his discipline. In those cases wherein the application of the reference(s) is not evident or clear, the first examiner should include a brief statement explaining the relation and possible application of the reference(s) to the claim(s); in case of dispute as to the necessity of this procedure, the patent classifier has power to require the statement.

7. When an application has been taken up by an examiner for action and a requirement to restrict is found necessary, a part of the claims being directed to matter classifiable in the group where the case is being examined, an action requiring restriction should be made without seeking a transfer of the case to another group. The action of the applicant in response to the requirement for restriction may result in making a transfer of the application unnecessary.

8. Ordinarily where all the claims of an application are for an article made of a specific composition or alloy with no other characteristic of the article recited, the application will be assigned to the composition or alloy class.

9. A class of cases exists in which either no art or a divided art is found and in which no rule or principle is involved. (Such cases are placed where, in the judgment of the patent classifiers they will be best searched and adjudicated. It is often impossible to so explain a decision in this class of cases as to satisfy, or in any way aid, the examiners interested. Indeed, the reasons for or against sending such cases one place or another may be so evenly balanced that no reason of any value can be given.

10. An examiner seeking the transfer of a case may make a search, both of his own class and the class to which he thinks the case should be transferred, and the examiner in charge of

the art unit should exhibit the result of such search to the classification groups. This is the way the expert knowledge of the examiners involved is utilized.

903.08(f) Patent Classifier's Decision [R–43]

A classifier in a classification group decides the question of the proper classification of the application, and either (1) returns the application to the group which submitted it if he denied the transfer request, or (2) forwards the application to the group to which it is transferred. See also § 903.10.

903.08(g) Transfer to Another Examining Group After Decision [R–43]

If the application is to remain in the group which submitted it for classification, no further procedure is necessary. If assigned to another group, the classification group processes the case as described in the Manual of Clerical Procedures.

If the case is one which had been taken up for action by an examiner according to its effective filing date, it should be treated as special by any examiner, art unit, or group to which it is transferred. See § 708.01.

903.09 International Classification of Patents for Inventions [R–43]

In accordance with the Strasbourg Agreement Concerning the International Patent Classification, the United States is required to indicate on its issuing documents the classification symbols of the International Patent Classification 1974 (Second Edition), hereinafter referred to as "Int. Cl.[2]".

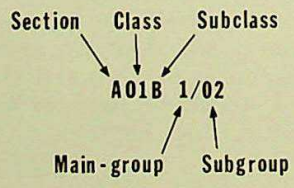
The complete Int. Cl.[2] symbols must be placed in the indicated space on the Issue Classification Slip (form PO–270) as revised 7/74 when an application or Defensive Publication Document is issued.

BASIC INT. CL.[2] STRUCTURE

The Int. Cl.[2] is arranged as follows:

Section — Subclass
Subsection — Main-group
Class — Subgroup

This can be graphically illustrated thus:



Section—Subsection

The Int. Cl.[2] is divided into eight main sections designated by capital letters A through H, and then, into subsections (*without any designating symbol*):

A. Human necessities:
  Subsections: Agriculture
  Foodstuffs and tobacco
  Personal and domestic articles
  Health and amusement

B. Performing operations:
  Subsections: Separating and mixing
  Shaping
  Printing
  Transporting

C. Chemistry and metallurgy:
  Subsections: Chemistry
  Metallurgy

D. Textiles and paper:
  Subsections: Textiles and flexible materials not otherwise provided for
  Paper

E. Fixed constructions:
  Subsections: Building
  Mining

F. Mechanics, lighting, and heating:
  Subsections: Engines and pumps
  Engineering in general
  Lighting and heating
  Weapons; blasting

G. Physics:
  Subsections: Instruments
  Nucleonics

H. Electricity:
  Subsection: Electricity

Class

Each section or subsection is divided into classes which are designated by a two-digit number following the section designation.

Example:
A01—Agriculture; Forestry; Animal Husbandry; Hunting; Trapping; Fishing

Subclass (Corresponding to U.S. Class)

Each class is divided into subclasses which are designated by a capital letter.

Example:
A01B—Soil working in agriculture or forestry

Main-group (Corresponding to U.S. Mainline Subclass)

Each subclass is divided into units referred to as main-groups which are identified by a

number to the left of a diagonal slash and 00 to the right thereof.

Example:

A01B 1/00 Hand tools

Subgroups (Corresponding to U.S. Indented Subclasses)

Main-groups may be divided into subgroups which are designated by a number (other than 00) to the right of the diagonal slash.

Example:

A01B 1/02. Spades; Shovels

Classifying in the Int. Cl.[2] System

Patents should be classified as far as possible as a whole and not by separate classification of constituent parts.

A. *Selecting subclasses* (Corresponding to U.S. Class)

In the Int. Cl.[2] there often occurs:

1. A subclass providing for the inherent nature or function of the invention, and
2. a subclass for its intended field of use.

Preference must be given to the intended field of use unless the invention is clearly specially adapted to a particular intrinsic function for which a class exists. The classifier must decide whether the invention is specially adapted to one field of use, or whether it is applicable to more than one particular field. It may, of course, be desirable to classify the invention in both places (intrinsic function and intended field of use); especially when the choice of a single place rests on the classifier's opinion rather than on fact.

B. *Selecting Main-groups* (Corresponding to U.S. Mainline Subclasses)

There are no firm rules of hierarchy. Frequently, there will be two or more main-groups which seem equally relevant, requiring a choice among them or classification in more than one of them. Contrary to U.S. practice, in which the more comprehensive subject matter appears first in the schedule, in the Int. Cl.[2], these inventions may be found in the lower part of the schedule.

C. *Selecting Subgroups* (Corresponding to U.S. Indented Subclasses)

An invention should be classified in the lowest (most indented) subgroup which is sufficiently comprehensive to embrace all essential features of the invention.

A detailed procedure for classifying a document into the Int. Cl.[2] is set forth in Chapter IV of the "Guide" to the Int. Cl.[2] which is located in the front of Volume I.

The Int. Cl.[2] contains 51,436 subdivisions, an increase of 8.8% over the previous edition.

In order to distinguish classification between the 1st Edition, hereinafter referred to as "Int. Cl.", and Int. Cl.[2], all classification according to Int. Cl.[2] can be identified by the notation "Int. Cl.[2]" preceding the international symbols.

The Int. Cl.[2] symbols are distinguishable from those of Int. Cl. in that the Int. Cl.[2] subclass symbol will be designated by a capital letter rather than a lower case letter.

Example:

(1st Edition) Int. Cl. A01b 1/02
(2nd Edition) Int. Cl.[2] A01B 1/02

U.S. Int. Cl.[2] Concordance, Third Edition

The Office of Patent Classification has prepared a revised Concordance between the U.S. classes and subclasses and the Int. Cl.[2]. In many areas the two systems are conceptually different. With this in mind, it will be seen that a complete one-to-one correspondence between the two systems cannot be attained. An indication in the Concordance may refer to only one relevant group, and not necessarily the only group in which the patent can or should be classified. For some inventions, the Concordance may not indicate any truly relevant group. Accordingly, the Concordance must be recognized as a *guide* to be used in conjunction with the Int. Cl.[2], and *not* as a translation list.

The third Edition of the Concordance incorporates some 20,000 changes over the previous edition and includes all changes in the Int. Cl.[2] and all changes in the U.S. Classification through Classification Order 413, dated December 31, 1973.

The Concordance may be incomplete in some areas and contain errors in other areas. Therefore, if corrections need to be made in the Concordance, members of the Examining Corps are requested to report any suggested changes to the appropriate group post classifier.

The Catchword Index

A revised Catchword Index, dated May 1974, has been prepared to correspond with the Int. Cl.[2].

Issue Classification Slip

The blue Issue Classification Slip (form PO–270) has been revised (Rev. 7/74) to indicate classification according to Int. Cl.[2] and also to permit a maximum of four discrete international notations.

An example of the revised blue Issue Slip (PO–270) is reproduced below with the following exemplary Int. Cl.[2] notations: A01B 1/02; B07B 7/083; C08F 110/04; and C08F 267/00.

		CROSS REFERENCE	
		CLASS	SUBCLASS
PATENT NUMBER			
SERIAL NUMBER			
NAME			
CLASS	SUBCLASS		
		INTERNATIONAL CLASSIFICATION (INT. CL.[2])	
GROUP ART UNIT	PLEASE PRINT FULL NAME	A01B	1/02
	ASSISTANT EXAMINER	B07B	7/083
	PRIMARY EXAMINER	C08F	110/04
		C08F	267/00

FORM PO-270 (REV. 7/74) U.S. DEPARTMENT OF COMMERCE PATENT OFFICE

ISSUE CLASSIFICATION SLIP

NOTE: The alpha characters appearing in the Int. Cl.[2] notations must all be in capital letters. The practice of using a lowercase letter for the second occurring alpha character, as used in the first Edition, has been discontinued.

SUMMARY

1. The appropriate symbols of Int. Cl.[2] will be placed on all issuing applications and Defensive Publication documents.

2. Each person involved in placing Int. Cl.[2] on issuing applications should be familiar with pages 7 through 35 in the front of Volume 1 of the Int. Cl.[2] Manual.

3. As indicated above, the Int. Cl.[2] symbols of the issuing application should be placed on the blue Issue Classification Slip (form PO–270, Rev. 7/74) in the space headed "Int. Cl.[2]".

4. It is required that at least one Int. Cl.[2] symbol, and not more than four (4) be placed on each issuing application. It is required that the complete symbol be designated (e.g., A01B 1/02).

903.10 Duties of the Post Classifier [R–32]

Post classifiers were established to improve liaison between the classification groups and the examining groups. Examiners should contact their post classifier on all classification problems.

Each post classifier is assigned one examining group as his responsibility. He is charged with all classification duties relative to this one examining group, except for major reclassification projects.

A post classifier is responsible for:

(1) The technical accuracy, adequacy and completeness of all search systems in his group including the monitoring of any need for major and minor reclassification projects including mechanized systems.

(2) The full range of classification administration functions including the resolution of classification disputes on pending applications, guidance on classification matters to both examiners and the public, which includes outlining fields of search and answering examiner's requests for advice as to the proper classification of allowed applications.

(3) The inspection of issuing applications to determine the accuracy and adequacy of original and cross-reference classification by working closely with the supervisory primary examiners and group directors to insure feedback to correct problem areas.

(4) Determination of the training needs of the personnel in his assigned group relative to principles of classification and supplying this training through formal and informal channels.

Generally, the post classifiers are to aid the examiners in the use, maintenance, and perfection of the classification system.

904 How to Search [R–36]

The examiner, after having obtained a thorough understanding of the invention disclosed and claimed in the application, then searches the prior art as disclosed in patents and other printed documents. Any such document used in the rejection of a claim is called a "reference."

In all continuing applications, the parent applications should be reviewed by the examiner for pertinent prior art.

The first search should be such that the examiner need not ordinarily make a second search of the prior art, unless necessitated by amendments to the claims by the applicant in the first response, except to check to determine whether any reference which would appear to be substantially more pertinent than the prior art cited in the first Office action has become available subsequent to the initial prior art search. It should cover the invention as described and claimed, including the inventive concepts toward which the claims appear to be directed. It should not be extended merely to add immaterial variants.

904.01 Analysis of Claims [R–36]

The breadth of the claims in the application should always be carefully noted; that is, the examiner should be fully aware of what the claims do *not* call for, as well as what they do require. There is always danger of reading into the claim limitations imported from the specification or drawing.

904.01(a) Variant Embodiments Within Scope of Claim [R–36]

Substantially every claim includes within its breadth or scope of definition one or more variant embodiments not disclosed by applicant, which would anticipate the terms of the definition. The claim must be so analyzed and understood that any such variant encountered during the search will be recognized and selected.

In each type of subject matter capable of such treatment (e.g., a machine or other apparatus), the subject matter as defined by the claim may be sketched in order to clearly delineate the limitations of the claim. Two or more sketches, each of which is as divergent from the particular disclosure as is permitted by claim recitation, will assist the examiner in determining the claim's actual breadth or scope. However, an applicant will not be required to submit such sketches of claim structure (In re Application filed November 16, 1945, 1951 C.D. 1; 646 O.G. 5).

904.01(b) Equivalents [R–24]

All subject matter that is the patentable equivalent of the subject matter as defined in the claim, even though specifically different from the definition in the claim, must be considered.

904.01(c) Analogous Arts [R–24]

Not only must the art be searched with which the invention claimed is classifiable, but also all analogous arts regardless of where classified.

The determination of when arts are analogous is at times difficult. It depends upon the necessary essential function or utility of the subject matter covered by the claims, and not upon what it is called.

For example, a tea mixer and a concrete mixer are for the same art, namely, the mixing art, this being the necessary function of each. Similarly a brick cutting machine and a biscuit cutting machine have the same necessary function.

904.01(d) Outlining Field of Search [R–36]

In outlining a field of search the examiner should note every class and subclass that may have material pertinent to the subject matter as claimed. Every subclass and digest pertinent to each type of invention claimed should be listed, from the largest combination through the various subcombinations to the most elementary part. The search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed.

The following should be kept in mind: (a) that a combination reference is necessary to reject a claim drawn to an old or exhausted combination, (b) that a combination reference is valuable as a basic reference where elements thereof may be varied by substituting equivalent elements of a secondary reference, (c) that a convincing aid to a rejection on the ground of old combination is the citation of references showing the subcombinations to have been already recognized as having practical and more general utility, (d) that combination claims can be shown unpatentable by combining separately classified subcombinational elements where reasons can be given for holding obviousness in forming the combination, and (e) that in the rejection of a claim on the ground of aggregation, the citation of references showing the individual utility of the elements may better prove that the aggregative structure is no more than the sum of the features shown by the several elemental patents.

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An examiner, in each first action upon an application, makes an initialed endorsement in ink in the space provided on the left-hand page of the open file wrapper, stating the classes and subclasses of domestic and foreign patents, abstract collections and the publications in which search for references was made and also the date of the search.

In subsequent actions, if further search is made, notation of the additional field covered is also endorsed and initialed on the file wrapper.

904.02 Conducting the Search [R–36]

It is a prerequisite to a speedy and just determination of the issues involved in the examination of an application that a careful and comprehensive search, commensurate with the limitations appearing in the most detailed claims in the case, be made in preparing the first action on the merits so that the second action on the merits can be made final or the application allowed with no further searching other than to update the original search. It is normally not enough that references be selected to meet only the terms of the claims alone, especially if only broad claims are presented; but the search should, insofar as possible, also cover all subject matter which the examiner reasonably anticipates might be incorporated into applicant's amendment. A complete search should result if applicant included, at the time of filing, claims varying from the broadest to which he believes he is entitled to the most detailed that he would be willing to accept.

It thus results that the examiner finds references that, while not needed for treating the claims before him, would be useful for forestalling the possible presentation of claims to other subject matter regarded by applicant as his invention, and claimable with the subject matter being currently claimed, but shown to be old by these references.

In selecting the references to be cited the examiner should carefully compare the references with one another and with the applicant's *disclosure* to avoid the citation of an unnecessary number. The examiner is not called upon to cite *all* the references that may be available, but only the "best." (rule 106.) Multiplying references, any one of which is as good as, but no better than, the others, adds to the burden and cost of prosecution, and should therefore be avoided. However, if doubt exists as to the inclusion of a reference, it is better to err in citing too much art rather than too little.

The best reference should always be the one used. Sometimes the best reference will have a publication date less than a year prior to the application filing date, hence it will be open to being overcome under rule 131. In these cases, if a second reference exists which cannot be so overcome and which, though inferior, is an adequate basis for rejection, the claims should be *additionally* rejected thereon.

In all references considered, including nonpatent, foreign patents and domestic patents, the examiner should study the specification or description sufficiently to determine the full value of the reference disclosure relative to the claimed or claimable subject matter.

905 Miscellaneous

905.01 Photocopy Orders [R–24]

Patents and/or applications received from Germany since October 1, 1968 and from Japan, France and U.S.S.R. since July 1, 1969 are not in numerical sequence. Inasmuch as the Patent Office supplies orders for copies of these foreign documents from master microfilm reels made up on weekly or other periodic publishing sequences, all orders must include the country, patent or application number, and the publication date (if known) of the ordered document. Reference should be made to § 901.05(a) to assist in determining the publication date of the commonly encountered foreign patents and applications.

All orders for photocopies on PO–250 originating in the Examining Groups must be authorized by an Examiner having full or partial signatory authority in the box headed "PRIMARY EXAMINER (Signature)". The stamped name of the authorizing Examiner will be indication of authority for Reproduction Section. Handwritten signatures should not be used.

905.02 Soft Copy Orders [R–36]

Soft copies may be ordered on PO–14 by the examiner for his use. These orders are filled by employees of Patent Copy Sales Branch. No employees other than those assigned to this Branch have access to the files of printed copies of patents. In emergency cases, orders may be taken to the Chief of the Branch whose approval thereof, if given, will insure immediate filling of said orders.

Because of the cost of printing copies of patents, economy should be exercised in their use. No soft copies should, however, be returned to Customer Services Division by examiners.

In view of the high cost of printing patents with color drawings, orders by examiners for plant patents and other patents with color drawings will not normally be filled by the Patent Copy Sales Branch. Soft copies of patents with colored drawings may be obtained only for cross-referencing purposes with the group director's approval. The group director indicates his approval by stamping and initialing form PO–14 below the "Examiner's Name".

Updating of Patent Listings

All patent copies in Official subclasses and Digests have been recorded as of the summer of 1969. In order that each search file be complete as to patent copies, it is necessary that each patent copy subsequently added to the search file be recorded.

The informal placement of cross references as "Unofficial Patents" into the examiner's search files has been discontinued. All patent copies now placed in the examiner's search file are "hard-copy" official cross references. Requests for patent copies on soft copy order form PO–14 having classification information noted thereon will be utilized by the Office of Patent Classification to generate and classify hard copy patent documents. The Office of Patent Classification provides copies to the Public Search Room and the examiner's search files in accordance with the form PO–14 request.

If a soft copy is desired without a copy being placed into the search files, no indication of classification should be included. A single soft copy is enclosed with all orders made on form PO–14. All soft copies are stamped in red "DO NOT PLACE IN SEARCH FILE." If for any reason the requesting examiner desires more than one soft copy for purposes other than the search file, the number of copies desired should be placed in the box on form PO–14 marked "NO. OF COPIES".

1. *Procedure to add cross references only.* (Sample "A").

Place the number "1" (one) in the box marked "NO. OF COPIES". Fill in clearly the "CLASS" and "SUB CLASS/DIGEST" boxes. Also complete the "PATENT NUMBER", "GROUP", "DATE OF ORDER" and "EXAMINER'S NAME" boxes.

2. *Procedure to order soft copies only.* (Sample "B").

This procedure is to be used when no copies are to be placed in the search files. Mark the number of soft copies desired in the box marked "NO. OF COPIES" and also complete the "PATENT NUMBER", "GROUP", "DATE OF ORDER", and "EXAMINER'S NAME" boxes.

3. *Procedure to add cross references to search file and also receive multiple soft copies.* (Sample "C").

In the "NO. OF COPIES" box place only the numeral indicating the number of soft copy patents desired exclusive of those patents for which a classification is listed. Also complete the "PATENT NUMBER", "GROUP",

SAMPLE "A" is an order for 3 hard copies and 1 soft copy.

USE A SEPARATE COUPON FOR EACH PATENT NUMBER ORDERED	PATENT NUMBER		NO. OF COPIES
	1,234,567		1
GROUP	DATE OF ORDER	CLASS	SUB CLASS/DIGEST
242	10-15-74	15	23
		15	24
EXAMINER'S NAME		259	10
ERIC ROBERTS			
		☐ DO NOT RECORD CLASSIFICATION	
NOTES			

FORM PO-14 REV. 1/71 — EXAMINER'S ORDER FOR PATENT COPY — U.S. DEPARTMENT OF COMMERCE PATENT OFFICE

SAMPLE "B" is an order for 3 soft copies.

USE A SEPARATE COUPON FOR EACH PATENT NUMBER ORDERED	PATENT NUMBER		NO. OF COPIES
	2,345,678		3
GROUP	DATE OF ORDER	CLASS	SUB CLASS/DIGEST
352	10-15-74		
EXAMINER'S NAME			
HENRY GREEN			
		☐ DO NOT RECORD CLASSIFICATION	
NOTES			

FORM PO-14 REV. 1/71 — EXAMINER'S ORDER FOR PATENT COPY — U.S. DEPARTMENT OF COMMERCE PATENT OFFICE

SAMPLE "C" is an order for 2 hard copies and 3 soft copies.

USE A SEPARATE COUPON FOR EACH PATENT NUMBER ORDERED	PATENT NUMBER		NO. OF COPIES
	3,456,789		3
GROUP	DATE OF ORDER	CLASS	SUB CLASS/DIGEST
166	10-15-74	96	6
		96	7
EXAMINER'S NAME			
ELLEN GRAY			
		☐ DO NOT RECORD CLASSIFICATION	
NOTES			

FORM PO-14 REV. 1/71 — EXAMINER'S ORDER FOR PATENT COPY — U.S. DEPARTMENT OF COMMERCE PATENT OFFICE

"DATE OF ORDER", "CLASS" and "SUBCLASS/DIGEST" for the desired hard copies, and the "EXAMINER'S NAME" boxes.

For the procedure to be used for ordering soft copies to replace missing hard copies see § 901.09.

To expedite the handling of soft-copy orders requested by Patent Office personnel, and thereby insure the quickest response, the following routing procedures should be adhered to:

(1) Use designated collection drops within each group.

(2) Group clerical personnel should hand carry or mail the forms, at least daily, to the Office of Patent Classification (OPC), room 2–7D12 or drop them in the OPC soft-copy order box provided at the reference order window in room 2–1A03. This box is emptied at least three times daily.

(3) The OPC will date stamp and batch the forms for subsequent keypunch processing by Customer Services Division (i.e., A, B, and C bundles for none, one or multiple classifications). This procedure is essential in order to update the record of classification which is maintained on magnetic tape.

The attorneys' drop slot at the Customer Services Division window should not be used nor should the forms be mailed to Customer Services Division as consequent rerouting to OPC for processing will result in unnecessary delay. [R–42]

905.03 Orders for Patented and Abandoned Files [R–22]

In the examination of an application it is sometimes necessary to inspect the application papers of some previously abandoned application or granted patent. This is always true in the case of a reissue application.

Patented and abandoned files may be obtained in the Record Room and Abandoned File Unit respectively, by filing out Charge Form (PO–125), and leaving this form with the clerk in charge. The file should be promptly returned when the examiner has finished with it. Where a patented file is needed for the purpose of reissue or interference, this information should be given to the Record Room upon obtaining the file, and as soon as these matters have been disposed of, the file should be returned to the Record Room.

When an interference is declared between a patent and an application and the interference is forwarded to the Board of Patent Interferences, the clerk in charge of the Record Room should be informed in order that the charge may be changed and the location of the file known at all times.

Examiners may expedite service in obtaining abandoned files and patented files by ordering them by telephone.

When ordering a patented file from the Record Room, the name of the person ordering the file should appear on the Form PO–125. It is important that the Patent Number be stated rather than the Serial Number of the application which matured into the patent. An examiner ordering a patented file should also place his art unit number on the form. If the notation "HOLD" is marked on the Form PO–125 the case will be held at the Record Room and in the absence of such notation it will be sent to the art unit indicated. If ordered by phone, the examiner may appear at the Record Room to complete the Form PO–125 and to pick up the file or he may request the delivery of the file by regular Office Messenger Service. If the need for the file is not urgent, examiner time may be saved by sending a Form PO–125, completed in the manner indicated above, to the Record Room by regular Office Messenger Service. The file will be delivered by the same Messenger Service to the art unit indicated on the form or it will be held at the Record Room only if so requested on the form.

Customer Services Division has charge of the drawings in patented cases. Canceled sheets, however, are not retained with the patented drawings but are filed with the "Abandoned Files and Drawings."

905.04 Marking Examiners' Copies of Patents

When the examiners' copies of patents are sent to their respective art units to be filed, they should be routed across the appropriate examiners' desks prior to placement in the shoes. The assistant examiners who examined the application should mark in ink on the face of the drawings, or the specifications where there are no drawings, such features as may be deemed advantageous in aiding understanding of the patents in future searches.

905.05 Charge for Pending Application Files [R–22]

Whenever an application file is temporarily removed from the group or division having jurisdiction thereof Charge Form PO–125 must be completed, and left with the clerk in charge. Such pending applications should also be "palmed in" by the group or division borrow-

ing the pending application so that accurate records may be maintained as to the location of such applications.

Whenever a file is removed from the group application file rack for use by an examiner assigned to that group, but not having jurisdiction of that file, cardboard Form OF–25 should be inserted in place of the borrowed file.

All files should be returned promptly to their proper location.

Chapter 1000 Matters Decided By Various Patent and Trademark Office Officials

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1001 Statutory Authority of Commissioner [R–43]

35 U.S.C. 3. Officers and employees. (a) There shall be in the Patent and Trademark Office a Commissioner of Patents and Trademarks, a Deputy Commissioner, two Assistant Commissioners and not more than fifteen examiners-in-chief. The Deputy Commissioner, or in the event of a vacancy in that office, the Assistant Commissioner senior in date of appointment, shall fill the office of Commissioner during a vacancy in that office until a Commissioner is appointed and takes office. The Commissioner of Patents and Trademarks, the Deputy Commissioner, and the Assistant Commissioners shall be appointed by the President, by and with the advice and consent of the Senate. The Secretary of Commerce, upon the nomination of the Commissioner in accordance with law, shall appoint all other officers and employees.

(b) The Secretary of Commerce may vest in himself the functions of the Patent and Trademark Office and its officers and employees specified in this title and may from time to time authorize their performance by any other officer or employee.

(c) The Secretary of Commerce is authorized to fix the per annum rate of basic compensation of each examiner-in-chief in the Patent and Trademark Office at not in excess of the maximum scheduled rate provided for positions in grade 17 of the General Schedule of the Classification Act of 1949, as amended.

35 U.S.C. 6. Duties of Commissioner. The Commissioner, under the direction of the Secretary of Commerce, shall superintend or perform all duties required by law respecting the granting and issuing of patents and the registration of trademarks; and he shall have charge of property belonging to the Patent and Trademark Office. He may, subject to the approval of the Secretary of Commerce, establish regulations, not inconsistent with law, for the conduct of proceedings in the Patent and Trademark Office.

1001.01 Modes of Exercising Authority [R–43]

The Commissioner's authority to review and supervise the work of the Office is exercised by the promulgation of the Rules of Practice; issuance of orders, notices and memoranda stating Office policies and modes for effectuating these policies; decisions on petitions by applicants, and by the designation of particular cases which must be submitted to the Commissioner or other officials authorized by the Commissioner. The present chapter deals with the latter two items.

Rule 181, paragraph (g), states "The Commissioner may delegate to appropriate Patent and Trademark Office officials the determination of petitions under this rule, with the exception of petitions under rule 183."

1002 Petitions to the Commissioner [R–43]

Rule 181. Petition to the Commissioner. (a) Petition may be taken to the Commissioner (1) from any action or requirement of any examiner in the ex parte prosecution of an application which is not subject to appeal to the Board of Appeals or to the court; (2) in cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) to invoke the supervisory authority of the Commissioner in appropriate circumstances.

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Briefs or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declarations (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the ex parte prosecution of an application, it may be required that there have been a proper request for reconsideration (rule 111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters avered in the petition, supplying a copy thereof to the petitioner.

(d) No fee is required for a petition to the Commissioner except in the case of a petition to revive an abandoned application (rule 137) or for the delayed payment of an issue fee (rule 317).

(e) Oral hearings will not be granted except when considered necessary by the Commissioner.

(f) Except as otherwise provided in these rules, any such petition not filed within two months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an examiner's action which may be running against an application, nor act as a stay of other proceedings.

(g) The Commissioner may delegate to appropriate → Patent and Trademark Office officials the determination of petitions under this rule, with the exception of petitions under rule 183.

Rule 182. Questions not specifically provided for. All cases not specifically provided for in these rules will be decided in accordance with the merits of each case by or under the authority of the Commissioner, and such decision will be communicated to the interested parties in writing.

Rule 183. Suspension of rules. In an extraordinary situation, when justice requires, any requirement of these rules which is not a requirement of the statutes may be suspended or waived by the Commissioner in person on petition of the interested party, subject to such other requirements as may be imposed.

Rule 184. Reconsideration of cases decided by former Commissioners. Cases which have been decided by one Commissioner will not be reconsidered by his successor except in accordance with the principles which govern the granting of new trials.

Petitions on appealable matters ordinarily are not entertained. See § 1201.

The mere filing of a petition will not stay the period for replying to an examiner's action which may be running against an application, nor act as a stay of other proceedings (rule 181(f)). For example, if a petition to vacate a final rejection as premature is filed within two months from the date of the final rejection, the period for response to the final rejection is not extended even if the petition is not reached for decision within that period. However, if the petition is granted and the applicant has filed an otherwise full response to the rejection *within the period for response*, the case is not abandoned.

Rule 181(f) now provides that any petition under that rule which is not filed "within two months from the action complained of" may be dismissed as untimely. Often, the "action complained of", for example, a requirement for a new drawing, is included in the same letter as an action on the merits of the claims, the latter having a three months period for response. Under such circumstances, if applicant requests reconsideration, under rule 111(b), of the requirement for a new drawing, the examiner's action on this request, if adverse, establishes the beginning of the two month period for filing the petition. The petition must be filed within this period even though the period for response to the rejection of the claims may extend beyond the two month period.

1002.01 Procedure [R–21]

Petitions, together with the respective application files, are sent to the Office of the Commissioner or other official having the delegated authority to decide the petition. The petition may be referred to the examiner for a formal statement under rule 181(c) or for an informal memorandum.

Where a formal statement under rule 181(c) is made, a copy thereof is mailed to the petitioner by the examiner unless the latter is otherwise directed, and the file and petition, accompanied by the original copy of his statement, are returned to the official handling the petition. If an informal memorandum is requested, no copy thereof is mailed to the petitioner by the examiner. After the decision has been rendered, the decision is entered on the

"Contents" of the file wrapper which is then returned to the primary examiner, who will act in accordance with the decision.

1002.02 Delegation of Authority to Decide Petitions [R–43]

Petitions to the Commissioner are decided in accordance with the following delegation of authority.

In any case in which the authority to decide the petition has been delegated as indicated in §§ 1002.02(a)–(m), the decision may be viewed as a final agency decision for the purposes of court review where such review is proper.

The authority to decide certain types of petitions for suspension of rules of practice under rule 183 of the Rules of Practice in Patent Cases and rule 2.148 of the Trademark Rules of Practice has been delegated to the Assistant Commissioner for Patents and the Assistant Commissioner for Trademarks. The petitions falling within each of these delegations are set forth in the listings in §§ 1002.02 (a) and (i). Certain types of such petitions falling within the authority delegated to the Assistant Commissioner for Patents have been assigned by him to the Deputy Assistant Commissioner for Patents and this assignment is reflected in the listings in § 1002.02(b).

In accordance with rule 181(g) the authority to decide petitions to the Commissioner, not otherwise delegated, has been delegated to various Office officials. Generally, these officials will decide petitions as specified in the following sections for the effective operation of the Office. Also listed are certain petitions which are not, strictly speaking, to the Commissioner but have been committed by statute or rule to the designated officials. Not included herein are petitions under 37 C.F.R., Part 100, for reconsideration of Commissioner's decisions on patent rights of government employees, since authority to act on these petitions has been reserved to the Commissioner and has not been delegated.

Authority not herein delegated has been reserved to the Commissioner and may be delegated to appropriate officials on an ad hoc basis.

1002.02(a) Petitions Decided by the Assistant Commissioner for Patents [R–43]

1. Petitions related to public use proceedings. Rule 292.

2. Petitions to make a patent application special on the ground of:

(a) prospective manufacture;
(b) infringement; or
(c) inability to interest capital. § 708.02.

3. Petitions under rule 183 for suspension of rules relating to patent examining not otherwise covered.

4. Petitions to expunge papers from patent application files or patent files.

5. Petitions to strike patent applications, except where the petition to strike an application involves or arises out of interference proceedings. Rule 56.

1002.02(b) Petitions Decided by the Deputy Assistant Commissioner for Patents [R–43]

1. Petitions to revive an abandoned patent application. Rule 137, § 711.03(c).

2. Petitions under rule 183 for suspension of rules relating to the examining of patent applications.

3. Petitions to invoke the supervisory authority of the Commissioner in matters within the responsibility of the Patent Examining Operation.

4. Petitions to withdraw patent applications from issue. Rule 313, § 1308.

5. Petitions for acceptance of late priority papers in patent applications. Rule 55, §§ 201.14 (a) and (c).

6. Petitions for deferment of issuance of patents.

7. Petitions for express abandonment of patent applications after Notice of Allowance.

8. Petitions to accept late payment of issue fees. Rule 316, § 712.

9. Petitions to accept late payment of additional issue fees. Rule 317, § 712.

10. Petitions relating to disclaimers in patents and patent applications under rule 321.

11. Petitions relating to assignments and issuance of patents. § 1308.

12. Petitions to invoke the supervisory authority of the Commissioner in matters concerning the Office of Administration.

13. Petitions under rule 183 for suspension of rules in patent matters administered by the Office of Administration.

1002.02(c) Petitions and Requests Decided by the Group Directors [R–43]

1. Petitions to make patent applications special: § 708.02

(a) on the ground of applicant's age or state of health;

(b) a division, continuation or continuation-in-part of an earlier application;
(c) under the Environmental Quality Program;
(d) under the Special Examining Procedure for certain new applications—accelerated examination.

2. Petitions to reopen prosecution of patent applications after decision by the Board of Appeals, where no court action has been filed. § 1214.07.

3. Petitions from a final decision of examiner requiring restriction in patent applications. Rule 144, § 818.03(c).

4. Petitions invoking the supervisory authority of the Commissioner involving any ex parte action or requirement in a patent application by the examiner which is not subject to appeal, as for example:

(a) prematureness of final rejection, § 706.07 (c);
(b) refusal to enter an amendment, rule 127, § 714.19;
(c) holding of abandonment, §§ 711.03 (c) and (d);
(d) requirement to cancel "new matter" from specification, § 608.04(c);
(e) petitions relative to formal sufficiency and propriety of affidavits under rules 131, 132, and 204;
(f) petitions to institute an interference under rule 205.
(g) petitions relating to refusal to enter an amendment under rule 312.

5. Petitions under rule 212 for concurrent ex parte and inter partes prosecution of patent applications. § 1103.

6. Petitions for return of original oaths of patent applications. § 604.04(a).

7. Requests for second or subsequent extensions of a set shortened statutory period under rule 136(b). § 710.02(e).

8. Requests for interviews with the examiner after a patent application has been sent to issue. § 713.10.

9. Requests for a defensive publication (denial). § 711.06.

10. Petitions concerning appealed patent applications before transfer of jurisdiction to the Board of Appeals (e.g., second or subsequent extension of time for filing an appeal brief). § 1206.

11. Petitions for a second or subsequent suspension of action in patent applications under rule 103. § 709.

12. Petitions for license to file patent applications in foreign countries (limited to the group director of Group 220).

13. Petitions to reinstate appeals dismissed by the group appeals clerk.

1002.02(d) Requests Decided by the Supervisory Primary Examiners [R–32]

Requests for defensive publication (approval). § 711.06.

1002.02(e) Requests Decided by the Examining Group Appeal Clerks [R–32]

First request for a one-month extension of time to file the appeal brief or reply brief in appeals to the Board of Appeals. § 1206.

1002.02(f) Petitions Decided by the Chairman of the Board of Patent Interferences [R–43]

1. Petitions in patent interferences from an action by a primary examiner or from an interlocutory action by the patent interference examiner.

2. Petitions to accept late settlement papers in patent interferences under 35 U.S.C. 135(c).

3. Petitions for acceptance of priority papers in patent applications involved in an interference.

1002.02(g) Petitions Decided by the Patent Interference Examiners [R–32]

1. Petitions for access to patent applications related to an interference or having an interference background. § 103.

2. Petitions for access to unopened preliminary statements under rule 227(d).

1002.02(h) Petitions Decided by the Special Assistant to the Assistant Commissioner for Patents [R–43]

1. Petitions for filing date. § 506.

2. Petitions relating to filing and issuance of divisional reissue applications. Rule 177, § 1401.10(a).

1002.02(i) Petitions Decided by the Assistant Commissioner for Trademarks [R–43]

Petitions relating to Trademarks are covered in Chapter 1700 of the Trademark Manual of Examining Procedure.

1002.02(j) Petitions Decided by the Board of Appeals [R–32]

1. Petitions or requests for extension of time to file an amendment under rule 196(b). § 1214.01.

2. Petitions under rule 197(b) for a rehearing, or reconsideration or modification of a decision of the Board of Appeals. § 1214.03.

3. Petitions to make special patent applications within the jurisdiction of the Board of Appeals. § 708.02.

4. Petitions or requests for extensions of time to file a supplemental reply brief responding to a supplemental examiner's answer under rule 193(b). § 1208.01.

1002.02(k) Petitions Decided by the Solicitor [R–32]

1. Petitions for access to patent applications except applications involved in or related to an interference. §§ 103 and 104.

2. Petitions for access to agreements filed under 35 U.S.C. 135(c).

3. Petitions from refusal to issue certificates of correction. §§ 1402 to 1402.02.

4. Petitions for extension of time in court matters. 35 U.S.C. 142, 145, 146.

5. Petitions for withdrawal of attorney. Rule 36, § 402.06.

6. Petitions for acceptance of patent applications under rule 47. § 409.03.

7. Petitions involving deceased inventors. §§ 409.01 (a) and (b).

8. Petitions under rule 324 to correct errors in joining inventors in a patent. § 1402.01.

9. Petitions relating to ex parte questions in cases before the Court of Customs and Patent Appeals.

1002.02(l) Requests Decided by the Decisions and Certificates of Correction Unit [R–32]

Requests for certificates of correction under rule 322 or 323 except for denials on grounds requiring consideration by the Solicitor. §§ 1402 and 1402.01.

1002.02(m) Petitions Decided by the Chairman, Committee on Enrollment [R–32]

1. Petitions relating to registration under rule 341.

2. Petitions for special recognition under rule 342.

3. Petitions for exceptions to undertakings under rule 341(g). § 1702.

4. Petitions for recognition in trademark cases under rule 2.12(c) of the Trademark Rules of Practice.

1003 Matters Submitted to Group Directors [R–43]

The following is a list of matters which require the approval of the appropriate group director, together with a reference to the section of this manual where such matters are more fully treated.

1. Applications filed without drawings where there is a doubt as to the need for drawings before granting a filing date. § 608.02.

2. Return of papers entered on the "Contents" of the file wrapper. See §§ 201.14(c) and 717.01.

3. Return of papers containing discourteous remarks. See § 714.25.

4. Certain rejections on double patenting of divisional (or parent) case when restriction or election of species has previously been required. § 804.04.

5. Request for patentability report. § 705.01 (e).

6. Letters to an applicant suggesting claims for purposes of interference, or the submission of Form PO–850, where one or more claims of one application would differ from corresponding claims of another application. See rule 203 (a) and § 1101.01(j).

7. Letters to an applicant of an allowed application informing him of a proposal to request withdrawal of said application from issue for the purpose of rejecting a claim or claims as fully met by, or obviously unpatentable over a new reference. § 1308.01.

8. Second or subsequent attempts at conversion of an application (addition or removal of an inventor under rule 45), or simultaneous addition and removal of inventors. See § 201.03.

9. Entry of a patent claim copied outside the time limit set requires the approval of the appropriate group director. See § 1101.02(f).

10. Actions which hold unpatentable claims copied from a patent for interference purposes where the grounds relied upon are equally applicable to the patentee. § 1101.02(f).

11. Interferences between applications neither of which is in condition for allowance. § 1101.01(c).

12. Letters requesting jurisdiction of applications involved in interference. § 1101.01(o).

13. Letters to an applicant suggesting claims for purposes of interference, the adoption of

which by the applicant would result in the withdrawal of an application from issue. § 1101.01 (o).

14. Amendments presented after decision by the Board of Appeals as to which the primary examiner recommends entry as placing the application in condition for allowance. See § 1214.07.

15. New ground of rejection or objection or new reference cited in examiner's answer on appeal. Prior approval of the group director must be obtained before the answer is written and the file copy of the answer must be stamped "approved" by the group director if it meets with his approval. See § 1208.01.

16. Examiner's answers containing a new interpretation of law. See § 1208.

17. Letters to an applicant indicating a defect in his appeal brief. § 1206.

18. Proposed interferences between applications whose effective filing dates differ by more than six months. See § 1101.01.

The group director should also be consulted in situations such as the one spelled out in § 1208.01, where it must be decided whether to fully reopen the ex parte prosecution after appeal or to proceed by introducing a new ground of rejection in the examiner's answer. Such consultation would ordinarily be confined to questions of policy as to whether the best interests of the applicant as well as the Office would be served by reopening the prosecution or extending the term to reply to the answer.

All unusual questions of practice may be referred to the group directors.

1004 Actions Which Require the Attention of the Primary Examiner [R–32]

There are some questions which existing practice requires the primary examiner to be personally responsible for. The following actions fall in this category:

Third action on any case (§ 707.02(a)).

Action on a case pending 5 or more years (§ 707.02(a)).

Final rejection (§ 706.07).

Initiating an interference (§ 1101.01(c)).

First request for extension of time (§ 710.02 (e)).

Disposition of an amendment in a case in interference looking to the formation of another interference involving that application (§ 1111.05).

Decisions on interference motions under rule 231; also, actions taken under rule 237 (§§ 1105.02 to 1105.05).

Rejection of a previously allowed claim (§ 706.04).

Proposed rejection of a copied patent claim. (If applicable to a patentee, see § 1101.02(f).)

Classification of allowed cases (§ 903.07).

Holding of abandonment for insufficient response (§ 711.03(a)).

Suspension of examiner's action (§ 709).

Treatment of newly filed application which obviously fails to comply with 35 U.S.C. 112 (§ 702.01).

Consideration of the advisability of a patentability report (§ 705.01).

Final requirements for restriction (§ 803.01).

Withdrawal of final rejection (§§ 706.07(d) and 706.07(e)).

All examiner's answers on appeal (§ 1208). Note also § 1208.01 where a new ground of rejection or objection is raised, or a new reference is cited, in the answer.

Decision on reissue oath or declaration. (§ 1401.08).

Decision on affidavits or declarations under rule 131 (§ 715.08) and under rule 132 (§ 716).

For a list of actions that are to be submitted to the group directors, see §§ 1002.02(c) and 1003.

1005 Partial Signatory Authority [R–39]

Examiners who are delegated partial signatory authority are expected to sign their own actions with the exception of the following actions which require the signature of the primary examiner:

Allowances

Quayle actions

Final rejections (§ 706.07).

Actions on amendments submitted after final rejection (§ 714.12).

Examiners' answers on appeal (§ 1208).

Interference declarations or modifications (§§ 1102.01(a) and 1106).

Decisions on interference motions (§ 1105.06).

Actions suggesting claims for interference purposes (§ 1101.01(j)).

Actions involving copied patent claims (§ 1101.02(f)).

Actions reopening prosecution (§ 1214.07).

Requests for withdrawal from issue (§ 1308).

Rule 312 amendments (§ 714.16).

Rejection of previously allowed claim (§ 706.04).

Final holding of abandonment for insufficient response (§ 711.03(a)).

Actions based on affidavit or declaration evidence (rules 131 and 132) (§§ 715.08 and 716).
Suspension of examiner's action (§ 709).
Reissue cases (decisions on reissue oath or declaration) (§ 1401.08)).
Requests for an extension of time (§ 710.02 (e)).
Examiner's amendments (§ 1302.04).
Final restriction requirements (§ 803.01).

Chapter 1100 Interference

1101 Preliminaries to an Interference
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This chapter relates only to interference matters before the examiner.

The interference practice is based on 35 U.S.C. 135.

35 U.S.C. 135. Interferences. (a) Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall

give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

(b) A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

Rule 201 sets forth the definition of an interference.

Rule 201. Definition, when declared. (a) An interference is a proceeding instituted for the purpose of determining the question of priority of invention between two or more parties claiming substantially the same patentable invention and may be instituted as soon as it is determined that common patentable subject matter is claimed in a plurality of applications or in an application and a patent.

(b) An interference will be declared between pending applications for patent, or for reissue, of different parties when such applications contain claims for substantially the same invention, which are allowable in the application of each party, and interferences will also be declared between pending applications for patent, or for reissue, and unexpired original or reissued patents, of different parties, when such applications and patents contain claims for substantially the same invention which are allowable in all of the applications involved, in accordance with the provisions of these rules.

(c) Interferences will not be declared, nor continued, between applications or applications and patents owned by the same party unless good cause is shown therefor. The parties shall make known any and all right, title and interest affecting the ownership of any application or patent involved or essential to the proceedings, not recorded in the Patent Office, when an interference is declared, and of changes in such right, title, or interest, made after the declaration of the interference and before the expiration of the time prescribed for seeking review of the decision in the interference.

1101 Preliminaries to an Interference [R–31]

An interference is often an expensive and time-consuming proceeding. Yet, it is necessary to determine priority when two applicants before the Office are claiming the same subject matter and their filing dates are close enough together that there is a reasonable possibility that the first applicant to file is not the first inventor.

The greatest care must therefore be exercised both in the search for interfering applications and in the determination of the question as to whether an interference should be declared. Also the claims in recently issued patents, especially those used as references against the application claims, should be considered for possible interference.

The question of the propriety of initiating an interference in any given case is affected by so many factors that a discussion of them here is impracticable. Some circumstances which render an interference unnecessary are hereinafter noted, but each instance must be carefully considered if serious errors are to be avoided.

In determining whether an interference exists a claim should be given the broadest interpretation which it reasonably will support, bearing in mind the following general principles:

(a) The interpretation should not be strained.

(b) Express limitations in the claim should not be ignored nor should limitations be read therein.

(c) Before a claim (unless it is a patented claim) is made the count of an interference it should be allowable and in good form. No pending claim which is indefinite, ambiguous or otherwise defective should be made the count of an interference.

(d) A claim copied from a patent, if ambiguous, should be interpreted in the light of the patent in which it originated.

(e) Since an interference between cases having a common assignee is not normally instituted, all cases must be submitted to the Assignment Branch for a title report.

(f) If doubts exist as to whether there is an interference, an interference should not be declared.

1101.01 Between Applications [R-23]

Where two or more applications are found to be claiming the same patentable invention they may be put in interference, dependent on the status of the respective cases and the difference between their filing dates. One of the applications should be in condition for allowance. Unusual circumstances may justify an exception to this if the approval of the appropriate director is obtained.

Interferences will not be declared between pending applications if there is a difference of more than 3 months in the effective filing dates of the oldest and next oldest applications, in the case of inventions of a simple character, or a difference of more than 6 months in the effective filing dates of the applications in other cases, except in exceptional situations, as determined and approved by the group director. If an interference is declared, all applications having the same interfering subject matter should be included.

Before taking any steps looking to the formation of an interference, it is very essential that the examiner make certain that each of the prospective parties is claiming the same patentable invention and that the claims that are to constitute the counts of the interference are clearly readable upon the disclosure of each party and allowable in each application.

It is to be noted that while the claims of two or more applicants may vary in scope and in immaterial details, yet if directed to the same invention, an interference exists. But mere disclosure by an applicant of an invention which he is not claiming does not afford a ground for suggesting to that applicant claims for the said invention copied from another application that is claiming the invention. The intention of the parties to claim the same patentable invention, as expressed in the summary of the invention or elsewhere in the disclosure, or in the claims, is an essential in every instance.

When the subject matter found to be allowable in one application is disclosed and claimed in another application, but the claims therein to such subject matter are either nonelected or subject to election, the question of interference should be considered. The requirement of rule 201(b) that the conflicting applications shall contain claims for substantially the same invention which are allowable in each application should be interpreted as meaning generally that the conflicting claimed subject matter is sufficiently supported in each application and is patentable to each applicant over the prior art. The statutory requirement of first inventorship is of transcendent importance and every effort should be made to avoid the improvident issuance of a patent when there is an adverse claimant.

Following are illustrative situations where the examiner should take action toward instituting interference:

A. Application filed with claims to divisible inventions I and II. Before action requiring restriction is made, examiner discovers another case having allowed claims to invention I.

The situation is not altered by the fact that a requirement for restriction had actually been made but had not been responded to. Nor is the situation materially different if an election of noninterfering subject matter had been made without traverse but no action given on the merits of the elected invention.

B. Application filed with claims to divisible inventions I and II and in response to a requirement for restriction, applicant traverses the same and elects invention I. Examiner gives an action on the merits of I. Examiner subsequently finds an application to another containing allowed claims to invention II and which is ready for issue.

The situation is not altered by the fact that the election is made without traverse and the nonelected claims possibly cancelled.

C. Application filed with generic claims and claimed species a, b, c, d, and e. Generic claims rejected and election of a single species required. Applicant elects species a, but continues to urge allowability of generic claims. Examiner finds another application claiming species b which is ready for issue.

The allowability of generic claims in the first case is not a condition precedent to seting up interference.

D. Application filed with generic claims and claims to five species and other species disclosed but not specifically claimed. Examiner finds another application the disclosure and claims of which are restricted to one of the unclaimed species and have been found allowable.

The prosecution of generic claims is taken as indicative of an intention to cover all species disclosed which come under the generic claim.

In all the above situations, the applicant has shown an intention to claim the subject matter which is actually being claimed in another application. These are to be distinguished from situations where a distinct invention is claimed in one application but merely disclosed in another application without evidence of an intent to claim the same. The question of interference should not be considered in the latter instance. However, if the application disclosing but not claiming the invention is senior, and the junior application is ready for issue,

the matter should be discussed with the group director to determine the action to be taken.

1101.01(a) In Different Groups [R–23]

An interference between applications assigned to different groups is declared by the group where the controlling interfering claim would be classified. Appropriate transfer of one of the applications is made. After termination of the interference, further transfer may be necessary depending upon the outcome.

1101.01(b) Common Ownership [R–33]

Where applications by different inventors but of common ownership claim the same subject matter or subject matter that is not patentably different:—

I. Interference therebetween is normally not instituted since there is no conflict of interest. Elimination of conflicting claims from all except one case should usually be required, rule 78(c). The common assignee must determine the application in which the conflicting claims are properly placed. Treatment by rejection is set forth in § 804.03.

II. Where an interference with a third party is found to exist, the owner should be required to elect which one of the applications shall be placed in interference.

Whenever a common assignee of applications by different inventors is called upon to eliminate conflicting claims from all except one application under the provisions of rule 78(c), a copy of the Office action making this requirement must be sent directly to each of the applicants.

Whenever a common assignee is required under rule 201(c) to elect one of the conflicting applications owned by him for purpose of interference with a third party, a copy of the Office action making this requirement must be sent to the applicants in each of the commonly assigned applications.

An assignee may not change his election after an interference has been declared.

1101.01(c) The Interference Search [R–23]

The search for interfering applications must not be limited to the class or subclass in which it is classified, but must be extended to all classes in or out of the examining group which it has been necessary to search in the examination of the application.

Moreover, the possibility of the existence of interfering applications should be kept in mind throughout the prosecution. Where the examiner at any time finds that two or more applications are claiming the same invention and he does not deem it expedient to institute interference proceedings at that time, he should make a record of the possible interference as on the face of the file wrapper in the space reserved for class and subclass designation. His notations, however, if made on the file wrapper or drawings, must not be such as to give any hint to the applicants, who may inspect their own applications at any time, of the date or identity of a supposedly interfering application. Serial numbers or filing dates of conflicting applications must never be placed upon drawings or file wrappers. A book of "Prospective Interferences" should be maintained containing complete data concerning possible interferences and the page and line of this book should be referred to on the respective file wrappers or drawings. For future reference, this book may include notes as to why prospective interferences were not declared.

In determining whether an interference exists, the primary examiner must decide the question. The patent interference examiner may, however, be consulted to obtain his advice.

The group director should be consulted if it is believed that the circumstances justify an interference between applications neither of which is ready for allowance.

1101.01(d) Correspondence Under Rule 202 [R–23]

Correspondence under rule 202 may be necessary but is seldom required under present practice.

Rule 202. Preparation for interference between applications; preliminary inquiry of junior applicant. In order to ascertain whether any question of priority arises between applications which appear to interfere and are otherwise ready to be prepared for interference, any junior applicant may be called upon to state in writing under oath or declaration the date and the character of the earliest fact or act, susceptible of proof, which can be relied upon to establish conception of the invention under consideration for the purpose of establishing priority of invention. The statement filed in compliance with this rule will be retained by the Patent Office separate from the application file and if an interference is declared will be opened simultaneously with the preliminary statement of the party filing the same. In case the junior applicant makes no reply within the time specified, not less than thirty

days, or if the earliest date alleged is subsequent to the filing date of the senior party, the interference ordinarily will not be declared.

Under rule 202 the Commissioner may require an applicant junior to another applicant to state in writing under oath or by making a declaration, the date and the character of the earliest fact or act, susceptible of proof, which can be relied upon to establish conception of the invention under consideration. Such affidavit or declaration does not become a part of the record in the application, nor does any correspondence relative thereto. The affidavit or declaration, however, will become a part of the interference record, if an interference is formed.

1101.01(e) Correspondence Under Rule 202, How Conducted [R–28]

In preparing cases for submission to the associate solicitor for rule 202 correspondence and in subsequent treatment of the cases involved, attention should be given to the following points:

(1) The name of the examiner to be called for a conference should be given as indicated on the form.

(2) It should be stated which of the applications, if any, is ready for allowance.

(3) If an application is a division or continuation of an earlier one, this fact should be stated. If it is a continuation-in-part, this should be indicated along with a statement whether or not the application is entitled to the benefit of the filing date of the earlier application for the conflicting subject matter.

(4) If two or more applications are owned by the same assignee, or are presented by the same attorney, it should be so stated.

(5) Only the broadest claim proposed for interference or, if various aspects of an invention are claimed, the broadest claim to each feature, need be identified but if the claims are not present in either of the applications, a proposed count should be set out in this letter.

(6) Any other points which have a bearing on the declaration of the interference should be stated.

(7) Amendments or other papers filed in cases held by the associate solicitor bearing on the question of interference should be promptly forwarded to him.

(8) Letters of submission should be in duplicate.

1101.01(f) Correspondence Under Rule 202, Not an Action on the Case

Correspondence under rule 202 is not an action on the case. Hence, it cannot serve to extend the statutory period if the case is awaiting action by the applicant.

1101.01(g) Correspondence Under Rule 202, When and When Not Needed [R–23]

After July 1, 1964, correspondence under rule 202 was greatly curtailed since interferences between pending applications with more than six months difference in effective filing dates were not to be declared unless approved by the Commissioner in exceptional situations.

1101.01(h) Correspondence Under Rule 202, Approval or Disapproval by Associate Solicitor [R–42]

The associate solicitor will stamp the letters from the examiner either "Approved" or "Disapproved," as the case may require, and return the carbon copy to the examining group.

If the earliest date alleged by the junior party under rule 202 fails to antedate the filing date of the senior applicant, the associate solicitor disapproves the proposed interference and the examiner then follows the procedure outlined in the next section. When a "Disapproved" letter is returned to the examining group it is accompanied by a note to be attached to the senior party's case requesting the Patent Issue Division to return the case to the associate solicitor after the notice of allowance is sent.

Where the junior party, as required by rule 202, states under oath or declaration a date of a fact or an act, susceptible of proof, which would establish that he had conceived the claimed invention prior to the filing date of the senior applicant, the associate solicitor approves the examiner's proposal to suggest claims and the examiner may then proceed with the preparation of the cases for interference.

Sealing Statement

When an interference is to be declared involving applications which had previously been submitted to the associate solicitor for correspondence under rule 202, before forwarding the files to the Board of Patent Interferences, the examiner should ascertain from the associate solicitor if any such statement has been filed and, if so, get this statement and forward it with the files.

The oath or declaration under rule 202 becomes a part of the interference file in contradistinction to the application file as in the case of an affidavit or declaration under rule 131 or rule 204 but, like them, is subject to inspection on the opening of the preliminary statements.

When the formation of an interference between two parties is necessary, all other applicants claiming the contested invention should be placed in the interference irrespective of their filing dates or of any dates alleged under rule 202, provided there is no statutory bar to the allowance of the claims in the other applications.

1101.01(i) Correspondence Under Rule 202, Failure of Junior Party To Overcome Filing Date of Senior Party [R–42]

If the earliest date alleged by a junior party in his affidavit or declaration under rule 202 fails to overcome the filing date of the senior party and if the interference is not to be declared (note that an interference might be necessary for other reasons), the senior party's application will be sent to issue as speedily as possible and the conflicting claims of the junior applicant will be rejected on the patent when granted. A shortened period for response may be set in the senior party's case. (See § 710.02(b).)

After the senior applicant's application has been passed for issue, the application is sent to the associate solicitor by the Patent Issue Division in accordance with a note to that effect attached to the application and he writes a letter to that applicant urging him to promptly pay the issue fee, this being done to the end that prosecution of the junior application may be promptly resumed, the senior party's disclosure then being available as prior art in treating the claims of the junior application. The examiner may make a supplemental action on the junior applicant's case when the senior applicant's patent issues.

Interim Procedure

In the meantime the junior party's application will be treated in accordance with the following:

Where a junior party after correspondence under rule 202 fails to overcome the filing date of the senior party, the examiner when he reaches the case for action will write a letter substantially as follows:

> In view of rule 202, action on this case (or on claims 1, 2, 4. etc., indicating the conflicting claims and claims not patentable over the senior party's case) is suspended for six months to determine whether an interference will be declared (unless these claims are canceled). At the end of the six months applicant should call up the case for action.

The letter should include the usual action on the remaining claims in the case, indicating what, if any, claims are allowable.

If the examiner's letter is a suspension of action on the entire case, the case should be noted on the examiner's calendar at the date marking the end of the six months period and on the docket clerk's cards and, if applicant does not call up the case, the examiner should do so unless the senior party's patent will soon issue, since there is no period for response running against the applicant and the case should not be permitted to remain indefinitely among the files in the examining group.

It sometimes happens that the application of the junior party is not amended and nothing else occurs to bring it to the attention of the examiner, and that the patent to the senior party issues and is not promptly cited to the junior party. This works an unnecessary hardship upon the junior applicant and the Office should make every effort to give him action in view of this reference at the earliest possible date. To this end, the examiner should keep informed as to the progress of the senior application and cite the patent with appropriate comment to the junior applicant immediately after its issue.

If, at the end of the six months' suspension, it appears likely that the senior application will be passed to issue within the next six months, action on the conflicting claims and claims not patentable over the senior party's case should again be suspended for a period of six months. Of course, if the first suspension was directed to certain claims only and the usual action was given on other claims, it is necessary for the applicant to make such response as is required to the action on the other claims.

If, at the end of the first six months' suspension, there is no likelihood of the senior party's application being put in condition for allowance within the next six months and the only unsettled question in the junior party's case is the disposition of the claims on which action was suspended, then the interference should be declared.

If the junior application is in issue when the interference is discovered and, in correspondence under rule 202, the junior applicant fails to make the date of the senior party, the junior application should be withdrawn from issue (see "Letter Forms Used in Interferences," § 1112.04) and a letter sent informing him that the interfering claim or claims and claims not patentable over the senior party's case cannot

be allowed him as his date of invention indicates he is not the first inventor. Action should be suspended for six months, the examiner noting the expiration date on his calendar and advising applicant to call the case up for action at the end of the six months. Thereafter, procedure should be as above.

1101.01(j) Suggestion of Claims [R–43]

Rule 203. Preparation for interference between applications; suggestion of claims for interference. (a) Before the declaration of interference, it must be determined by the examiner that there is common subject matter in the cases of the respective parties, patentable to each of the respective parties, subject to the determination of the question of priority. Claims in the same language, to form the counts of the interference, must be present or be presented, in each application; except that, in cases where, owing to the nature of the disclosures in the respective applications, it is not possible for all applications to properly include a claim in identical phraseology to define the common invention, an interference may be declared, with the approval of the Commissioner, using as a count representing the interfering subject matter a claim differing from the corresponding claims of one or more of the interfering applications by an immaterial limitation or variation.

(b) When the claims of two or more applications differ in phraseology, but relate to substantially the same patentable subject matter, the examiner shall, if it has been determined that an interference should be declared, suggest to the parties such claims as are necessary to cover the common invention in the same language. The parties to whom the claims are suggested will be required to make those claims (i. e., present the suggested claims in their applications by amendment) within a specified time, not less than 30 days, in order that an interference may be declared. The failure or refusal of any applicant to make any claim suggested within the time specified, shall be taken without further action as a disclaimer of the invention covered by that claim unless the time be extended.

(c) The suggestion of claims for purpose of interference will not stay the period for response to an Office action which may be running against an application, unless the claims are made by the applicant within the time specified for making the claims.

(d) When an applicant presents a claim in his application (not suggested by the examiner as specified in this rule) which is copied from some other application, either for purpose of interference or otherwise, he must so state, at the time he presents the claim and identify the other application.

Although the subject of suggesting claims is treated in detail at this point in the discussion of a prospective interference between applications, some of the practice here outlined is also applicable to a prospective interference with a patent.

If the applications contain identical claims covering the entire interfering subject matter the examiner proceeds under rule 207 to form the interference; otherwise, proper claims must be suggested to some or all of the parties.

It should be noted at this point that if an applicant copies a claim from another application without suggestion by the examiner, rule 203(d) requires him to "so state, at the time he presents the claim and identify the other application."

The question of what claims to suggest to the interfering applications is one of great importance, and failure to suggest such claims as will define clearly the matter in issue leads to confusion and to prolongation of the contest.

While it is much to be desired that the claims suggested (which are to form the issue of the interference) should be claims already present in one or the other of the applications, yet if claims cannot be found in the applications which satisfactorily express the issue it may be necessary to frame a claim or claims reading on all the applications and clearly expressing the interfering subject matter and suggest it or them to all parties. Whether selecting a claim already presented or framing one for suggestion to all parties, the examiner should keep in mind that where one application has a less detailed disclosure than others there is less chance for error in finding support in all applications if language is selected from the application with the less detailed disclosure.

It is not necessary that all the claims of each party that read on the other party's case be suggested. The counts of the issue should be representative claims and should be materially different. Stated another way, the difference between counts should be one not taught by the prior art, and should have a significant effect in the subject matter involved. In general, the broadest patentable claim which is allowable in each case should be used as the interference count and additional claims should not be suggested unless they are sufficiently different that they may properly issue in separate patents. In determining the broadest patentable count the examiner should avoid the use of specific language which imposes an unnecessary limitation. Claims not patentably different from counts of the issue are rejected in the application of the defeated party after termination of the interference.

The claims to form the issue of the interference are suggested to all parties who have not already made those claims.

Where necessitated by the respective disclosures, one or more applications may be involved on a claim which differs from that of

another application, with the approval of the group director. Note rule 203(a). In such a case the principles set out in detail in § 1101.02 should be applied.

However, a phantom count should not be used where one of the applications supports the broadest aspects of all limitations of the common invention. If a claim commensurate with the disclosure of the broadest application is not present, one should be drafted and suggested. The application with the narrower disclosure should be involved in the interference with a corresponding claim with one or more narrower limitations so that it defines the common invention with the greatest breadth disclosed in that application. If a suitable claim is not present in the application with the narrower disclosure, one should be drafted and suggested by the examiner.

1101.01(k) Suggestion of Claims, Conflicting Parties Have Same Attorney [R–43]

Rule 208. Conflicting parties having same attorney. Whenever it shall be found that two or more parties whose interests appear to be in conflict are represented by the same attorney or agent, the examiner shall notify each of said principal parties and the attorney or agent of this fact, and shall also call the matter to the attention of the Commissioner. If conflicting interests exist, the same attorney or agent or his associates will not be recognized to represent either of the parties whose interests are in conflict without the consent of the other party or in the absence of special circumstances requiring such representation, in further proceedings before the Patent and Trademark Office involving the matter or application or patent in which the conflicting interests exist.

Notification should be given to both parties at the time claims are suggested even though claims are suggested to only one party. Notation of the persons to whom this letter is mailed should be made on all copies. (See § 1112.03.) The attention of the Commissioner is not called to the fact that two conflicting parties have the same attorney until an actual interference is set up and then it is done by notifying the examiner of interferences as explained in § 1102.01(a).

1101.01(l) Suggestion of Claims, Action To Be Made at Time of Suggesting Claims [R–32]

At the same time that the claims are suggested an action is made on each of the applications that are up for action by the examiner, whether they be new or amended cases. In this way possible motions under rule 231(a) (2) and (3) may be forestalled. That is, the action on the new or amended case may bring to light patentable claims that should be included as counts of the interference, and, on the other hand, the rejection of unpatentable claims will serve to indicate to the opposing parties the position of the examiner with respect to such claims.

The examiner is required to inform each applicant when the interference is declared what claims in his application are unpatentable over the issue. There would seem to be no objection to, and many advantages in, giving this information when suggesting claims.

Where in a letter suggesting claims to an applicant for interference, the examiner states that none of the claims in the case are patentable over the claims suggested, this statement does not constitute a formal rejection of the claims, so that after the expiration of the period fixed for presenting the suggested claims, if no amendment has been filed, the examiner should make a definite action on the claims then in the application.

1101.01(m) Suggestion of Claims, Time Limit Set for Making Suggested Claims [R–20]

Where claims are suggested for interference, a limited period determined by the examiner, not less than 30 days, is set for reply. See § 710.02(c).

Should any one of the applicants fail to make the claim or claims suggested to him, within the time specified, all his claims not patentable thereover are rejected on the ground that he has disclaimed the invention to which they are directed. If applicant makes the suggested claims later they will be rejected on the same ground unless the delay is satisfactorily explained. (See § 706.03(u).)

1101.01(n) Suggestion of Claims, Suggested Claims Made After Period for Response Running Against Case [R–20]

If suggested claims are made within the time specified for making the claims, the applicant may ignore other outstanding rejections in the application. Even if claims are suggested in an application near the end of the period for response running against the case, and the time limit for making the claims extends beyond the end of the period, such claims will be admitted if filed within the time limit even though outside the period for response (usually a three month shortened statutory period) and even though no amendment was made responsive to

the Office action outstanding against the case at the time of suggesting the claims. No portion of the case is abandoned provided the applicant makes the suggested claims within the time specified. However, if the suggested claims are not thus made within the specified time, the case becomes abandoned in the absence of a responsive amendment filed within the period for response. See rule 203(c).

1101.01(o) Suggestion of Claims, Application in Issue or in Interference [R–40]

An application will not be withdrawn from issue for the purpose of suggesting claims for an interference. When an application is pending before the examiner which contains one or more claims, which may be made in a case in issue, the examiner may write a letter suggesting such claims to the applicant whose case is in issue, stating that if such claims be made within a certain specified time the case will be withdrawn from issue, the amendment entered and the interference declared. Such letters must be submitted to the group director. If the suggested claims are not copied in the application in issue, it may be necessary to withdraw it from issue for the purpose of rejecting other claims on the implied disclaimer resulting from the failure to copy the suggested claims, using form at § 1112.04.

When the examiner suggests one or more claims appearing in a case in issue to an applicant whose case is pending before him, the case in issue will not be withdrawn for the purpose of interference unless the suggested claims shall be made in the pending application within the time specified by the examiner. The letter suggesting claims should be submitted to the group director for approval.

In either of the above cases the Patent Issue Division should be notified when the claim is suggested, so that in case the issue fee is paid during the time in which the suggested claims may be made, proper steps may be taken to prevent the issue fee from being applied.

The examiner should borrow the allowed application from the Patent Issue Division and hold the file until the claims are made or the time limit expires. This avoids any possible issuance of the application as a patent should the issue fee be paid. To further insure against the issuance of the application, the examiner may pencil in the blank space labeled "Date paid" in the lower right-hand corner of the file wrapper the initialled request: "Defer for interference." The issue fee is not applied to such an application until the following procedure is carried out.

When notified that the issue fee has been received, the examiner shall prepare a memo to the Patent Issue Division requesting that issue of the patent be deferred for a period of three months due to a possible interference. This allows a period of two months to complete any action needed. At the end of this two month period, the application must either be released to the Patent Issue Division or be withdrawn from issue, using form at § 1112.04.

When an application is found having claims to be suggested to other applications already involved in interference, to form another interference, the primary examiner borrows the last named applications from the Service Branch of the Board of Patent Interferences by leaving a charge card. In case the application is to be added to the existing interference, the primary examiner need only send the application and form PO–850 (illustrated in § 1112.05) properly filled out as to the additional application and identifying the interference, to the Patent Interference Examiner who will take the appropriate action. Also see § 1106.02.

1101.02 With a Patent [R–40]

Rules 204, 205 and 206 quoted below deal with interference involving patents.

Rule 204. Interference with a patent; affidavit or declaration by junior applicant. (a) The fact that one of the parties has already obtained a patent will not prevent an interference. Although the Commissioner has no power to cancel a patent, he may grant another patent for the same invention to a person who, in the interference, proves himself to be the prior inventor.

(b) When the effective filing date of an applicant is three months or less subsequent to the effective filing date of a patentee, the applicant, before the interference will be declared, shall file an affidavit or declaration that he made the invention in controversy in this country before the effective filing date of the patentee, or that his acts in this country with respect to the invention were sufficient to establish priority of invention relative to the effective filing date of the patentee.

(c) When the effective filing date of an applicant is more than three months subsequent to the effective filing date of the patentee, the applicant, before the interference will be declared, shall file two copies of affidavits or declarations by himself, if possible, and by one or more corroborating witnesses, supported by documentary evidence if available, each setting out a factual description of acts and circumstances performed or observed by the affiant, which collectively would prima facie entitle him to an award of priority with respect to the effective filing date of the patent. This showing must be accompanied by an explanation of the basis on which he believes that the facts set forth would overcome the

effective filing date of the patent. Failure to satisfy the provisions of this rule may result in summary judgment against the applicant under rule 228. Upon a showing of sufficient cause, an affidavit or declaration on information and belief as to the expected testimony of a witness whose testimony is necessary to overcome the filing date of the patent may be accepted in lieu of an affidavit or declaration by such witness. If the examiner finds the case to be otherwise in condition for the declaration of an interference he will consider this material only to the extent of determining whether a date prior to the effective filing date of the patent is alleged, and if so, the interference will be declared. (See also rule 228)

The extensive discussion of modified patent claims below should not be misinterpreted. Most interferences between applications and patents have the exact patent claim as a count.

As a patentee may not alter his claims (except by reissue) an applicant must make one or more claims of the patent or a claim corresponding substantially to a claim of the patent and differing therefrom by an immaterial variation or by the exclusion of an immaterial limitation to invoke an interference as stated in rule 205(a), either because of lack of support in the application for the omitted limitation, or because justified by a showing as set out in the rule. An example of the latter might be where the showing submitted by the applicant demonstrates that his best proofs do not satisfy the omitted limitation. This practice is less restrictive than that which was followed prior to adoption of rule 205(a) in its present form.

Where a patent claim is modified, the count of the interference should be the broader claim as between the patentee and the applicant. Thus, if an immaterial limitation is excluded, the count of the interference should be a copy of the *modified* patent claim as made in the application following the practice as explained in Bonine v. Bliss, 1919 C.D. 75; 265 O.G. 306.

It is improper to base a plurality of interference counts upon a single claim of a patent. If one count of the interference corresponded exactly to the claim of the patent, and another count corresponded substantially to the same claim, the question would arise, in the case of a split decision on priority, as to who had obtained the favorable judgment. Slepian v. Bennett; 85 USPQ 44.

It has been found that the practice set forth in Ex parte Card and Card, 112 O.G. 499, 1904 C.D. 383, does not adequately take care of all situations where there is an interference in fact between a patent and an application but there are obstacles to the applicant making the exact patent claim.

In those cases where the claim of the patent contains an immaterial limitation which can be wholly eliminated or suitably modified so as to broaden the claim, the practice set forth in Ex parte Card and Card should continue to be followed.

A. APPLICATION DISCLOSURE NARROWER THAN PATENT CLAIM

In some cases, the disclosure in the application, although for the same generic invention in fact as the patent claim, is somewhat narrower than the claim of the patent. Under such circumstances, the applicant should be permitted to copy the claim of the patent as exactly as possible, modifying it only by substituting language based upon his own narrower disclosure for the limitation in the patent claim which he can not make, see Tolle et al. v. Starkey, 1958 C.D. 359; 118 USPQ 292. In declaring the interference, the exact patent claim should be used as the count of the interference and it should be indicated that the claim in the application corresponds substantially to to the interference count.

Examples of the practice outlined in the preceding paragraph:

I. Patent Claims a Range of 10 to 90.

Application discloses a range of 20 to 80, there being no distinction in substance between the two ranges.

Application may be permitted to copy the patent claim, modifying it by substituting his range of 20 to 80 for the range of 10 to 90 in the patent claim.

Interference should be declared with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

II. Patent Claims a Markush Group of 6 Members.

Application discloses a Markush group of 5 of the same 6 members, there being no distinction in substance between the two groups.

Applicant may be permitted to copy the patent claim, modifying it by substituting his 5-member group for the 6-member group in the patent claim.

Interference should be declared with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

B. APPLICATION DISCLOSURE BROADER THAN PATENT CLAIM

In some cases, the disclosure in the application, although for the same invention in fact

as the patent claim, is somewhat broader than the claim of the patent. If the applicant presents a corresponding broader claim, the application claim should be used as the count of the interference and it should be indicated on form PO–850 that the count is a modification of the patent claim. The applicant should not be permitted to copy the exact patent claim if any limitation thereof is not disclosed in the application. If the application discloses every limitation of the patent claim, and the applicant copies the exact patent claim, the patent claim is used as the count of the interference. In the latter circumstance, if the applicant presents a timely motion under rule 231 to substitute a broader count and accompanies the motion with a satisfactory showing, as by asserting that his best evidence lies outside the exact limits of the patent claim, the applicant may be permitted to substitute a count wherein language based upon his slightly broader disclosure replaces the corresponding limitation in the patent claim. In redeclaring the interference, the application claim is used as the count of the interference and it is indicated in the redeclaration papers that the claim in the patent is modified.

EXAMPLES

The following are examples of the above practice in which THE SAME PATENTABLE INVENTION IS CLAIMED BY THE APPLICANT AND PATENTEE ALTHOUGH THE DISCLOSURE IN THE APPLICATION DIFFERS IN BREADTH FROM THE PATENT CLAIMS.

I. Patent Claims a Range of 20 to 80: *Application discloses a range of 10 to 90.*

If the application supports the exact patent claim and the applicant elects to copy the exact patent claim, the interference should be declared with the patent claim as the count. However, the interference may be declared having as a count the patent claim modified by substituting applicant's range of 10 to 90 for the range of 20 to 80 in the patent claim. Rule 205(a).

Similarly, the applicant may seek such substitution after the interference is declared on the exact patent claim by filing a motion to substitute a count with the broader range supported by a similar showing as indicated above.

Where the application claim is accepted as a count, it should be indicated in the interference notices and declaration sheet that the count is a modification of the patent claim.

II. Patent Claims a Markush Group of 5 Members.

Application discloses a Markush group of 6 members, including the 5 claimed in the patent.

The interference is declared with the application claim having the 6-member group as the count and it should be indicated that the count is a modification of the patent claim.

If the applicant elects to copy the exact patent claim, the interference should be declared with the patent claim as the count.

If, in connection with a motion to substitute, the applicant makes a satisfactory showing (Wheelock v. Wolinski, 175 USPQ 216) of the necessity for including the sixth member in the interference count, he may be permitted to present the patent claim modified by substituting his 6-member group for the 5-member group in the patent claim.

The interference will be redeclared with the application claim as the count and it will be indicated that the count is a modification of the patent claim.

C. APPLICATION DISCLOSURE BROADER IN SOME ASPECTS AND NARROWER IN SOME ASPECTS THAN PATENT CLAIMS

Some cases may include aspects of both A and B, above. Such cases should be appropriately treated by the same general principles outlined above.

Examples of cases involving mixed aspects:

I. Patent Claims a Range of 10 to 80.

Application discloses a range of 20 to 90, there being no distinction in substance between the two ranges.

The applicant may be permitted to present a claim which includes the range of 20–90, and the interference should be declared with a count covering the range of 10–90, and it should be indicated that the count is a "phantom" count by writing the word "phantom" beside the number of the patent claim and the application claim on form PO–850. In such circumstances, the examiner must attach a copy of the count to the form PO–850.

II. Patent Claims a Markush Group of 6 Members.

Application discloses a Markush group of 5 of the same 6 members, plus another member not claimed in the patent, there being no distinction in substance between the two groups.

(a) Initially, applicant may be permitted to copy the patent claim, modifying it by substituting the 5 members of the patent claim which he discloses for the 6-member group in the patent claim.

Interference should in such case be declared initially with the exact patent claim as the count and it should be indicated that the claim in the application corresponds substantially to the interference count.

However, if the applicant has a claim drawn to the 6 members disclosed in his application, the interference may initially be declared with a "phantom" count including a Markush group of all 7 members and this should be indicated on form PO–850 by writing "phantom" beside the number of the corresponding patent and application claims. A copy of the count must be attached to form PO–850.

(b) If the interference is declared with the exact patent claim as the count, the applicant may subsequently, if a satisfactory showing is made, move under rule 231 to substitute a count which includes the 6 member group which he discloses.

The interference is redeclared with a "phantom" count including a Markush group of all 7 members and this should be indicated in the decision on motion by calling attention to the fact that the count is a "phantom" count. The redeclaration papers will have the word "phantom" next to the number of the corresponding claim. Care should be taken to be sure that the corresponding application claim contains only the 6 member group disclosed in the application.

This count is established only for interference purposes and thus provides a situation which does not restrict either party as to any testimony or exhibits offered as to the disclosed members included in the count. Such a "phantom" count is only for interference purposes and cannot otherwise appear as a claim in either of the cases since it has no basis therein. Further, such a "phantom" count must be patentable over the prior art.

The practice outlined in A, B, and C above should be restricted to situations where the inventions claimed in the patent and disclosed in the application are clearly the same, so that there is truly an interference in fact.

D. FORMULATION OF TABLE OF COUNTS

Where one or more claims of a patent are not copied identically, the table of counts and claims in form PO–850 (see §§ 1102.01(a) and 1112.05) should be formulated on the basis of the principles set out below.

(1) Where the application claim omits an immaterial limitation or otherwise broadens the corresponding patent claim, indicate by writing (modified), (mod.) or (m) *beside the number of the patent claim.*

(2) Where the application claim is narrower than the corresponding patent claim, indicate by writing (substantially), (subst.) or (s) *beside the number of the application claim.*

(3) Where the application claim is broadened in at least one respect but is narrower in another respect than the corresponding patent claim, a "phantom" count, to be the issue as to the claims concerned, must be drafted incorporating the broadest expressions from both claims and must be indicated by writing (phantom), (phant.) or (p) beside the number of *both* corresponding claims. In this case a copy of the "phantom" count must be attached to the form.

The result of (1) and (2) will be that any count, other than a phantom count, will be identical to the claims in the cases beside it on form PO–850 having no indicator.

For rejection of copied patent claims see § 1101.02(f).

Rule 205. Interference with a patent; copying claims from patent. (a) Before an interference will be declared with a patent, the applicant must present in his application, copies of all the claims of the patent which also define his invention and such claims must be patentable in the application. However, an interference may be declared after copying the claims excluding an immaterial limitation or variation if such immaterial limitation or variation is not clearly supported in the application or if the applicant otherwise makes a satisfactory showing in justification thereof.

(b) Where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure, unless the claim is copied in response to a suggestion by the Office. The examiner will call to the Commissioner's attention any instance of the filing of an application or the presentation of an amendment copying or substantially copying claims from a patent without calling attention to that fact and identifying the patent.

Rule 206. Interference with a patent; claims improperly copied. (a) Where claims are copied from a patent and the examiner is of the opinion that the applicant can make only some of the claims so copied

he shall notify the applicant to that effect, state why he is of the opinion the applicant cannot make the other claims and state further that the interference will be promptly declared. The applicant may proceed under rule 231, if he desires to further contest his right to make the claims not included in the declaration of the interference.

(b) Where the examiner is of the opinion that none of the claims can be made, he shall reject the copied claims stating why the applicant cannot make the claims and set a time limit, not less than 30 days, for reply. If, after response by the applicant, the rejection is made final, a similar time limit shall be set for appeal. Failure to respond or appeal, as the case may be, within the time fixed will in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

When an interference with a patent is proposed it should be ascertained before any steps are taken whether there is common ownership. Note § 804.03. A title report must be placed in both the application and the patented file when the papers for an interference between an application and a patent are forwarded. To this end the examiner, before initiating an interference involving a patent, should refer both the application and the patented file to the Assignment Division for notation as to ownership.

PATENT IN DIFFERENT GROUP

Where claims are copied from a patent classified in another group, the propriety of declaring the interference (if any) is decided by and the interference is declared by the group where the copied claims would be classified. In such a case, it may be necessary to transfer the application, including the drawings, temporarily to the group which will declare the interference. A print of the drawings should be made and filed in the group originally having jurisdiction of the application in place of the original drawings. When classified in different groups, the question of which group should declare the interferences should be resolved by agreement between the examiners of the groups concerned, possibly in consultation with the directors involved.

1101.02(a) Copying Claims From a Patent [R–40]

A large proportion of interferences with a patent arise through the initiative of an applicant in copying claims of a patent which has come to his attention through citation in an Office action or otherwise.

If, in copying a claim from a patent an error is introduced by the applicant, the examiner should correct applicant's claim to correspond to the patent claim.

However, in some instances the examiner observes that certain claims of a patent can be made in a pending application and, if the patent is not a statutory bar, he must take steps to avoid the issuance of a second patent claiming the same invention without an interference. The practice set forth hereinbelow applies when an issued patent and a pending application are not commonly assigned. If there is a common assignment, a requirement for election under rule 78(c) should be required as outlined in § 804.03.

A patent claiming the same invention as that being claimed in an application can be overcome only through interference proceedings. Where the effective filing date of the application is prior to that of the patented application. no affidavit or declaration is required.

If the effective filing date of the applicant is three months or less later than that of the patented application, the applicant must submit an affidavit or declaration that he made the invention prior to the filing date of the patent, even though there was copendency between the two applications, rule 204(b). The affidavit or declaration may be made by persons other than the applicant. See § 715.04.

If the effective filing date of the applicant is more than three months later than that of the patented application, the applicant is required by rule 204(c) to submit a showing by affidavits or declarations including at least one by a corroborating witness, and documentary exhibits setting forth acts and circumstances which if proven by testimony taken in due course would provide sufficient basis for an award of priority to him with respect to the effective filing date of the patent application. In connection with a requirement for a showing under rule 204 (b) or (c), or in examining such a showing submitted voluntarily, the examiner must determine whether or not the patentee is entitled to the filing date of an earlier domestic or foreign application. A determination that a divisional or continuation relationship is acknowledged in the heading of the patent is sufficient for this purpose as to a parent application thus mentioned. In the case of a foreign application this determination will not be made unless the necessary papers (rule 55(b)) are already of record in the file, including a sworn translation of the foreign application if it is not in the English language. Where the benefit of such earlier application is then accorded the patentee, this fact should be noted on the form PO–850 and will be stated in the notices of interference.

The examiner will examine the showing to determine whether it includes the two copies of affidavits or declarations and exhibits as well as an explanation of the pertinency of the showing as required by the rule. If duplicate copies of any of the affidavits, declarations, or exhibits are omitted, the examiner will notify the applicant by letter of such omission and state that because of it the application cannot be forwarded for declaration of the interference. Lack of an explanation should be treated similarly except that if there are accompanying remarks, with the amendment or in a separate paper, which appear to be an explanation (see paragraph numbered 5 below) their sufficiency should not be questioned. A period of twenty days should be set within which to correct the omission.

The substance of the showing will be considered by the examiner only to the extent of determining that it includes at least one allegation of an act relating to priority prior to the effective filing date of the patentee. Absent such a date, the deficiency should be pointed out and the copied claims rejected on the patent with a time limit for response under rule 203. If such an allegation is present and the interference is otherwise proper, the examiner will

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forward the application and the patented file with form PO–850 for declaration of the interference. The Board of Patent Interferences will consider the sufficiency of the showing prior to declaration of the interference (rule 228).

Although, aside from dates, the examiner will not normally attempt any evaluation of the sufficiency of the showing, an exception may be made where it is clear beyond any argument that the showing relates to an invention of a different character from that of the copied claims. In such a case, the examiner may refuse to accept the showing and reject the copied claims on the patent.

If the filing date of the patent precedes the filing date of the application and the patent is not a statutory bar against the application, the claims of the application should be rejected on the patent. If it appears that the applicant is claiming the same invention as is claimed in the patent and that the applicant is able to make one or more claims of the patent, a statement should be included in the rejection that the patent cannot be overcome by an affidavit or declaration under rule 131 but only through interference proceedings. Note, however, 35 U.S.C. 135, 2d par. and § 1101.02(f). If the applicant controverts this statement and presents an affidavit or declaration under rule 131, the case should be considered special, one claim of the patent which the applicant clearly can make should be selected, and an action should be made refusing to accept the affidavit or declaration under rule 131 and requiring the applicant to make the selected claim as well as any other claims of the patent which he believes find support in his application. If necessary, the applicant should be required to file the affidavit or declaration and showing required by rule 204. In making this requirement, where applicable, the applicant should be notified of the fact that the patentee has been accorded an earlier effective filing date by virtue of a patent or foreign application. A time limit for response should be set under rule 203. In any case where an applicant attempts to overcome a patent by means of affidavit or declaration under rule 131, even though the examiner has not made a rejection on the ground that the same invention is claimed in the patent, the claims of the patent should be examined and, if applicant is claiming the same invention as is claimed in the patent and can make one or more of claims of the patent, the affidavit or declaration under rule 131 should be refused, and an action such as outlined in the preceding part of this paragraph should be made. If necessary, the requirements of rule 204 should be specified and a time limit for response should be set under rule 203.

Applicants, in preparing affidavits or declarations under rule 204(c) to secure interference contests with patentees whose filing dates antedate their own by more than three months, should have in mind the provisions of rule 228, and especially the following facts:

1. That after these affidavits or declarations are forwarded by the primary examiner for the declaration of an interference they will be examined by a Board of Patent Interferences.

2. If the affidavits or declarations fail to establish with adequate corroboration acts and circumstances which would prima facie entitle applicant to an award of priority relative to the effective filing date of the patentee, an order will be issued concurrently with the notice of interference, requiring applicant to show cause why summary judgment should not be rendered against him.

3. Additional affidavits or declarations in response to such order will not be considered unless justified by a showing under the provisions of rule 228, and if the applicant responds the patentee will receive from the applicant a copy of the response (rule 247) and from the Patent Office a copy of the original showing (rule 228), and will be entitled to present his views with respect thereto.

4. It is the position of the Board of Patent Interferences that all affidavits or declarations submitted must describe acts which the affiants performed or observed or circumstances observed, such as structure used and results of use or test, except on a proper showing as provided in rule 204(c). Statements of conclusion, for example, that the invention of the counts was reduced to practice, are generally considered to be not acceptable. It should also be kept in mind that documentary exhibits are not self-proving and require explanation by an affiant having direct knowledge of the matters involved. However, it is not necessary that the exact date of conception or reduction to practice be revealed in the affidavits, declarations, or exhibits if the affidavits or declarations aver observation of the necessary acts and facts, including documentation when available, before the patentee's effective filing date. On the other hand, where reliance is placed upon diligence, the affidavits or declarations and documentation should be precise as to dates from a date just prior to patentee's effective filing date.

The showing should relate to the essential factors in the determination of the question of priority of invention as set out in 35 USC 102(g).

5. The explanation required by rule 204(c) should be in the nature of a brief or explana-

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tory remarks accompanying an amendment, and should set forth the manner in which the requirements of the counts are satisfied and how the requirements for conception, reduction to practice or diligence are met.

1101.02(b) Copying Claims From a Patent, Examiner Cites Patent Having Filing Date Later Than That of Application

If a patent, having a filing date later than the filing date of an application, discloses the same subject matter as disclosed in that application and if the application claims the same invention as that claimed in the patent so that a second patent could not be granted without interference proceedings, the patent should be cited and one claim of the patent which applicant clearly can make should be selected and the applicant should be required to make the selected claim as well as any other claims of the patent which he believes find support in his application.

If an application claims an invention patentably different from that claimed in a patent, which discloses the same subject matter as that disclosed in the application but which has a filing date later than the filing date of the application, so that a distinct patent could be granted to the applicant without interference proceedings, the patent should be only cited to the applicant. Thus, it is left to the applicant to determine whether he wishes to and can copy the claims of the patent.

1101.02(c) Copying Claims From a Patent, Difference Between Copying Patent Claims and Suggesting Claims of an Application [R–36]

The practice of an applicant copying claims from a patent differs from the practice of suggesting claims for a prospective interference involving only applications in the following respects:

(1) No correspondence under rule 202 is conducted with a junior applicant who is to become involved in an interference with a patent but, instead, an affidavit or declaration under rule 204 is required.

(2) When a question of possible interference with a patent arises, the patent should be cited, whereas no information concerning the source of the claim should be revealed when a claim is suggested for a prospective interference involving only applications.

(3) All claims of a patent which an applicant can make should be copied.

(4) Claims copied by an applicant from a patent may differ from the patent claims by the exclusion of an immaterial limitation or variation which the applicant can not make *or* upon a satisfactory showing (rule 205(a)), whereas claims suggested for an interference between applications must normally be identical though rule 203(a) permits an exception with the approval of the Commissioner.

1101.02(d) Copying Claims From a Patent, Copied Patent Claims Not Identified [R–40]

Rule 205(b) requires that "where an applicant presents a claim copied or substantially copied from a patent, he must, at the time he presents the claim, identify the patent, give the number of the patented claim, and specifically apply the terms of the copied claim to his own disclosure, unless the claim is copied in response to a suggestion by the Office."

The requirement of rule 205(b) applies to claims copied in an application at the time of filing as well as to claims copied in an amendment to a pending application. If an applicant, attorney, or agent presents a claim copied or substantially copied from a patent without complying with rule 205(b) the examiner may be led into making an action different from what he would have made had he been in possession of all the facts. Therefore, failure to comply with rule 205(b), when submitting a claim copied from a patent, may result in the issuance of an Order to Show Cause why the application should not be stricken from the files of the Patent Office. If a satisfactory answer is not filed within the period set in the Order, it may be necessary to strike the application under rule 56. Rule 205(b) therefore requires the examiner to "call to the Commissioner's attention any instance of the filing of an application or the presentation of an amendment copying or substantially copying claims from a patent without calling attention to the fact and identifying the patent."

1101.02(e) Copying Claims From a Patent, Making of Patent Claims Not a Response to Last Office Action [R–36]

The making of claims from a patent when not required by the Office does not constitute a response to the last Office action and does not

operate to stay the running of the statutory period dating from the unanswered Office action unless the last Office action relied solely on the patent for the rejection of all the claims rejected in that action.

The declaration of an interference based on such claims before the expiration of the statutory period, by operation of rule 212 stays the running of the statutory period. [R–43]

1101.02(f) Copying Claims From a Patent, Rejection of Copied Patent Claims [R–40]

Rejection Not Applicable to Patent

When claims from a patent are made, the application is taken up at once and the examiner may reject such claims in the application if the ground of rejection is not also applicable in the case of the patent. Examples of such a ground of rejection are insufficient disclosure in the application, a reference whose date is junior to that of the patent, or because the claims copied from a patent are barred to applicant by the second paragraph of 35 U.S.C. 135, which reads:

"A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted." The anniversary date of the issuance of a patent is "prior to one year from the date on which the patent was granted", Switzer and Ward v. Sockman and Brady, 142 USPQ 226 (CCPA 1964).

It should be noted that an applicant is permitted to copy a patent claim outside the year period if he has been claiming substantially the same subject matter within the year limit. See Thompson v. Hamilton, 1946 C.D. 70, 68 USPQ 161; In re Frey, 1950 C.D. 362, 86 USPQ 99; Andrews v. Wickenden, 1952 C.D. 176, 93 USPQ 27; In re Tanke et al., 1954 C.D. 212; 102 USPQ 93; Emerson v. Beach, 1955 C.D. 34; 103 USPQ 45; Rieser v. Williams, 118 USPQ 96; Stalego et al. v. Haymes et al., 120 USPQ 473.

As is pointed out in rule 206, where more than one claim is copied from a patent, and the examiner holds that one or more of them are not patentable to applicant and at least one other is, the examiner should at once initiate the interference on the claim or claims considered patentable to applicant, rejecting the others, leaving it to applicant to proceed under rule 231(a)(2) in the event that he does not acquiesce in the examiner's ruling as to the rejected claims.

Where all the claims copied from a patent are rejected on a ground not applicable to the patentee the examiner sets a time limit for reply, not less than thirty days, and all subsequent actions, including action of the Board on appeal, are special in order that the interference may be declared as promptly as possible. Failure to respond or appeal, as the case may be, within the time fixed, will, in the absence of a satisfactory showing, be deemed a disclaimer of the invention claimed.

While the time limit for an appeal from the final rejection of a copied patent claim is usually set under the provisions of rule 206, where the remainder of the case is ready for final action, it may be advisable to set a shortened statutory period for the entire case in accordance with rule 136.

The distinction between a limited time for reply under rule 206 and a shortened statutory period under rule 136 should not be lost sight of. The penalty resulting from failure to reply within the time limit under rule 206 is loss of the claim or claims involved, on the doctrine of disclaimer, and this is appealable; while failure to respond within the set statutory period (rule 136) results in abandonment of the entire application. That is not appealable. Further, a belated response after the time limit set in accordance with rule 206 may be entered by the examiner, if the delay is satisfactorily explained (except that the approval of the Commissioner is required where the situation described in the next paragraph below exists); but one day late under rule 136 period, no matter what the excuse, results in abandonment. However, if asked for in advance, one extension of either period may be granted by the examiner, provided that extension does not go beyond the six month statutory period.

Copied Outside Time Limit

Where a patent claim is suggested to an applicant by the examiner for the purpose of establishing an interference and is not copied within the time limit set or a reasonable extension thereof, an amendment presenting it thereafter will not be entered without the approval of the Commissioner. The Commissioner has delegated this authority to the group directors, § 1003, item 9.

The rejection of copied patent claims sometimes creates a situation where two different periods for response are running against the application—one, the statutory period dating from the last full action on the case; the other, the limited period set for the response to the rejection (either first or final) of the patent claims. This condition should be avoided where possible as by setting a short-

ened period for the entire case, but where unavoidable, it should be emphasized in the examiner's letter.

In this connection it is to be noted that a reply to a rejection or an appeal from the final rejection of the patent claims will not stay the running of the regular statutory period if there is an unanswered Office action in the case at the time of reply or appeal, nor does such reply or appeal relieve the examiner from the duty of acting on the case if it is up for action, when reached in its regular order.

Where an Office action is such as requires the setting of a time limit for response to or appeal from that action or a portion thereof, the examiner should note at the end of the letter the date when the time limit period ends and also the date when the statutory period ends. See § 710.04.

Rejection Applicable to Patent and Application

If the ground of rejection is applicable to both the claims in the application and the claims in the patent, any letter including the rejection must have the approval of the appropriate group director.

An interference will not be declared where the examiner is aware of a reference for the copied claims, even if it would also be applicable to the patent. However, if such a reference is discovered while an interference involving a patent is before the examiner for his decision on motions, he should proceed under rule 237, last sentence. If a reference is discovered at any other time during the course of an interference, the examiner proceeds in accordance with rule 237 and § 1105.05. The group director's approval must be obtained before forwarding the form letter of § 1112.08 and before mailing the decision on motion. See § 1003, item 10.

The decision on such a motion should avoid any comment on the patentability of the claims already granted to the patentee. See Noxon v. Halpert, 128 USPQ 481.

1101.02(g) Copying Claims From a Patent, After Prosecution of Application Is Closed or Application Is Allowed [R–42]

An amendment presenting a patent claim in an application not in issue is usually admitted and promptly acted on. However, if the case had been closed to further prosecution as by final rejection or allowance of all of the claims, or by appeal, such amendment is not entered as a matter of right.

An interference may result when an applicant copies claims from a patent which provided the basis for final rejection. Where this occurs, if the rejection in question has been appealed, the Board of Appeals should be notified of the withdrawal of this rejection so that the appeal may be dismissed as to the involved claims.

Where the prosecution of the application is closed and the copied patent claims relate to an invention distinct from that claimed in the application, entry of the amendment may be denied. (Ex parte Shohan, 1941 C.D. 1; 522 O.G. 501.) Admission of the amendment may very properly be denied in a closed application, if prima facie, the claims are not supported by applicant's disclosure. An applicant may not have recourse to asserting a patent claim which he has no right to make as a means to reopen or prolong the prosecution of his case. See § 714.19(4).

After Notice of Allowance

When an amendment which includes one or more claims copied or substantially copied from a patent is received after the Notice of Allowance and the examiner finds one or more of the claims patentable to the applicant and an interference to exist, he should prepare a letter [see Letter Form § 1112.04], requesting that the application be withdrawn from issue for the purpose of interference. This letter, which should designate the claims to be involved, together with the file and the proposed amendment, should be sent to the group director.

When an amendment is received after Notice of Allowance, which includes one or more claims copied or substantially copied from a patent and the examiner finds basis for refusing the interference on any ground he should make an oral report to the supervisory primary examiner of the reasons for refusing the requested interference. Notification to applicant is made on Form POL–271 if the entire amendment or a portion of the amendment (including all the copied claims) is refused. The following or equivalent language should be employed to express the adverse recommendation as to the entry of the copied or substantially copied patent claims:

"Entry of claims _____ is not recommended because (brief statement of basic reasons for refusing interference). Therefore withdrawal of the application from issue is not deemed necessary."

1101.03 Removing of Affidavits or Declarations Before Interference [R–28]

When there are of record in the file, affidavits or declarations under rule 131, 204(b) or 204(c) they should not be sealed but should be left in the file for consideration by the Board of Interference Examiners. If the interference proceeds normally, these affidavits or declarations will be removed and sealed up by the Service Branch of the Board of Patent Interferences and retained with the interference.

In the event that there had been correspondence under rule 202, this should be obtained from the associate solicitor and left (unsealed) in the file.

Affidavits or declarations under rules 131 and 204, as well as an affidavit or declaration under rule 202 (which never becomes of record in the application file) are available for inspection by an opposing party to an interference when the preliminary statements are opened. Ferris v. Tuttle, 1940 C.D. 5; 521 O.G. 523.

The now opened affidavits or declarations filed under rules 131 and 204 may then be returned to the application files and the affidavits or declarations filed under rule 202 filed in the interference jacket.

1102 Preparation of Interference Papers and Declaration [R–22]

Rule 207. Preparation of interference papers and declaration of interference. (a) When an interference is found to exist and the applications are in con-

dition therefor, the primary examiner shall forward the files to the Board of Patent Interferences together with a statement indicating the claims of each applicant or patentee which are to form the respective counts of the interference and also indicating whether any party is entitled to the benefit of the filing date of any prior application as to the subject matter in issue, and, if so, identifying such application.

(b) A patent interference examiner will institute and declare the interference by forwarding notices to the several parties to the proceeding. Each notice shall include the name and residence of each of the other parties and those of his attorney or agent, and of any assignee, and will identify the application of each opposing party by serial number and filing date, or in the case of a patentee by the number and date of the patent. The notices shall also specify the issue of the interference, which shall be clearly and concisely defined in only as many counts as may be necessary to define the interfering subject matter (but in the case of an interference with a patent all the claims of the patent which can be made by the applicant should constitute the counts), and shall indicate the claim or claims of the respective cases corresponding to the count or counts. If the application or patent of a party included in the interference is a division, continuation or continuation-in-part of a prior application and the examiner has determined that it is entitled to the filing date of such prior application, the notices shall so state. Except as noted in paragraph (e) of this rule, the notices shall also set a schedule of times for taking various actions as follows:

(1) For filing the preliminary statements required by rule 215 and serving notice of such filing, not less than 2 months from the date of declaration.

(2) For each party who files a preliminary statement to serve a copy thereof on each opposing party who also files a preliminary statement as required by rule 215(b), not less than 15 days after the expiration of the time for filing preliminary statements.

(3) For filing motions under rule 231, not less than 4 months from declaration.

(c) The notices of interference shall be forwarded by the patent interference examiner to all the parties, in care of their attorneys or agents; a copy of the notices will also be sent the patentees in person and, if the patent in interference has been assigned, to the assignees.

(d) When the notices sent in the interest of a patent are returned to the Office undelivered, or when one of the parties resides abroad and his agent in the United States is unknown, additional notice may be given by publication in the Official Gazette for such period of time as the Commissioner may direct.

(e) In a case where the showing required by rule 204(c) is deemed insufficient (rule 228) the notice of interference will not set the time schedule specified in paragraph (b) of this rule but will be accompanied by an order to show cause by the Board of Patent Inteferences as provided by rule 228.

1102.01 Preparation of Papers [R–28]

The only paper prepared by the examiner is the Initial Memorandum (Form PO–850) addressed to the Board of Patent Interferences which provides authorization for preparation of the Notices of Interference and the Declaration Sheet. The latter papers are prepared in the Service Branch of the Board of Patent Interferences.

In declaring or redeclaring an interference the following should be borne in mind:

(1) That no party should be made junior as to some counts and senior as to others, but that two interferences should be set up making the party with two applications junior in one interference and senior in the other.

(2) That no interference should be declared in which each party to the interference is not involved on every count.

(3) That where an applicant puts identical claims in two applications by virtue of one of which he will be the senior party and of the other the junior the latter application should be placed directly in the interference, leaving the applicant to gain such benefit as he may from the senior application either by motion to shift the burden of proof or by introducing the senior into the interference as evidence." (In re Redeclaration of Interference Nos. 49,635; 49,636; 49,866; 1926 C.D. 75; 350 O.G. 3.)

The Initial Memorandum and the files to be involved are forwarded to the Interference Service Branch, including prior applications or patent files benefit of which is being accorded. Any correspondence under rule 202 should be obtained from the associate solicitor and forwarded with the other papers. See § 1101.03. This same practice obtains in the case of affidavits or declarations of this nature in earlier applications the benefits of which is accorded a party by the examiner in the initial memorandum. Such cases will be acknowledged in the Declaration papers.

Rule 207(b) requires inclusion of the name and residence of any assignee in the declaration notice. Therefore, a recent title report on all the applications and patents involved should be obtained by the examiner and forwarded with the other papers to the Board of Patent Interferences.

The information to be included in the initiating memorandum is set forth in § 1102.01(a).

1102.01(a) Initial Memorandum to the Board of Patent Interferences [R–42]

The initial memorandum to the Board of Patent Interferences is written on Form PO–

850, shown in § 1112.05 and is signed by the primary examiner. Since the files will be available, information found on the file wrapper is unnecessary and is not desired except as indicated on the form. The form is designed to require a minimum of effort by the examiner and typing should not be used unless the counts are not found verbatim in any file as provided in the last sentence of rule 203(a). In this case copies of the counts should be supplied at the end of the form using additional plain sheets if needed. The files to be included in the interference should be listed by last name (of first listed inventor if application is joint), serial number, and filing date irrespective of whether an application or a patent is involved. The sequence of the listed applications is completely immaterial. If the examiner has determined that a party is entitled to the benefit of the filing date of one or more applications (or patents) as to all counts, the blanks provided on the form for indicating this fact should be filled in as to all such applications. It is particularly important to list all applications necessary to provide continuity of pendency to the earliest application to which a party is entitled. The date of abandonment or patenting of a prior application should be indicated by checking the appropriate box and writing the date. The word "pending" should be written if a prior application is still pending. An applicant will be accorded the benefit of a foreign application on the form PO–850 and declaration notices only if he has filed the papers required by rule 55, including a sworn translation, and the primary examiner has determined that he is in fact entitled to the benefit of such application. A patentee may be accorded the benefit of the filing date of a foreign application in the notice of interference provided he has complied with the requirements of rule 55, has filed a sworn translation, and the primary examiner has determined that the patented claims involved in the interference are supported by the disclosure of the foreign application. This should be noted on form PO–850 (see § 1101.02(a)). The claims in each case which are unpatentable over the issue should be indicated in the blanks provided for that purpose. The examiner must also complete the table showing the relation of the counts to the claims of the respective parties in the area provided in the form.

The indication of claims in each case which are regarded as unpatentable over the issue is based on the decisions in Votey v. Wuest v. Doman, 1904 C.D. 323; 111 O.G. 1627 and Earll v. Love, 1909 C.D. 56; 140 O.G. 1209. When an interference is declared and the examiner is of the opinion that the application or applications contain claims not patentably different from the issue of the interference, he should specify them by number on form PO–850 so that they will be held subject to the decisions in the interference.

Such a specifying of claims gives the parties notice as to what claims the examiner considers unpatentable over the issue, it avoids the inadvertent granting of claims to the losing party which are not patentable over the issue, but which are not included therein, and will probably result in fewer motions under rule 231(b).

In carrying out the provisions of rule 208, examiners, when forwarding the Initial Memorandum to the Board of Patent Interferences, will in a separate memorandum, call their attention to cases in which two of the parties are represented by the same attorney, in lieu of calling the matter directly to the attention of the Commissioner. The patent interference examiner when mailing out the notices to the parties and their attorney will advise the parties and the attorney that the attorney will not be recognized further as representing either party in the interference or in the interfering cases unless he shows that he is entitled to continue to represent either or both parties as provided by rule 208. The patent interference examiner will also call to the attention of the parties and the attorney the requirement of the second sentence of rule 201(c).

In an interference involving a patent, if the primary examiner discovers a reference which, in his opinion, renders a count obviously unpatentable, action should be taken in accordance with § 1101.02(f).

In situations where exactly corresponding claims are not present in the applications and patent considered to be interfering, see the guides and examples set forth in § 1101.02 under the heading D. FORMULATION OF TABLE OF COUNTS as to the proper designation of the relationship of the claims to the counts. If an application was merely in issue and did not become a patent, the original claim numbers of the application, prior to revision for issue, should be used.

A certificate of correction in a patent should not be overlooked. For the best practice in interference between applications, dependent counts should be avoided and each count should be independent. This avoids confusion in language and disputes as to the meaning of the counts. When dependent counts cannot be avoided, as in the case of an interference with a patent where one of the counts is a dependent claim, the count may likewise be dependent on the count corresponding to the claim on which the dependent claim is founded. If necessary a dependent claim may be the sole count of an interference.

1102.02 Declaration of Interference [R–25]

The papers necessary in declaring an interference are prepared in the Interference Service Branch. The notices to the parties and the declaration sheet are signed by a patent interference examiner, who institutes and declares the interference by mailing the notices to the several parties to the proceeding. Thereafter the applications and interference files are kept in the Service Branch where they are also recorded in a card index.

If an application that has been made special by the Commissioner becomes involved in an interference, the interference will be made special, provided the prosecution of such application has been diligent on the part of the applicant. See § 708.01.

1103 Suspension of Ex Parte Prosecution, Full or Partial [R–25]

Rule 212. Suspension of ex parte prosecution. On declaration of the interference, ex parte prosecution of an application is suspended, and amendments and other papers received during the pendency of the interference will not be entered or considered without the consent of the Commissioner, except as provided by these rules. Proposed amendments directed toward the declaration of an interference with another party will be considered to the extent necessary. Ex parte prosecution as to specified matters may be continued concurrently with the interference, on order from or with the consent of the Commissioner.

The treatment of amendments filed during an interference is considered in detail in §§ 1108 and 1111.05.

Ex parte prosecution of an appeal under rule 191 may proceed concurrently with an interference proceeding involving the same application provided the primary examiner who forwards the appeal certifies, in a memorandum to be placed in the file, that the subject matter of the interference does not conflict with the subject matter of the appealed claims.

For treatment of other applications by the same inventor or assignee having overlapping claims with the application being put into interference see §§ 709.01 and 1111.03.

1104 Jurisdiction of Interference [R–25]

Rule 211. Jurisdiction of interference. (a) Upon the institution and declaration of the interference, as provided in rule 207, the Board of Patent Interferences will take jurisdiction of the same, which will then become a contested case.

(b) The primary examiner will retain jurisdiction of the case until the declaration of interference is made.

The declaration of interference is made when the patent interference examiner mails the notices of interference to the parties. The interference is thus technically pending before the Board of Patent Interferences from the date on which the letters are mailed, and from that date the files of the various applicants are opened to inspection by other parties. Rule 226.

Throughout the interference, the interference papers and application files involved are in the keeping of the Service Branch except at such times that action is required as for decision on motions, final hearings, appeals, etc., when they are temporarily in possession of the tribunal before whom the particular question is pending.

If, independent of that interference, action as to one or more of the applications becomes necessary, the examiner charges out the necessary application or applications from the Service Branch by leaving a charge card. It is not foreseen that the primary examiner will need to take action for which he requires jurisdiction of the entire interference. However, if circumstances arise which appear to require it, the primary examiner should request jurisdiction from the Board of Patent Interferences.

The examiner merely borrows a patent file, if needed, as, where the patent is to be involved in a new interference.

1105 Matters Requiring Decision by Primary Examiner During Interference [R–37]

Rule 231 Motions before the primary examiner. (a) Within the period set in the notice of interference for filing motions any party to an interference may file a motion seeking:

(1) To dissolve as to one or more counts, except that such motion based on facts sought to be established by affidavits, declarations, or evidence outside of office records and printed publications will not normally be considered, and when one of the parties to the interference is a patentee, no motion to dissolve on the ground that the subject matter of the count is unpatentable to all parties or is unpatentable to the patentee will be considered, except that a motion to dissolve as to the patentee may be brought which is limited to such matters as may be considered at final hearing (rule 258). Where a motion to dissolve is based on prior art, service on opposing parties must include copies of such prior art. A motion to dissolve on the ground that there is no interference in fact will not be considered unless the interference involves a design or plant patent or application or unless it relates to a count which differs from the corresponding claim of an involved patent or of one or more of the involved applications as provided in rules 203(a) and 205(a).

(2) To amend the issue by addition or substitution of new counts. Each such motion must contain an explanation as to why a count proposed to be added is necessary or why a count proposed to be substituted is preferable to the original count, must demonstrate patentability of the count to all parties and must apply the proposed count to all involved applications except an application in which the proposed count originated.

(3) To substitute any other application owned by him as to the existing issue, or to declare an additional interference to include any other application owned by him as to any subject matter other than the existing issue but disclosed in his application or patent involved in the interference and in an opposing party's application or patent in the interference which should be made the basis of interference with such other party. Complete copies of the contents of such other application, except affidavits or declarations under rules 131, 202, and 204, must be served on all other parties and the motion must be accompanied by proof of such service.

(4) To be accorded the benefit of an earlier application or to attack the benefit of an earlier application which has been accorded to an opposing party in the notice of declaration. See rule 224.

(5) To amend an involved application by adding or removing the names of one or more inventors as provided in rule 45. (See paragraph (d) of this rule.)

(b) Each motion must contain a full statement of the grounds therefor and reasoning in support thereof. Any opposition to a motion must be filed within 20 days of the expiration of the time set for filing motions and the moving party may, if he desires, file a reply to such opposition within 15 days of the date the opposition was filed. If a party files a timely motion to dissolve, any other party may file a motion to amend within 20 days of the expiration of the time set for filing motions. Service on opposing parties of an opposition to a motion to amend which is based on prior art must include copies of such prior art. In the case of action by the primary examiner under rule 237, such motions may be made within 20 days from the date of the primary examiner's decision on motion wherein such action was incorporated or the date of the communication giving notice to the parties of the proposed dissolution of the interference.

(c) A motion to amend or to substitute another application must be accompanied by an amendment adding the claims in question to the application concerned if such claims are not already in that application.

(d) All proper motions as specified in paragraph (a) of this rule, or of a similar character, will be transmitted to and considered by the primary examiner without oral argument, except that consideration of a motion to dissolve will be deferred to final hearing before a Board of Patent Interferences where the motion urges unpatentability of a count to one or more parties which would be reviewable at final hearing under rule 258(a) and such unpatentability is urged against a patentee or has been ruled upon by the Board of Appeals or by a court in ex parte proceedings. Also consideration of a motion to add or remove the names of one or more inventors may be deferred to final hearing if such motion is filed after the times for taking testimony have been set. Requests for reconsideration will not be entertained.

(e) In the determination of a motion to dissolve an interference between an application and a patent, the prior art of record in the patent file may be referred to for the purpose of construing the issue.

(f) Upon the granting of a motion to amend and the adoption of the claims by the other parties within a time specified, or upon the granting of a motion to substitute another application, and after the expiration of the time for filing any new preliminary statements, a patent interference examiner shall redeclare the interference or shall declare such other interferences as may be necessary to include said claims. A preliminary statement as to the added claims need not be filed if a party states that he intends to rely on the original statement and such a declaration as to added claims need not be signed or sworn to by the inventor in person. A second time for filing motions will not be set and subsequent motions with respect to matters which have been once considered by the primary examiner will not be considered.

An interference may be enlarged or diminished both as to counts and applications involved, or may be entirely dissolved, by actions taken under rule 231 "Motions before the primary examiner" or under rule 237 "Dissolution at the request of examiner". The action may be a substitution of one or more counts,

the addition of counts or dissolution as to one or more counts or as to all counts, a change in the application by addition, substitution, or dissolution a shifting of the burden of proof, or a conversion of an application by changing the number of inventors. See § 1111.07. Decisions on questions arising under this rule are made under the personal supervision of the primary examiner.

Examiners should not consider *ex parte*, when raised by an applicant, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party an interest. See § 1111.01.

Occasionally the entire subject matter of the interference may have been transferred to another group between the time of declaring the interference and the time that motions are transmitted for consideration. If this has occurred, after the second group has agreed to take the case, the Interference Service Branch should be notified so that appropriate changes may be made in their records.

1105.01 Briefs and Consideration of Motions [R–25]

A party filing a motion is expected to incorporate his reasons with the motion so that an initial brief is not contemplated although if filed with the motion it would not be objectionable. Under rule 231(b) other parties have twenty days from the expiration of the time for filing motions for filing an opposition to a motion, and the moving party may file a reply brief within fifteen days of the date such opposition is filed. If a motion to dissolve is filed by one party the other parties may file a motion to amend within 20 days from the expiration of the time set for filing motions and the same times for opposition and reply brief are allowed with respect to the filing date of the latter motion.

After the expiration of the time for filing a reply brief, motions filed under rule 231 are examined by a Patent Interference Examiner who, if he finds them to be proper motions, will transmit the case to the primary examiner for consideration of the motions with an indication of such motions as are improper under the rules and which should not be considered if there be any such. No oral hearing will be set. The primary examiner should render a decision within one month on each motion transmitted by the Patent Interference Examiner. The decision must include the basis for any conclusions arrived at by the primary examiner. Care must be taken to specifically identify which limitations of a count are not supported, or the portions of the specification which do provide support for the limitations of the count when necessary to decide a motion. The examiner should not undertake to answer all arguments presented.

In motions of the types specified below the primary examiner must consult with and obtain the approval of a member of the Board of Patent Interferences before mailing the decision. Motions requiring such consultation and approval are:

Motions to amend where the matter of support for a count is raised in opposition or the examiner decides to deny the motion for that reason,

Motions relating to the benefit of a prior application,

Motions to dissolve on the ground that one or more parties have no right to make the counts,

Motions to dissolve on the ground of no interference in fact,

Motions to convert an application to a different number of inventors,

Motions to substitute or involve another application in interference where the matter of support for a count is raised in opposition or the examiner decides to deny the motion for that reason,

Motions to amend involving modified or "phantom" counts,

Motions to amend seeking to broaden a patent claim and an issue is raised with respect to the showing in justification.

Requests should be made to the Patent Interference Examiner for the assignment of the Board member to be consulted. The consultation will normally be at the offices of the Board of Patent Interferences. The primary examiner should arrange a convenient time by telephone. In the case of motions to amend or to involve another application the Patent Interference Examiner will examine any opposition which may have been filed and if the question of right to make the proposed counts as to any party is raised thereby, he will indicate in his letter transmitting motions the necessity for consultation. If such indication is not made there will be no necessity for consultation unless the primary examiner from his own consideration concludes that one or more parties cannot make one or more of the proposed counts. In this case he should inquire of the Patent Interference Examiner as to which member to consult.

1105.02 Decision on Motion To Dissolve [R–36]

By the granting of a motion to dissolve, one or more parties may be eliminated from the interference; or certain of the counts may be

eliminated. Where the interference is dissolved as to one or more of the parties but at least two remain, the interference is returned to the primary examiner prior to resumption of proceedings before the Patent Interference Examiner for removal of the files of the parties who are dissolved out. *Ex parte* action is resumed as to those applications and the interference is continued as to the remaining parties. The *ex parte* action then taken in each rejected application should conform to the practice set forth hereinafter under the heading "Action After Dissolution" (§ 1110). See § 1302.12 with respect to listing references discussed in motion decision.

With respect to a motion to dissolve on the ground that one or more parties does not have the right to make one or more counts it should be kept in mind that once the interference is dissolved as to a count any appeal from a rejection based thereon is ex parte and the views of other parties in the interference will not be heard. In order to preserve the *inter parties* forum for consideration of this matter a motion to dissolve on this ground should not be granted where the decision is a close one but only where there is clear basis for it.

It should be noted that if all parties agree upon the same ground for dissolution, which ground will subsequently be the basis for rejection of the interference count to one or more parties, the interference should be dissolved *pro forma* upon that ground, without regard to the merits of the matter. This agreement among all parties may be expressed in the motion papers, in the briefs, or in papers directed solely to that matter. See Buchli v. Rasmussen, 339 O.G. 223; 1925 C.D. 75, and Tilden v. Snodgrass, 1923 C.D. 30; 309 O.G. 477 and Gelder v. Henry, 77 USPQ 223.

Affidavits or declarations relating to the disclosure of a party's application as, for example, on the matter of operativeness or right to make should not be considered but affidavits or declarations relating to the prior art may be considered by analogy to rule 132.

If there is considerable doubt as to whether or not a party's application is operative and it appears that testimony on the matter may be useful to resolve the doubt, a motion to dissolve may be denied so that the interference may continue and testimony taken on the point. See Bowditch v. Todd, 1902 C.D. 27; 98 O.G. 792 and Pierce v. Tripp v. Powers, 1923 C.D. 69 at 72, 316 O.G. 3.

Where the effective date of a patent or publication (which is not a statutory bar) is antedated by the effective filing dates or the allegations in the preliminary statements of all parties, then the anticipatory effect of that patent or publication need not be considered by the examiner at this time, but the reference should be considered if at least one party fails to antedate its effective date by his own filing date or the allegations in his preliminary statement. See Forsyth v. Richards, 1905 C.D. 115; 115 O.G. 1327 and Simons v. Dunlop, 103 USPQ 237.

In deciding motions under rule 231(a)(1) the examiner should not be misled by citation of decisions of the Court of Customs and Patent Appeals to the effect that only priority and matters ancillary thereto will be considered and that patentability of the counts will not be considered. These court decisions relate only to the final determination of priority, after the interference has passed the motion stage; in the ordinary case a motion to dissolve may attack the patentability of the count and need not be limited to matters which are ancillary to priority.

Where a motion to dissolve is based on a contention of no interference in fact, the question to be decided is whether claims presented by respective parties as corresponding to the count or counts in issue claim the same invention even though a claim of one party differs from the corresponding claim of another party through omission of limitations or variation in language under rule 203(a) or rule 205(a). See § 1101.02. Since the claims were found allowable prior to declaration, granting of a motion to dissolve on this ground would normally result in issuance of the respective claims to each party concerned in separate patents. The question to be decided then, is whether one or more limitations in the claim of one party which are omitted or broadened in the claim of another party are material. Whether or not they are material depends primarily on whether they were regarded as significant in allowing the claim in the first instance. That is, the prosecution should be examined to determine if the limitation in question was relied upon to distinguish from cited prior art, or if it was essential to obtaining the desired result. See Mabon v. Sherman, 34 CCPA 991, 73 USPQ 378, 161 F.2d 255, 1947 C.D. 325 (CCPA, 1947); Brailsford v. Lavet et al., 50 CCPA 1367, 138 USPQ 28, 318 F. 2d 942, 1963 C.D. 723 (CCPA, 1963); and Knell v. Mueller et al., 174 USPQ 460 (Comm. of Pats., 1971). [R–40]

1105.03 Decision on Motion To Amend or To Add or Substitute Another Application [R–36]

Motions by the interfering parties may be made under rule 231(a) (2) and (3) to add or

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substitute counts to the interference and also to substitute or involve in interference other applications owned by them. It should be noted that, if the examiner grants a motion of this character, he sets a time for the nonmoving parties to present the allowed proposed counts in their applications, if necessary, and also sets a time for all parties to file preliminary statements as to the allowed proposed counts. An illustrative form for these requirements is given at § 1105.06. If the claims are made by some or all of the parties within the time limit set, the interference is reformed or a new interference is declared by the Patent Interference Examiner.

If a motion under rule 231(a)(3) relates to an application in issue, the application should be withdrawn from issue prior to decision on the motion only if the motion is transmitted to the primary examiner after the issue fee has been paid or the date of transmittal is so close to the ultimate date for paying the issue fee that the motion cannot be decided prior to that date. For form see § 1112.04.

The case should then be withdrawn from issue even though the examiner may be of the opinion that the motion will probably be denied, but this withdrawal does not reopen the case to further ex parte prosecution and if the motion is denied the case is returned to issue with a new notice of allowance.

It will be noted that rule 231(a)(3) does not specify that a party to the interference may bring a motion to include an application or patent owned by him as to subject matter, in addition to the existing issue, which is not disclosed both in his application or patent already in the interference and in an opposing party's application or patent in the interference. Consequently the failure to bring such a motion will not be considered by the examiner to result in an estoppel against any party to an interference as to subject matter not disclosed in his case in the interference. On the other hand, if such a motion is brought during the motion period, secrecy as to the application named therein is deemed to have been waived, access thereto is given to the opposing parties and the motion may be transmitted by the Patent Interference Examiner; if so transmitted, it will be considered and decided by the primary examiner without regard to the question of whether the moving party's case already in the interference discloses the subject matter of the proposed claims.

Concurrence of All Parties

Contrary to the practice which obtains when all parties agree upon the same ground for dissolution, the concurrence of all parties in a motion to amend or to substitute or add an application does not result in the automatic granting of the motion. The mere agreement of the parties that certain proposed counts are patentable does not relieve the examiner of his duty to determine independently whether the proposed counts are patentable and allowable in the applications involved. Even though no references have been cited against proposed counts by the parties, it is the examiner's duty to cite such references as may anticipate the proposed counts, making a search for this purpose if necessary.

Also, care should be exercised, in deciding motions, that any counts to be added to the existing interference differ materially from the original counts and from each other, and that counts of additional interferences likewise differ materially from the counts of the first interference and from each other § 1101.01(j).

A good test to apply is whether different proofs may be required to prove priority as, for example, in the case of a generic original count and a proposed count to a species, or vice versa. If the answer is affirmative, the motion to add the proposed count should be granted. When a patent is involved, all of the patent claims which the applicant can make must be included as counts of the interference.

The examiner should also be careful not to refuse acceptance of a count broader than original counts solely on the ground that it does not differ materially from them. If that is in fact the case, and the proposed count is patentable over the prior art, the examiner should grant the motion to the extent of substituting the proposed count for the broadest original count so that the parties will not be limited in their proofs to include one or more features which are unnecessary to patentability of the count. Where there is room for a reasonable difference of opinion as to whether two claims are materially different (or patentably distinct) it is advisable to add the proposed claim to the issue rather than to substitute it for the original count. This will allow the parties to submit priority evidence as to both counts.

Affidavits or declarations are occasionally offered in support of or in opposition to motions to add or substitute counts or applications. The practice here is the same as in the case of affidavits or declarations concerning motions to dissolve that is, affidavits or declarations relating to disclosure of a party's application as, for example, on the matter of operativeness or right to make, should not be considered, but affidavits or declarations relating to the prior art may be considered by analogy to rule 132.

If a motion under rule 231(a)(2) or (3) is denied on the basis of a reference which is not

a statutory bar, and which is cited for the first time by the examiner in his decision, the decision may be modified and the motion granted upon the filing of proper affidavits or declarations under rule 131 in the application file of the party involved. This is by analogy to rule 237, although normally, request for reconsideration of decisions on motions under rule 231 will not be entertained. Rule 231(d). These affidavits or declarations should not be opened to the inspection of opposing parties and no reference should be made to the dates of invention set forth therein other than the mere statement that the effective date of the reference has been overcome. As in the case of other affidavits or declarations under rule 131, they remain sealed until the preliminary statements for the new counts are opened.

A member of the Board of Patent Interferences must be consulted in connection with motions to add or substitute one or more counts or applications where the matter of right to make one or more counts is raised in an opposition to the motion or the primary examiner wishes to deny a motion for that reason although it has not been raised by a party. In the event the consultation ends in disagreement, the the matter will be resolved by the Deputy Assistant Commissioner for Patents. [R–43]

1105.04 Decision on Motion Relating to Benefit of a Prior Application Under Rule 231(a)(4) [R–43]

The primary examiner also decides motions relating to benefit of a prior application under rule 231(a)(4). These may involve shifting the burden of proof or merely giving a party the benefit of an earlier date which will not change the order of the parties. They may result in judgment or order to show cause against a junior party whose preliminary statement does not allege dates prior to the earlier application or, in the case of a junior party, they may shorten the period for which diligence must be proved or change the burden of proof from that of beyond reasonable doubt to a mere preponderance of the evidence.

If there is doubt whether an earlier application discloses the invention involved in the interference, there being a reasonable ground for denying the party's right to it, a party should not be given the earlier record date. The denial of a motion to shift the burden of proof does not deprive a party of the benefit of the earlier application upon which the motion was based. He may have the matter reviewed at final hearing (rule 258) and he may introduce that application as part of his evidence to be subject to argument by all parties and to be considered by the Board of Patent Interferences. See Greenawalt v. Mark, 1904 C.D. 352; 111 O.G. 2224.

In deciding a motion of this nature, it is usually advisable first to determine exactly which counts will be involved in the final redeclaration of the interference. The practice in deciding the motion should then follow that set forth in the case of In re Redeclaration of Interferences Nos. 49,635; 49,636; 49,866; 1926 C.D. 75; 350 O.G. 3. In accordance with the last stated case, no party in an interference should be made junior as to some counts and senior as to others. Therefore, if, in considering a motion to shift the burden of proof, it is found that the moving party is entitled to the benefit of an earlier filed application as to some counts but not as to other counts in the same interference, the motion should be denied.

In accordance with present practice an earlier filed application disclosing a single species (including chemical compositions) in such a manner as to comply with the first paragraph of 35 U.S.C. 112 is a constructive reduction to practice of a count expressing the genus provided continuity of disclosure has been maintained between the earlier application and the involved application either by copendency or by a chain of successively copending applications. Where such an application is a constructive reduction to practice, the benefit of its filing date may be obtained by a junior party by a motion to shift the burden of proof. See McBurney v. Jones, 104 USPQ 115; Den Beste v. Martin, 1958 C.D. 178, 729 O.G. 724; Fried et al. v. Murray et al., 1959 C.D. 311, 746 O.G. 563; In re Kirchner, 1962 C.D. 477, 134 USPQ 324, (CCPA 1962).

With respect to the shifting of the burden of proof it should be noted that the order of taking testimony should be placed upon the applicant last to file unless all the counts of the interference read upon an earlier application which antedates that of the other party.

For proving of foreign filing for priority see §§ 201.14, 201.15.

1105.05 Dissolution on Primary Examiner's Own Request Under Rule 237 [R–25]

Rule 237. Dissolution at the request of examiner. If, during the pendency of an interference, a reference or other reason be found which, in the opinion of the primary examiner, renders all or part of the counts unpatentable, the attention of the Board of Patent Interferences shall be called thereto. The interference may be suspended and referred to the primary examiner for consideration of the matter, in which case the

parties will be notified of the reason to be considered. Arguments of the parties regarding the matter will be considered if filed within 20 days of the notification. The interference will be continued or dissolved in accordance with the determination by the primary examiner. If such reference or reason be found while the interference is before the primary examiner for determination of a motion, decision thereon may be incorporated in the decision on the motion, but the parties shall be entitled to reconsideration if they have not submitted arguments on the matter.

Rule 237 covers dissolution of an interference on the primary examiner's own motion if he discovers a reference or other reason which renders all or part of the counts unpatentable.

Two procedures are available under this rule: First, if the primary examiner finds a reference or other reason for terminating the interference in whole or in part the interference is before him for determination of a motion, decision on this newly discovered matter "may be incorporated in the decision on the motion, but the parties shall be entitled to reconsideration "if they have not submitted arguments on the matter" (rule 237). This same practice obtains when the primary examiner discovers a new reason for holding counts proposed under rule 231(a) (2) or (3) unpatentable. Under this practice, the primary examiner should state that reconsideration may be requested within the time specified in rule 244(c). Second, if the primary examiner finds a reference or other reason for terminating the interference in whole or in part when the interference is not before him for determination of a motion, he should call the attention of the Patent Interference Examiner to the matter. The primary examiner should include in his letter to the Patent Interference Examiner a statement applying the reference or reason to each of the counts of the interference which he deems unpatentable and should forward with the original signed letter a copy thereof for each of the parties of the interference. Form at § 1112.08.

If preliminary statements have become open to all parties, rule 227, or if not and a party authorizes the primary examiner to inspect his preliminary statement, effect may be given thereto in considering the applicability of a reference to the count under rule 237. See § 1105.02.

The Patent Interference Examiner may suspend the interference and refer the case to the primary examiner for his determination of the question of patentability, which is *inter partes* as in the case of a motion to dissolve. Briefs may be filed within twenty days of the notification of the parties of the referral, but no hearing will be set. Decision is prepared and mailed by the primary examiner as in the case of a motion to dissolve.

In cases involving a patent and an application where the primary examiner raises the question of patentability of the count, attention is directed to Noxon v. Halpert, 128 USPQ 481.

If, in an interference involving two or more applications, a reference is brought to the attention of the examiner by one of the parties to the interference, that fact should be made of record by the examiner in his letter to the Examiner of Interferences under rule 237.

If, in an interference involving an application and a patent, the *applicant* calls attention to a reference which he states anticipates the issue of the interference, the Examiner of Interferences will forthwith dissolve the interference, and the primary examiner will thereupon reject the claim or claims to the applicant on his own admission of nonpatentability without commenting on the pertinency of the reference. Such applicant is of course also estopped from claiming subject matter not patentable over the issue. A reference cited by the *patentee* which is applicable against the claims of the patent, will be ignored. A reference newly discovered by the *primary examiner* is treated in accordance with § 1101.02(f).

1105.06 Form of Decision Letter [R–43]

In order to reduce the pendency of applications involved in interference proceedings, primary examiners are directed to render decisions on motions within 30 days of the date of transmittal to them.

The decision should separately refer to and decide each motion which has been transmitted by a statement of decision as granted or denied. The decision must include the basis for any conclusions arrived at by the primary examiner. Care must be taken to specifically identify which limitations of a count are not supported, or the portions of the specification which do provide support for the limitations of the count when necessary to decide a motion. Different grounds urged for seeking a particular action, such as dissolution for example, should be referred to and decided as separate motions. When a motion to dissolve on the ground of no right to make urges lack of support for more than one portion of a count and is granted, the examiner should indicate which portions of the count he considered not to be disclosed in the application in question. The same practice applies in denying a party the benefit of prior application.

Motions to amend or to substitute an application, if unopposed, do not require any statement of conclusion if granted, but a denial

should be supplemented by a statement of the conclusion on which denial is based. If such a motion is granted over opposition, the reason for overruling the opposition should be given. If an application is to be added or substituted and the examiner has determined that it is entitled to the filing date of a prior application by virtue of a divisional, continuation or continuation-in-part relationship, the decision should so state.

MOTION DECISION EXAMPLES

The motion by Brown to dissolve on the ground of unpatentability to all parties over X in view of Y is denied. The combination of references proposed in the motion is not considered obvious.

The motion by Brown to dissolve on the ground that Jones has no right to make the count is granted. It is considered that the expression "_____" is not supported by the Jones disclosure.

The motion by Jones to substitute proposed count 2 for the present count is unopposed and is granted.

The motion by Jones to add proposed count 3 is denied. The expression "_____" is considered to be ambiguous.

The motion by Smith to shift the burden of proof is granted. The prior application relied upon is found to be a constructive reduction to practice of the invention defined by the count.

It is usually advisable to decide motions to dissolve first, then motions to amend or to substitute an application, and finally motions to shift the burden of proof or relating to benefit of an earlier application taking into account any changes in the issue or the parties which may have been effected by the granting of other motions. If a motion to shift the burden of proof is granted the change in the order of parties should be stated.

If a motion to amend is granted the decision should close with paragraphs setting times for nonmoving parties to present claims corresponding to the newly admitted counts and for all parties to file preliminary statements as to them. Such paragraphs should take the following form:

"Should the parties Smith and Brown desire to contest priority as to proposed count 2, they should assert it by amendment to their respective applications on or before _____, and failure to so assert it within the time allowed will be taken as a disclaimer of the subject matter thereof.

On or before _____, the statements demanded by rules 215 *et seq.* with respect to proposed count 2 must be filed in a sealed envelope bearing the name of the party filing it and the number and title of the interference. See also rule 231(f), second sentence. The time for serving preliminary statements, as required by rule 215(b), is set to expire on _____."

If a motion to substitute another commonly owned application by a different inventor is granted, the decision should include a paragraph setting a time for the substituted party to file a preliminary statement in the following form:

"The party _____ to be substituted for the party _____ must file on or before _____, a preliminary statement as required by rules 215 *et seq.* in a sealed envelope bearing his name and the number and title of the interference."

The decision should close with a warning statement such as the following:

"No reconsideration (rule 231(d) last sentence)."

The spaces provided in the above paragraphs for the dates for copying allowed proposed counts and for filing and serving preliminary statements should be left blank. The appropriate dates will be inserted in the blank spaces by the Service Branch of the Board of Patent Interferences before the decision is mailed.

Where there has been consultation with a member of the Board of Patent Interferences as required by § 1105.01, the word "APPROVED" and spaced below this the Board member's name who was consulted should be typed at the lower left hand corner of the last page. The Board member will sign in the space below "APPROVED." If less than all of the motions decided required consultation, under § 1105.01, the word "APPROVED" should be followed by an indication of matters requiring such approval. For example,

"Approved as to the motion to shift the burden of proof."

After the decision is signed by the primary examiner and the proper clerical entry made, the complete interference file is forwarded to the Service Branch of the Board of Patent Interferences for dating and mailing or for the Board member's signature if there has been a consultation.

The motion decision is entered in the index of the interference file; it should include the following information and be set forth in this order:

Date_____ "Dec. of Pr. Exr." _____Granted.

If some of the motions have been granted and others denied, the last entry will be "Granted and Denied", and of course, if all the motions have been denied, the last entry will be "Denied." If a date for copying allowed proposed counts and for filing preliminary statements has been set, this should also be indicated at the end of the line by

"Amendment and Statement due_____."

Below are examples of entries which should be made in the interference brief in the section entitled "Decisions on Motion" (Form PO–222) in each case involved in the interference:

Dissolved
Dissolved as to counts 2 and 3
Dissolved as to Smith
Counts 4 and 5 admitted

These entries should be verified by the primary examiner.

Determination of the next action to be taken is made by the Service Branch of the Board. Examples of such action may be redeclaration, entry of judgment, or setting of time for taking testimony and for filing briefs for final hearing. [R–31]

1105.07 Petition for Reconsideration of Decision [R–23]

Petitions or requests for reconsideration of a decision on motions under rule 231 or 237 will not be given consideration. Rule 231(d) second sentence. An exception is the case where under rule 237 the primary examiner for the first time takes notice of a ground for dissolution while the interference is before him for consideration of motions by the parties and incorporates this matter in his decision so that the parties have had no opportunity to present arguments thereon. In this case the examiner's decision should include a statement to the effect that reconsideration may be requested within the time specified in rule 244(c). See § 1105.05.

1106 Redeclaration of Interferences and Additional Interferences [R–23]

Redeclaration of interferences where necessitated by a decision on motions under rule 231 will be done by a patent interference examiner, the papers being prepared by the Interference Service Branch. The decision signed by the primary examiner will constitute the authorization. The same practice will apply to the declaration of any new interference which may result from a decision on motions.

1106.01 After Decision on Motion

Various procedures are necessary after decision on a motion. The following general rules may be stated:

(1) If the total result of the motion decision consists solely in the elimination of counts, the elimination of parties or a shifting of the burden of proof, no redeclaration is necessary. The motion decision itself constitutes the paper deleting counts or parties and is likewise adequate notice of the shifting of the burden of proof.

(2) If the motion decision results in any addition or substitution of parties or applications or the addition or substitution of counts, then redeclaration is necessary. If redeclaration is necessary, the information falling within category (1) is also included in the redeclaration papers. The old counts should retain their old numbers for ease of identification.

(3) Since all of the necessary information concerning an application to be added or substituted should appear in the motion decision or on the face of the application file no separate communication from the primary examiner to the patent interference examiner is necessary or desired.

The patent interference examiner will determine whether or not the nonmoving parties have copied the proposed counts which have been admitted within the time allowed and if they have, he will proceed with the redeclaration. If a party fails so to copy a proposed count and thus will not be included in inter-

ference as to such count the application will be returned to the primary examiner by the patent interference examiner with a memorandum explaining the circumstances, unless the original interference will continue as to one or more counts. In the latter case the application concerned will be retained with the original interference and a new interference will be declared (assuming at least one other nonmoving party asserts the proposed count) on the new count and including only those parties who have asserted it in their applications.

In declaring a new interference as a result of a motion decision the notices to the parties and the declaration sheet will include a statement to the following effect:

"This interference is declared as the result of a decision on motions in Interference No. _____."

In this case also, no times for filing preliminary statements or motions will be set.

1106.02 By Addition of New Party by Examiner [R–23]

Rule 238 *Addition of new party by examiner.* If during the pendency of an interference, another case appears, claiming substantially the subject matter in issue, the primary examiner should notify the Board of Patent Interferences and request addition of such case to the interference. Such addition will be done as a matter of course by a patent interference examiner, if no testimony has been taken. If, however, any testimony may have been taken, the patent interference examiner shall prepare and mail a notice for the proposed new party, disclosing the issue in interference and the names and addresses of the interferants and of their attorneys or agents, and notices for the interferants disclosing the name and address of the said party and his attorney or agent, to each of the parties, setting a time for stating any objections and at his discretion a time of hearing on the question of the admission of the new party. If the patent interference examiner be of the opinion that the new party should be added, he shall prescribe the conditions imposed upon the proceedings, including a suspension if appropriate.

Rule 238 states the procedure to be followed when the examiner finds, or there is filed, other or new applications interfering as to some or as to all of the counts. The procedure when any testimony has been taken differs considerably from the procedure when no testimony has been taken. However, the difference does not involve the primary examiner but rather affects the action taken by the patent interference examiner.

The primary examiner forwards Form PO–850 accompanied by the additional application to the Interference Service Branch, giving the same information regarding the additional application as in connection with an original declaration (§ 1102.01) and also including the number of the interference. If no testimony has been taken, the patent interference examiner will as a matter of course suspend the interference and redeclare it to include the additional party setting such times for the new party or all parties as is consistent with the stage of proceedings at that point. If the additional party is to be added as to only some of the counts, the patent interference examiner will declare a new interference as to those counts and reform the original interference omitting the counts which are included in the new one. In this case the fact that the issue was in another interference should be noted in all letters in the new interference.

1107 Examiner's Entry in Interference File Subsequent to Interference [R–23]

An interference is terminated either by dissolution or by an award of priority to one of the parties. In either case the interference is returned with the entire record to the examiner as soon as the decision or judgment has become final.

After the files have been returned to the examining group the primary examiner is required to make an entry on the index in the interference file on the next vacant line that the decision has been noted, such as by the words "Decision Noted" and initialed by him. The interference file is returned to the Service Branch of the Board of Patent Interferences when the examiner is through with it. There it will be checked to see that such note has been made and initialed before filing away the interference record.

1108 Entry of Amendments Filed in Connection With Motions [R–23]

This section is limited to the disposition of amendments filed in connection with motions in an application involved in interference, after the interference has terminated.

The manner of treating other amendments which are filed in an application during the course of the interference, is discussed in a separate section (§ 1111.05).

Under rule 231(c) an applicant is required to submit with his motion to amend the issue or to substitute an application, as a separate paper, and amendment embodying the proposed claims if the claims are not already in the application concerned. In the case of an appli-

cation involved in the interference, this amendment is not entered at that time but is placed in the application file.

An amendment filed in connection with a motion to add counts to an interference must be accompanied by the claim or claims to be added and with the appropriate fees, if any, which would be due if the amendments were to be entered, it may be that the amendments will never be entered. Only upon the granting of the motion is it necessary for the other party or parties to present the claims, but the fees must be paid whenever presented. Claims which have been submitted in response to a suggestion by the Office for inclusion in an application must be accompanied by the fee due, if any. Money paid in connection with the filing of a proposed amendment will not be refunded by reason of the nonentry of the amendment.

If the motion is granted the amendment is entered at the time decision on the motion is rendered. If the motion is not granted, the amendment, though left in the file, is not entered and is so marked.

If the motion is granted only in part and denied as to another part, only so much of the amendment as is covered in the grant of the motion is entered, the remaining part being indicated and marked "not entered" in pencil. (See rule 266.)

In each instance the applicant is informed of the disposition of the amendment in the first action in the case following the termination of the interference. If the case is otherwise ready for issue, applicant is notified that the application is allowable and the Notice of Allowance will be sent in due course, that prosecution is closed and to what extent the amendment has been entered.

As a corollary to this practice, it follows that where prosecution of the winning application had been closed prior to the declaration of the interference, as by being in condition for issue, that application may not be reopened to further prosecution following the interference, even though additional claims had been presented under rule 231(a)(2). The interference proceeding was not such an Office action as relieved the case from its condition as the doctrine of Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

It should be noted at this point that, under the provisions of rule 262(d), the termination of an interference on the basis of a disclaimer, concession of priority, abandonment of the invention, or abandonment of the contest filed by an applicant operates without further action as a direction to cancel the claims involved from the application of the party making the same.

1109 Action After Award of Priority [R–40]

Under 35 U.S.C. 135, the Commissioner may at once issue a patent to the applicant who is adjudged by the Board of Patent Interferences to be the prior inventor, without waiting for appeal by any loser. However, in ordinary cases it is the policy of the Office not to issue a patent to the winning party during the period within which appeal may be taken to the Court of Customs and Patent Appeals, or during the pendency of such appeal. Therefore, the files are not returned to the examining group until after the termination of the appeal period, or the termination of the appeal, as the case may be. Jurisdiction of the examiner is automatically restored with the return of the files, and the cases of all parties are subject to such ex parte action as their respective conditions may require, even though, where no appeal to the Court of Customs and Patent Appeals was filed, the losing party to the interference may file a suit under 35 U.S.C. 146. In a case where a patentee is the losing party, and the Office is notified that a civil action under 35 U.S.C. 146 has been initiated, the files will not be returned to the examining group until after that action has been terminated. The date when the priority decision becomes final does not mark the beginning of a statutory period for response by the applicant. See Ex parte Peterson, 1941 C.D. 8, 525 O.G. 3.

If an application had been withdrawn from issue for interference and is again passed to issue, a notation "Re-examined and passed for issue" is placed on the file wrapper together with a new signature of the primary examiner in the box provided for this purpose. Such a notation will be relied upon by the Patent Issue Division as showing that the application is intended to be passed for issue and make it possible to screen out those applications which are mistakenly forwarded to the Patent Issue Division during the pendency of the interference.

See § 1302.12 with respect to listing references discussed in motion decisions.

1109.01 The Winning Party [R–25]

The winning party may be sent to issue despite the filing of a suit under 35 U.S.C. 146 by his opponent in an interference solely involving pending applications. Monaco v. Watson, 106 U.S. App. D.C. 142; 270 F. 2d 335; 122 USPQ 564. In an interference involving a patent where the winning party is an applicant, the Office will not send the application to issue while a suit is pending under 35 U.S.C. 146. Monsanto v. Kamp et al., 146 USPQ 431.

In the case of the winning party, if his application was not in allowable condition when the interference was formed and has since been amended, or if it contains an unanswered amendment, or if the rejection standing against the claims at the time the interference was formed was overcome by reason of the award of priority, as an interference involving the application and a patent which formed the basis of the rejection, the examiner forthwith takes the application up for action.

If, however, the application of the winning party contains an unanswered Office action, the examiner at once notifies the applicant of this fact and requires response to the Office action within a shortened period of two months running from the date of such notice. See Ex parte Peterson, 1941 C.D. 8; 525 O.G. 3. This procedure is not to be construed as requiring the reopening of the case if the Office action had closed the prosecution before the examiner.

The following language is suggested for notifying the winning party that his application contains an unanswered Office action:

> [1] "Interference No. _____ has been terminated by a decision favorable to applicant. Ex parte prosecution is resumed.
>
> However, this application contains an unanswered Office action.
>
> A SHORTENED STATUTORY PERIOD FOR RESPONSE TO SUCH ACTION IS SET TO EXPIRE TWO MONTHS FROM THE DATE OF THIS LETTER."

The winning party, if the prosecution of his case had not been closed, generally may be allowed additional and broader claims to the common patentable subject matter. (Note, however, In re Hoover Co., Etc., 1943 C.D. 338; 57 USPQ 111; 30 CCPA 927.) The winning party of the interference is not denied anything he was in possession of prior to the interference, nor has he acquired any additional rights as a result of the interference. His case thus stands as it was prior to the interference. If the application was under final rejection as to some of its claims at the time the interference was formed, the institution of the interference acted to suspend, but not to vacate, the final rejection. After termination of the interference a letter is written the applicant, as in the case of any other action unanswered at the time the interference was instituted, setting a shortened period of two months within which to file an appeal or cancel the finally rejected claims.

1109.02 The Losing Party [R–25]

The application of each of the losing parties following an interference terminated by a judgment of priority is acted on at once. The judgment is examined to determine the basis therefor and action is taken accordingly.

If the judgment is based on a disclaimer, concession of priority, or abandonment of the invention filed by the losing applicant, such disclaimer, concession of priority, or abandonment of the invention operates "without further action as a direction to cancel the claims involved from the application of the party making the same" (rule 262(d)). Abandonment of the contest has a similar result. See § 1110. The interference counts thus disclaimed, conceded, or abandoned are accordingly canceled from the application of the party filing the document which resulted in the adverse judgment.

If the judgment is based on grounds other than those referred to in the preceding paragraph, the claims corresponding to the interference counts in the application of the losing party should be treated in accordance with rule 265, which provides that such claims "stand finally disposed of without further action by the examiner and are not open to further ex parte prosecution." Accordingly, a pencil line should be drawn through the claims as to which a judgment of priority adverse to applicant has been rendered, and the words "Rule 265" should be written in the margin to indicate the reason for the pencil line. If these claims have not been canceled by the applicant and the case is otherwise ready for issue, these notations should be replaced by a line in red ink and the words "Rule 265" in red ink before passing the case to issue, and the applicant notified of the cancellation by an Examiner's Amendment. If an action is necessary in the application after the interference, the applicant should be informed that "Claims (designated by numerals), as to which a judgment of priority adverse to applicant has been rendered, stand finally disposed of in accordance with Rule 265."

If, as the result of one or both of the two preceding paragraphs all the claims in the application are eliminated, a letter should be written informing the applicant that all the claims in his case have been disposed of, indicating the circumstances, that no claims remain subject to prosecution, and that the application will be sent to the abandoned files with the next group of abandoned applications. Proceedings are terminated as of the date appeal or review by civil action was due if no appeal or civil action was filed.

Except where judgment is based solely on ancilliary matters, any remaining claims in each defeated party's case should be reviewed in connection with the winning party's disclosure.

An interference settles not only the rights of the parties under the issues or counts of the interference but also settles every question of the rights to any claim which might have been presented and determined in the interference proceeding. The doctrine of estoppel has been applied where a party has neglected or refused to contest priority of patentable subject matter which is clearly common to his application and the application of his opponent in interference.

Claims which the winning party could not make, for lack of disclosure, cannot be denied to the loser on the ground of interference estoppel, if they distinguish patentably from the counts.

The distinction which should be borne in mind is that, with regard to interference estoppel, the losing party is only estopped to obtain claims which read directly on disclosures of subject matter clearly common to both the winning party's application and that of the losing party; but that, with regard to prior art (including prior invention), the losing party cannot obtain claims to subject matter which is either barred under 35 U.S.C. 102(g), or rendered obvious under 35 U.S.C. 103, by the invention defined in the interference counts. In re Riss et al., 154 USPQ; 54 CCPA 1495.

Where the winning party is an applicant, reference should be made only to the application of _____, the winning party in Interfer-
(Name)
ence _____, but the serial number or the filing
No.
date of the other case should not be included in the Office Action. However, a losing applicant may avoid a rejection based on *unclaimed* disclosure of a winning *patentee*. When notice is received of the filing of a suit under 35 U.S.C. 146, further action is withheld on the application of the party filing the suit. No letter to that effect need be sent.

When the award of priority is based solely upon ancillary matters, as right to make, and is in favor of the junior party, the claims of the senior party, even though the award of priority was to the junior party, are not subject to rejection on the ground of estoppel, through failure to move under rule 231(a)(2) or on the disclosure of the junior party as prior art (rule 257).

If the losing party's case was under rejection at the time the interference was declared, such rejection is ordinarily repeated (either in full or by reference to the previous action) and, in addition, rejections as unpatentable over the

issue, unpatentable over the winning party's disclosure, or any other suitable rejections are made. If it was under final rejection or ready for issue, his right to reopen the prosecution is restricted to subject matter related to the issue of the interference.

Where the losing party failed to get a copy of his opponent's drawing or specification during the interference, he may order a copy thereof to enable him to respond to a rejection based on the successful party's disclosure. Such order is referred to the Patent Interference Examiner who has authority to approve orders of this nature.

Where the rejection is based on the issue of the interference, there is no need for the applicant to have a copy of the winning party's drawing, for the issue can be interpreted in the light of the applicant's own drawing as well as that of the successful party.

It may be added that rejection on estoppel through failure to move under rules 231(a) (2) and (3) may apply where the interference terminates in a judgment of priority as well as where it is ended by dissolution. See § 1110. However, rule 231(a) (3) now limits the doctrine of estoppel to subject matter in the cases involved in the interference. See § 1105.03.

1110 Action After Dissolution [R–25]

After dissolution of an interference any amendments which accompanied motions to dissolve are entered to the extent that the motions were not denied. See § 1108. See § 1302.12 with respect to listing references discussed in motion decisions. If the grounds for dissolution are also applicable to the nonmoving parties, e.g., unpatentability of the subject matter of the interference, the examiner should, on the return of the files to his group, reject in each of the applications of the nonmoving parties the claims corresponding to the counts of the interference on the grounds stated in the decision. It is proper to refer to the "application of _____, an adverse party in (Name) Interference _____," but neither the Serial No. number nor the filing date of such application should be included in the Office action.

If an application was in condition for allowance or appeal prior to the declaration of the interference, the matter of reopening the prosecution after dissolution of the interference should be treated in the same general manner as after an award of priority. (See §§ 1109.01 and 1109.02.) [R–26]

1110.01 Action after Dissolution—By Termination Paper Filed Under Rule 262(b) [R–26]

Dissolution of an interference on the basis of an abandonment of the contest operates as a direction to cancel the involved claims from that party's application (rule 262(d)).

If all the claims in an application are eliminated, see the fourth paragraph of § 1109.02 for the action to be taken.

Rule 262(b) reads in part:

> Upon the filing of such abandonment of the contest or of the application, the interference shall be dissolved as to that party, but such dissolution shall in subsequent proceedings have the same effect with respect to the party filing the same as an adverse award of priority.

Under these circumstances, it should be noted that, pursuant to the last sentence of rule 262(b), supra, the party who abandons the contest or the application *stands on the same footing as the losing party* referred to in § 1109.02.

1110.02 Action After Dissolution Under Rule 231 or 237 [R–38]

If, following the dissolution of the interference under rule 231 or 237, any junior party files claims that might have been included in the issue of the interference such claims should be rejected on the ground of estoppel. The senior of the parties, in accordance with rule 257, is exempted from such rejection. Where it is only the junior parties to the interference that have common subject matter additional to the subject matter of the interference, the senior one of this subgroup is free to claim this common subject matter. Rule 231(a)(3) now limits the doctrine of estoppel to subject matter in the cases involved in the interference. See §§ 1105.03 and 1109.02.

1111 Miscellaneous

1111.01 Interviews [R–16]

Where an interference is declared all questions involved therein are to be determined *inter partes*. This includes not only the question of priority of invention but all questions relative to the right of each of the parties to make the claims in issue or any claim suggested to be added to the issue and the question of the patentability of the claims.

Examiners are admonished that *inter partes* questions should not be discussed *ex parte* with any of the interested parties and that they should so inform applicants or their attorneys if any attempt is made to discuss *ex parte* these *inter partes* questions.

1111.02 Record in Each Interference Complete [R–16]

When there are two or more interferences pending in this Office relating to the same subject matter, or in which substantially the same applicants or patentees are parties thereto, in order that the record of the proceedings in each particular interference may be kept separate and distinct, all motions and papers sought to be filed therein must be titled in and relate only to the particular interference to which they belong, and no motion or paper can be filed in any interference which relates to or in which is joined another interference or matter affecting another interference.

The examiners are also directed to file in each interference a distinct and separate copy of their actions, so that it will not be necessary to examine the records of several interferences to ascertain the status of a particular case.

This will not, however, apply to the testimony. All papers filed in violation of this practice will be returned to the parties filing them.

1111.03 Overlapping Applications [R–26]

Where one of several applications of the same inventor or assignee which contain overlapping claims gets into an interference, the prosecution of all the cases not in the interference should be carried as far as possible, by treating as prior art the counts of the interference and by insisting on proper lines of division or distinction between the applications. In some instances suspension of action by the Office cannot be avoided. See § 709.01.

Where an application involved in interference includes, in addition to the subject matter of the interference, a separate and divisible invention, prosecution of the second invention may be had during the pendency of the interference by filing a divisional application for the second invention or by filing a divisional application for the subject matter of the interference and moving to substitute the latter divisional application for the application orig-

inally involved in the interference. However, the application for the second invention may not be passed to issue if it contains claims broad enough to dominate matter claimed in the application involved in the interference.

1111.04 "Secrecy Order" Cases [R–38]

Rule 5.3. Prosecution of application under secrecy order; withholding patent.

(b) An interference will not be declared involving applications under secrecy order. However, if an application under secrecy order copies claims from an issued patent, a notice of that fact will be placed in the file wrapper of the patent.

Since declaration of an interference gives immediate access to applications by opposing parties, no interference will be declared involving an application which has a security status therein (See §§ 107 and 107.02). Claims will be suggested so that all parties will be claiming substantially identical subject matter. When all applications contain the claims suggested, the following letter will be sent to all parties:

"Claims 1, 2, etc., (indicating the conflicting claims and claims not patentable over the application under security status) conflict with those of another application. However, the security status (of the other application) or (of your application) does not permit the declaration of an interference. Accordingly, action on the applications is suspended for so long as this situation continues.

"Upon removal of the security status from all applications, an interference will be declared."

The letter should also indicate the allowability of the remaining claims if any.

1111.05 Amendments Filed During Interference [R–26]

The disposition of amendments filed in connection with motions in applications involved in an interference, after the interference has been terminated, is treated in § 1108. If the amendment is filed pursuant to a letter by the primary examiner, after having gotten jurisdiction of the involved application for the purpose of suggesting a claim or claims for interference with another party and for the purpose of declaring an additional interference, the examiner enters the amendment and takes the proper steps to initiate the second interference.

Other Amendments

When an amendment to an application involved in an interference is received, the examiner inspects the amendment and, if necessary, the application, to determine whether or not the amendment affects the pending or any prospective interference. If the amendment is an ordinary one properly responsive to the last regular *ex parte* action preceding the declaration of the interference and does not affect the pending or any prospective interference, the amendment is marked in pencil "not entered" and placed in the file, a corresponding entry being endorsed in ink in the contents column of the wrapper and on the serial and docket cards. After the termination of the interference, the amendment may be permanently entered and considered as in the case of ordinary amendments filed during the *ex parte* prosecution of the case.

If the amendment is one filed in a case where *ex parte* prosecution of an appeal to the Board of Appeals is being conducted concurrently with an interference proceeding (see § 1103), and if it relates to the appeal, it should be treated like any similar amendment in an ordinary appealed case.

When an amendment filed during interference purports to put the application in condition for another interference either with a pending application or with a patent, the primary examiner must personally consider the amendment sufficiently to determine whether, in fact, it does so.

If the amendment presents allowable claims directed to an invention claimed in a patent or in another pending application in issue or ready for issue, the examiner borrows the file, enters the amendment and takes the proper steps to initiate the second interference.

Where in the opinion of the examiner, the proposed amendment does not put the application in condition for interference with another application not involved in the interference the amendment is placed in the file and marked "not entered" and the applicant is informed why it will not be now entered and acted upon. See form at § 1112.10. Where the amendment copies claims of a patent not involved in the interference and which the examiner believes are not patentable to the applicant, and where the application is open to further *ex parte* prosecution, the file should be obtained, the amendment entered and the claims rejected, setting a time limit for response. If reconsideration is requested and rejection made final a time limit for appeal should be set. Where the application at the time of forming the interference was closed to further *ex parte* prosecution and the disclosure of the application will, *prima facie*, not support the copied patent claims or where copied patent claims are drawn to a non-elected invention, the amendment will not be

entered and the applicant will be so informed, giving very briefly the reason for the nonentry of the amendment. See letter form in § 1112.10.

1111.06 Notice of Rule 231(a)(3) Motion Relating to Application Not Involved in Interference [R–26]

Whenever a party in interference brings a motion under rule 231(a)(3) affecting an application not already included in the interference, the Examiner of Interferences should at once send the primary examiner a written notice of such motion and the primary examiner should place this notice in said application file.

The notice is customarily sent to the group which declared the interference since the application referred to in the motion is generally examined in the same group. However, if the application is not being examined in the same group, then the correct group should be ascertained and the notice forwarded to that Group.

This notice serves several useful and essential purposes, and due attention must be given to it when it is received. First, the examiner is cautioned by this notice not to consider *ex parte*, questions which are pending before the Office in *inter partes* proceedings involving the same applicant or party in interest. Second, if the application which is the subject of the motion is in issue and the last date for paying the issue fee will not permit determination of the motion, it will be necessary to withdraw the application from issue. See form in § 1112.04. Third, if the application contains an affidavit or declaration under rule 131, this must be sealed because the opposing parties have access to the application.

1111.07 Conversion of Application From Joint to Sole or Sole to Joint [R–26]

Although, for simplicity, the subject of this section is titled "Conversion of Application from Joint to Sole or Sole to Joint," it includes all cases where an application is converted to decrease or increase the number of applicants. See § 201.03.

If conversion is attempted after declaration of an interference but prior to expiration of the time set for filing motions, the matter is treated as an *inter partes* matter, subject to opposition. That is, the filing of conversion papers during this period whether or not accompanied by a formal motion will be treated as a motion under rule 231(a)(5) and will be transmitted to the primary examiner for decision after expiration of the time within which reply briefs may be filed, along with any other motions which may have been filed. If conversion is permitted, redeclaration will be accomplished as in other cases on the basis of the decision on motions.

If conversion is attempted after the close of the motion period but prior to the taking of any testimony, the Interference Examiner may, at his discretion, either transmit the matter to the primary examiner for determination or defer consideration thereof to final hearing for determination by the Board of Patent Interferences. If transmitted to the primary examiner, the matter is treated as outlined in the preceding paragraph.

If conversion is attempted after the taking of testimony has commenced, the Interference Examiner will generally defer consideration of the matter to final hearing for determination by the Board of Patent Interferences.

In any case where the examiner must decide the question of converting an application he must, of course, determine whether the legal requirements for such conversion have been satisfied, just as in the ordinary *ex parte* treatment of the matter. Also as in *ex parte* situations the examiner should make of record the formal acknowledgment of conversion as required by § 201.03.

A party may occasionally seek to substitute an application with a lesser or greater number of applicants for the application originally involved in the interference. Such substitution is treated in the same manner as the conversion of an involved application as described above.

1111.08 Reissue Application Filed While Patent Is in Interference [R–38]

Care should be taken that a reissue of a patent should not be granted while the patent is involved in an interference without approval of the Commissioner.

If an application for reissue of a patent is filed while the patent is involved in interference, that application must be called to the attention of the Commissioner before any action by the examiner is taken thereon.

Such applications are normally forwarded by the Application Division to the Office of the Solicitor. A letter with titling relative to the interference is placed in the interference file by the Commissioner and copies thereof are placed in the reissue application and mailed to the parties to the interference. This letter gives notice of the filing of the reissue application and generally includes a paragraph of the following nature:

The reissue application will be open to inspection by the opposing party during the in-

terference and may be separately prosecuted during the interference, but will not be passed to issue until the final determination of the interference, except upon the approval of the Commissioner.

Should an application for reissue of a patent which is involved in an interference reach the examiner without having a copy of the letter by the Commissioner attached, it should be promptly forwarded to the Office of the Solicitor with an appropriate memorandum.

1111.09 Suit Under 35 U.S.C. 146 by losing Party [R–38]

35 U.S.C. 146. Civil action in case of interference. Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law.

When a losing party to an interference gives notice in his application that he has filed a civil action under the provisions of 35 U.S.C. 146, relative to the interference, that notice should be called to the attention of the Interference Service Branch in order that a notation thereof can be made on the index of the interference.

When notice is received of the filing of a suit under 35 U.S.C. 146, further action is withheld on the application of the party filing the suit. No letter to that effect need be sent.

1111.10 Benefit of Foreign Filing Date [R–26]

If a request for the benefit of a foreign filing date under 35 U.S.C. 119 is filed while an application is involved in interference, the papers are to be placed in the application file in the same manner as amendments received during interference, and appropriate action taken after the termination of the interference.

A party will be given the benefit of a foreign filing date in the declaration notices only under the circumstances set out in § 1102.01(a). A party having a foreign filing date which is not accorded him in the declaration papers should file a motion to shift the burden of proof or for benefit of that filing date under rule 231(a)(4) and the matter will be considered on an *inter partes* basis.

1111.11 Patentability Reports

The question of Patentability Reports rarely arises in interference proceedings but the proper occasion therefor may occur in deciding motions. If appropriate, Patentability Report practice may be utilized in deciding motions and the procedure should follow as closely as possible the *ex parte* Patentability Report practice.

1111.13 Consultation With Interference Examiner [R–23]

In addition to the consultation required in connection with certain motion decisions in § 1105.01, the examiner should consult with a Patent Interference Examiner or a member of the Board of Patent Interferences in any case of doubt or where the practice appears to be obscure or confused. In view of their specialized experience they may be able to suggest a course of action which will avoid considerable difficulty in the future treatment of the case.

1111.14 Correction of Error in Joining Inventor [R–37]

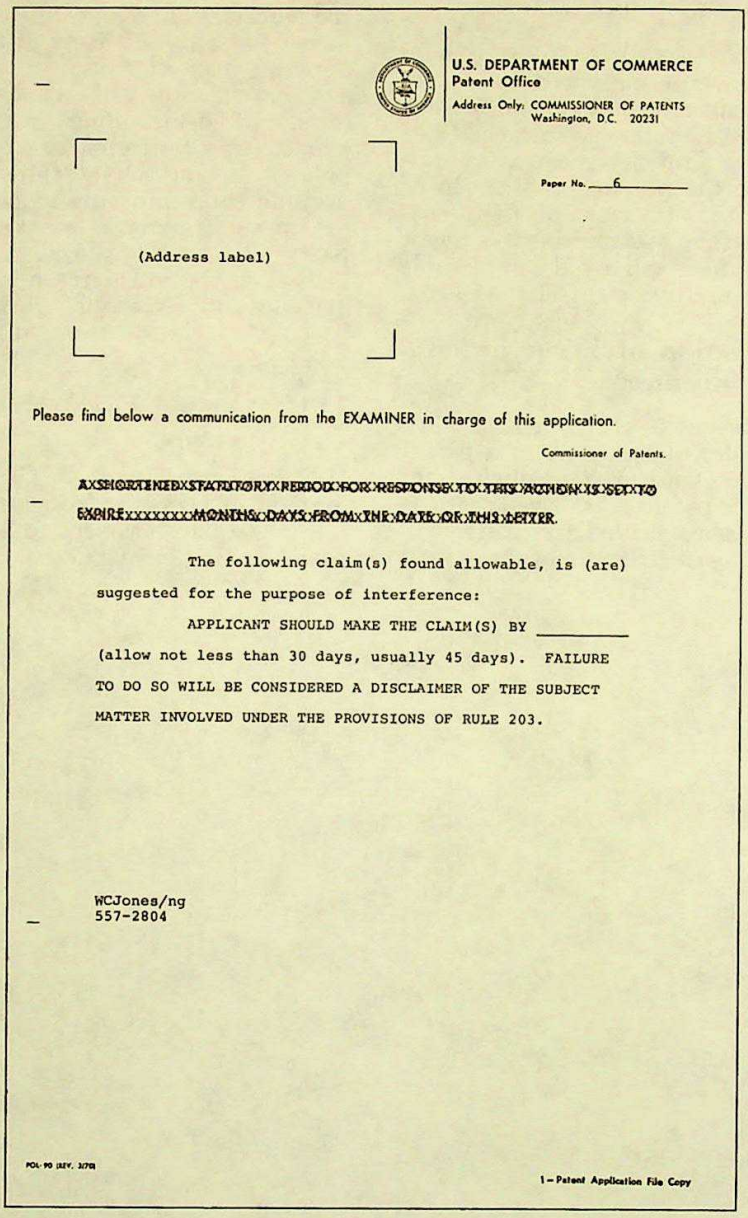
Requests for certificates correcting the misjoinder or nonjoinder of inventors in a patent are referred to the Office of the Solicitor for consideration. If the patent is involved in interference when the request is filed, the matter will be considered *inter partes*. Service of the request on the opposing party will be required and any paper filed by an opposing party addressed to the request will be considered if filed within 20 days of service of a copy of the request on the opposing party. Following this 20 days, the associate solicitor will consider the matter to the extent of determining whether the request *prima facie* conforms to applicable law and policy. During the interference, a copy of any decision concerning the request will be sent to the opposing party as well as to the requesting party. Issuance of the certificate will be withheld until the interference is terminated since evidence adduced in the interference may have a bearing on the question of joinder. See also § 1402.01.

1112 Letter Forms Used in Interferences

Forms are found in Chapter 600 of the Manual of Clerical Procedure which gives details as to the stationery to be used, number of copies, typing format and handling.

509-570 O - 73 - 4

1112.02 Letter Suggesting Claims for Interference [R–37]



U.S. DEPARTMENT OF COMMERCE
Patent Office
Address Only: COMMISSIONER OF PATENTS
Washington, D.C. 20231

Paper No. 6

(Address label)

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

~~A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE xxxxxxxx MONTHS, DAYS FROM THE DATE OF THIS LETTER.~~

The following claim(s) found allowable, is (are) suggested for the purpose of interference:

APPLICANT SHOULD MAKE THE CLAIM(S) BY _____ (allow not less than 30 days, usually 45 days). FAILURE TO DO SO WILL BE CONSIDERED A DISCLAIMER OF THE SUBJECT MATTER INVOLVED UNDER THE PROVISIONS OF RULE 203.

WCJones/ng
557-2804

POL-90 (REV. 3/73)

1 – Patent Application File Copy

1112.03 Same Attorney or Agent in Applications of Conflicting Interests [R–37]

The following sentence is usually added to the letter suggesting claims where the same attorney or agent is of record in applications of different ownership which have conflicting subject matter.

Attention is called to the fact that the attorrney (or agent) in this application is also the attorney (or agent) in an application of another party and of different ownership claiming substantially the same patentable invention as claimed in the above-identified application.

1112.04 Letter Requesting Withdrawal From Issue [R–42]

U.S. DEPARTMENT OF COMMERCE
Patent Office

Address Only: COMMISSIONER OF PATENTS
Washington, D.C. 20231

Date _____

Reply to
Attn of: _____, Primary Examiner

Subject: Withdrawal from Issue: S.N. _____

Filed _____

Sent to Issue _____

To: Mr. _____ Director, Group _____

It is requested that the above-entitled application be withdrawn from issue for the purpose of (Examiner provides necessary reason, or designates one of the phrases a-e below)

The issue fee has (or has not) been paid.

Respectfully,

_____
Examiner

J.Searcher:mdb

a. . . . interference, another party having made claims suggested to him from this application.

b. . . . interference, on the basis of claims _____ copied from Pat. No. _____.

c. . . . interference, applicant having made claims suggested to him.

d. . . . rejecting claims _____ on the implied disclaimer resulting from failure to make the claims suggested to him under rule 203.

e. . . . deciding a motion under rule 231(a) (3) involving this application, the issue fee having been paid, or, the motion cannot be decided prior to the ultimate date for paying the issue fee.

1112.05 Initial Interference Memorandum [R–42]

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE
WASHINGTON

INTERFERENCE – INITIAL MEMORANDUM PAGE NO. 1

EXAMINERS INSTRUCTIONS – Please do not have this form typewritten. Complete the items below by hand (pen and ink) and forward to the Group Clerk with all files including those benefit of which has been accorded. The parties need not be listed in any specific order.

BOARD OF INTERFERENCES: An interference is found to exist between the following cases:

1. LAST NAME OF FIRST LISTED "APPLICANT": SMITH et al (Pat.)

SERIAL NUMBER	FILED (MO., DAY, YEAR)
930,658	JUNE 19, 1965

* Accorded benefit of

SERIAL NUMBER	DATE FILED	DATE PATENTED / OR ABANDONED
816,322	MAY 15, 1965	PENDING

THROUGH INTERVENING APPLICATION SERIAL NO. — DATE FILED — DATE PATENTED ☐ / OR ABANDONED ☐

If applicable, check and/or fill in appropriate paragraphs from M.P.E.P. 1102.01(a)

☐ After termination of this interference, this application will be held subject to further examination under Rule 266.

Claims _____ will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to applicant.

AND APPLICATION SERIAL NO. — DATE FILED — DATE PATENTED ☐ / OR ABANDONED ☐

2. LAST NAME OF FIRST LISTED "APPLICANT": PARKER

SERIAL NUMBER	FILED (MO., DAY, YEAR)
668,512	MARCH 12, 1965

* Accorded benefit of

SERIAL NUMBER	DATE FILED	DATE PATENTED / OR ABANDONED
365,321	JULY 3, 1961	☒ DEC. 8, 1963 / ☐

THROUGH INTERVENING APPLICATION SERIAL NO. 457,123 — DATE FILED NOV. 22, 1963 — DATE PATENTED ☐ / OR ABANDONED ☒ APRIL 13, 1964

If applicable, check and/or fill in appropriate paragraphs from M.P.E.P. 1102.01(a)

☑ After termination of this interference, this application will be held subject to further examination under Rule 266.

Claims 5, 7, 12 will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to applicant.

AND APPLICATION SERIAL NO. 589,762 — DATE FILED APR. 10, 1964 — DATE PATENTED ☐ / OR ABANDONED ☒ 3/15/65

3. LAST NAME OF FIRST LISTED "APPLICANT": GRAY

SERIAL NUMBER	FILED (MO., DAY, YEAR)
765,432	APRIL 1, 1964

* Accorded benefit of UNITED KINGDOM

SERIAL NUMBER	DATE FILED	DATE PATENTED / OR ABANDONED
11,222/63	MAY 15, 1963	☐ / ☐

THROUGH INTERVENING APPLICATION SERIAL NO. — DATE FILED — DATE PATENTED ☐ / OR ABANDONED ☐

If applicable, check and/or fill in appropriate paragraphs from M.P.E.P. 1102.01(a)

☑ After termination of this interference, this application will be held subject to further examination under Rule 266.

Claims _____ will be held subject to rejection as unpatentable over the issue in the event of an award of priority adverse to applicant.

AND APPLICATION SERIAL NO. — DATE FILED — DATE PATENTED ☐ / OR ABANDONED ☐

THE RELATION OF THE COUNTS TO THE CLAIMS OF THE RESPECTIVE PARTIES (INDICATE THOSE MODIFIED)

COUNTS	NAME OF PARTY SMITH et al	NAME OF PARTY PARKER	NAME OF PARTY GRAY	NAME OF PARTY
1	8(m)	4	5	
2	1	9	6	
3	4	3(s)	7	
4	5(p)	6(p)	8(p)	
5				
6				

Have modified counts not appearing in any application typed on a separate sheet and attach to this form.

* The serial number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest application if there are intervening applications necessary for continuity.

GROUP	DATE	SIGNATURE OF PRIMARY EXAMINER
330	JUNE 18, 1969	Andrew Jones

Clerk's Instructions:

1. Obtain a title report for all cases and include a copy.
2. Return transmittal slip PO–261 or PO–262 to the Board of Appeals.
3. Forward all files including those benefit of which is being accorded.

FORM PO–850
Revised 1/71

USCOMM–DC 50674 P–71

1112.08 Primary Examiner Initiating Dissolution of Interference, Rule 237(a) [R–35]

This form is to be used in all cases except when the interference is before the primary examiner for determination of a motion. Sufficient copies of this form should be prepared and sent to the Patent Interference Examiner so that he may send a copy to each party.

PATENTEE INVOLVED

If one of the parties is a patentee, no reference should be made to the *patent* claims nor to the fact that such claims correspond to the counts. See § 1101.02(f), last paragraph. However, this restriction does not apply to claims of the application. Language such as the following is suggested: "Applicant's claims—are considered fully met by (or unpatentable over) the—reference."

U.S. DEPARTMENT OF COMMERCE
Patent Office

Address Only: COMMISSIONER OF PATENTS
Washington, D.C. 20231

In re Interference No. 98,000

John Willard
v.
Luther Stone

Under the provisions of Rule 237, your attention is called to the following patents:

197,520	Jolien	1-1897	214-26
1,637,468	Moran	4-1950	214-26

Counts 1 and 2 are considered unpatentable over either of these references for the following reasons:

(The Examiner discusses the references.)

MMWard:pcf

Copies to:

John Jones
133 Fifth Avenue
New York, New York 11346

Leonard Smith
460 Munsey Building
Washington, D. C. 20641

1112.10 Letter Denying Entry of Amendment Seeking Further Interference [R–35]

(With application or patent not involved in present interference)

U.S. DEPARTMENT OF COMMERCE
Patent Office
Address Only: COMMISSIONER OF PATENTS
Washington, D.C. 20231

Z. Green A.U. 123

Serial No. 521,316 7/1/65

Paper No. 4

Richard A. Green

PIPE CONNECTOR

Charles A. Donnelly
123 Main Street
Dayton, Ohio 65497

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents.

~~A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE XXXXXXXX MONTHS/DAYS FROM THE DATE OF THIS LETTER~~

The amendment filed _____ has not now been entered since it does not place the case in condition for another interference.

(Follow with appropriate paragraph, e.g., (a) or (b) below:)

(a) Applicant has no right to make claims _____ because (state reason briefly). (Use where applicant cannot make claims for interference with another application or where applicant clearly cannot make claims of a patent.)

(b) Claims _____ are directed to a species which is not presently allowable in this case.

Z. Green:ns
(703) 557-2802

POL-90 (REV. 3/70)

1 – Patent Application File Copy

Chapter 1200 Appeal

1201 Introduction

1202 Channels of Ex Parte Review

1203 Composition of Board

1204 Administrative Handling

1205 Notice of Appeal

1206 Appeal Brief

1207 Amendment Filed With or After Appeal

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1208.01 New Reference, New Objection or New Ground of Rejection in Examiner's Answer

1208.02 Withdrawal of Final Rejection

1209 Oral Hearing

1210 Actions Subsequent to Examiner's Answer But Before Board's Decision

1211 Remand by the Board to Consider Amendment

1212 Remand by the Board to Consider Affidavits or Declarations

1213 Decision by Board

1213.01 Recommendations of Board

1214 Actions following Decision by Board

1214.01 New Ground of Rejection

1214.02 Procedure after Decision

1214.03 Rehearing and Reconsideration

1214.04 Examiner Reversed

1214.05 Cancellation of Withdrawn Claims

1214.06 Examiner Sustained in Whole or in Part

1214.07 Reopening of Prosecution

1215 Withdrawal or Dismissal of Appeal

1215.01 Withdrawal of Appeal

1215.02 Claims Standing Allowed

1215.03 Partial Withdrawal

1215.04 Dismissal of Appeal

1215.05 Case Before the Court

1216 Appeals to Courts

1216.01 To Court of Customs and Patent Appeals

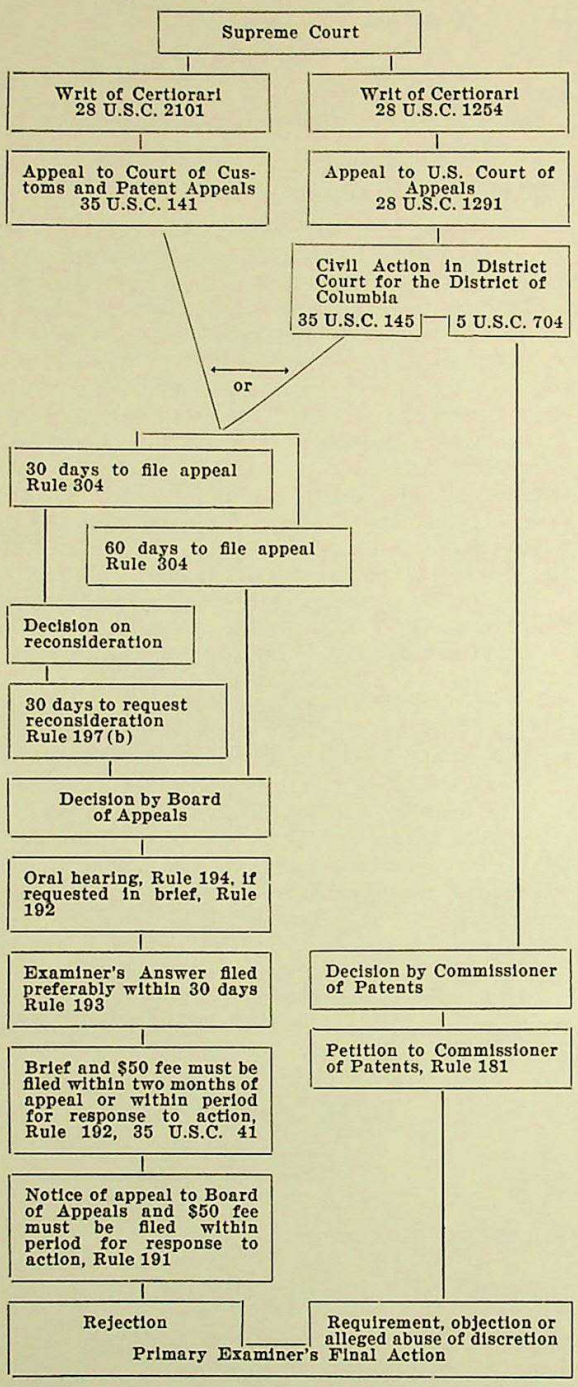
1216.02 Civil Suits

1201 Introduction [R–43]

The Patent and Trademark Office in administering the Patent Laws makes many decisions of a discretionary nature which the applicant may feel deny him the patent protection to which he is entitled. The differences of opinion on such matters can be justly resolved only by prescribing and following judicial procedures. Where the differences of opinion concern the denial of patent claims because of prior art or material deficiencies in the disclosure set forth in the application, the questions thereby raised are said to relate to merits, and appeal procedure within the Patent and Trademark Office and to the courts has long been provided by statute.

The line of demarcation between appealable matters for the Board of Appeals and petitionable matters for the Commissioner of Patents and Trademarks should be carefully observed. The Board will not ordinarily hear a question which it believes should be decided by the Commissioner, and the Commissioner will not ordinarily entertain a petition where the question presented is an appealable matter. However, since rule 181(f) states that any petition not filed within two months from the action complained of may be dismissed as untimely and since rule 144 states that petitions from restriction requirements must be filed no later than appeal, petitionable matters will rarely be present in a case by the time it is before the Board for a decision. Note in re Hengehold, 169 USPQ 473, (CCPA 1971).

1202 Channels of Ex Parte Review [R–23]



1203 Composition of Board [R–43]

35 U.S.C. 7, provides for a Board of Appeals as follows:

35 U.S.C. 7 Board of Appeals. The examiners-in-chief shall be persons of competent legal knowledge and scientific ability, who shall be appointed under the classified civil service. The Commissioner, the deputy commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

Whenever the Commissioner considers it necessary to maintain the work of the Board of Appeals current, he may designate any patent examiner of the primary examiner grade or higher, having the requisite ability, to serve as examiner-in-chief for periods not exceeding six months each. An examiner so designated shall be qualified to act as a member of the Board of Appeals. Not more than one such primary examiner shall be a member of the Board of Appeals hearing an appeal. The Secretary of Commerce is authorized to fix the per annum rate of basic compensation of each designated examiner-in-chief in the Patent and Trademark Office at not in excess of the maximum scheduled rate provided for positions in grade 16 of the General Schedule of the Classification Act of 1949, as amended. The per annum rate of basic compensation of each designated examiner-in-chief shall be adjusted, at the close of the period for which he was designated to act as examiner-in-chief, to the per annum rate of basic compensation which he would have been receiving at the close of such period if such designation had not been made.

If subsequent to the hearing, but prior to the decision, a Board member who heard the case becomes unable to participate in the decision for some reason, the applicant will be given the choice of having a rehearing or of having a different Board member substituted for the one who is incapacitated.

Should a member die or otherwise become unavailable (for example, retirement) to reconsider a decision, it is the Board's practice to have the remaining two Board members reconsider the case. However, if there is disagreement concerning the position of the Board on reconsideration, a third member may be designated as a substitute for the absent member.

1204 Administrative Handling [R–41]

Ex parte appeals to the Board of Appeals, and all papers relating thereto, are forwarded to the examining group for docketing. All appeal papers, such as the notice of appeal, appeal brief and request for extension of time to file the brief are processed by the appropriate examining group.

The application file and jurisdiction of the application are normally transferred from the

examining groups to the Board of Appeals at one of the following times:

1) After 2 months from the examiner's answer, plus mail room time, if a "new ground of rejection" has been indicated in the examiner's Answer and no reply brief has been timely filed.
2) After 20 days from the examiner's answer, plus mail room time, where no new ground of rejection has been indicated in the examiner's Answer and no reply brief has been timely filed.
3) After a supplemental examiner's answer has been mailed in reply to a timely reply brief.
4) After the examiner has determined that he will not prepare a supplemental examiner's answer in response to a timely reply brief.

The jurisdiction of an application may be returned to the examining group to consider various matters.

The clerk in charge of handling appeals in the examining group is solely responsible for completion of all phases of appeal clerical procedure. All communications from the Board and all signed Office communications relating to appeals from the primary examiners should be given to the group appeals clerk.

To insure that all records are current, memorandum form PO–262 is attached to the file wrapper when it is remanded by the Board of Appeals. It is important that this memorandum be promptly completed and forwarded by the group if the application is allowed, the prosecution is reopened, a continuation application is filed or if the appeal is discontinued for any other reason.

Complete clerical instructions appear in Chapter 700 of the Manual of Clerical Procedure.

If the brief is not filed within the time designated by rule 192, the clerk will notify the applicant that the appeal stands dismissed.

"Special" Case

Subject alone to diligent prosecution by the applicant, an application for patent that once has been made special and advanced out of turn by the Commissioner or an Assistant Commissioner for examination will continue to be special throughout its entire course of prosecution in the Patent Office, including appeal, if any, to the Board of Appeals.

A petition to make a case special after the appeal has been forwarded to the Board of Appeals may be addressed to the Board. However, no such petition will be granted unless the brief has been filed and applicant has made the same type of showing required by the Commissioner under rule 102. Therefore, diligent prosecution is essential to a favorable decision on a petition to make special.

1205 Notice of Appeal [R–32]

35 U.S.C. 134. Appeal to the Board of Appeals. An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal.

Extract from 35 U.S.C. 41, Patent fees. (a) The Commissioner shall charge the following fees: 6. On appeal for the first time from the examiner to the Board of Appeals, $50; in addition, on filing a brief in support of the appeal, $50.

Rule 191. Appeal to Board of Appeals. (a) Every applicant for a patent or for reissue of a patent, any of the claims of which have been twice rejected, or who has been given a final rejection (rule 113), may, upon the payment of the fee required by law, appeal from the decision of the primary examiner to the Board of Appeals within the time allowed for response.

(b) The appeal must identify the rejected claim or claims appealed, and must be signed by the applicant or his duly authorized attorney or agent. (See form 41)

(c) Except as otherwise provided by rule 206, appeal when taken must be taken from the rejection of all claims under rejection which applicant proposes to contest. Questions relating to matters not affecting the merits of the invention may be required to be settled before an appeal can be considered.

An applicant dissatisfied with the primary examiner's decision in the second or final rejection of his claims may appeal to the Board of Appeals for review of the examiner's rejection by filing a notice of appeal, signed by the applicant or his attorney, and the required fee of $50.

The notice of appeal must be filed within the period for response set in the last Office action, which is normally three months. The timely filing of a first response to a final rejection having a shortened statutory period for response is construed as including a request to extend the period for response an additional month, even if an extension has been previously granted, as long as the period for response does not exceed six months from the date of the final rejection. The additional month may be used to place the application in condition for allowance, to appeal or to file a continuing application. See § 714.13. Failure to place an application in condition for allowance or to file an appeal after final rejection will result in the application becoming abandoned, even if one or more claims have been allowed except where claims suggested for interference have been copied.

The use of form 41 for filing a notice of appeal is strongly recommended. This form is reproduced below. Copies for duplication may

be obtained from the receptionist in the lobby of Building 3 in the Patent Office.

Revised Form 41

NOTICE OF APPEAL FROM THE PRIMARY EXAMINER TO THE BOARD OF APPEALS

In re application of:
Serial No.:
For:
Filed:
Group Art Unit:
To Commissioner of Patents
Sir:

Applicant hereby appeals to the Board of Appeals from the decision dated _____ of the Primary Examiner finally rejecting claims _____ _____.

The item(s) checked below are appropriate:

1. ☐ An extension of time to respond to the final rejection was granted on _____ for _____ months(s).
2. ☐ A timely response to the final rejection has been filed, as provided in 841 O.G. 1411.
3. ☐ Fee $50.00:
   - ☐ Enclosed
   - ☐ Not required (Fee paid in prior appeal.)
   - ☐ Charge to Deposit Account No. _____. (One additional copy of this Notice is enclosed herewith.)

_____
Signature (Rule 191(b)).

_____
_____
_____
Post Office Address (to which correspondence is to be sent).

MATTERS HANDLED CONCURRENTLY WITH APPEAL

Rule 206 permits partial appeal in cases where there are both finally rejected claims copied from a patent and other claims not ready for appeal. See §§ 1210 and 1101.02(f).

Ex parte prosecution of an appeal under rule 191 may proceed concurrently with an interference proceeding involving the same application provided the primary examiner who forwards the appeal certifies, in a memorandum to be placed in the file, that the subject matter of the interference does not conflict with the subject matter of the appealed claims. See rule 212, § 1103.

The Patent Office does not acknowledge receipt of a Notice of Appeal by separate letter. However, if a self-addressed Post Card is included with the Notice of Appeal, it will be date stamped and mailed.

1206 Appeal Brief [R–41]

Rule 192. Appellant's brief. (a) The appellant shall, within two months from the date of the appeal, or within the time allowed for response to the action appealed from, if such time is later, file a brief in triplicate, accompanied by the requisite fee, of the authorities and arguments on which he will rely to maintain his appeal, including a concise explanation of the invention which should refer to the drawing by reference characters, and a copy of the claims involved, at the same time indicating if he desires an oral hearing. Upon a showing of sufficient cause, the Commissioner may grant extensions of time for filing the brief. The Commissioner may delegate to appropriate Patent Office officials the approval of such extensions. All requests for extensions must be filed prior to the expiration of the period sought to be extended.

(b) On failure to file the brief, accompanied by the requisite fee, within the time allowed, the appeal shall stand dismissed.

Where the brief is not filed, but within the period allowed for filing the brief an amendment is presented which places the case in condition for allowance, the amendment may be entered since the application retains its pending status during said period. Amendments should not be included in the appeal briefs. Amendments should be filed as separate papers. See §§ 1207, 1215.01 and 1215.02.

The copy of the claims required in the brief should be a clean copy and should not include any brackets or underlining as required by rule 121(b).

TIME FOR FILING APPEAL BRIEF

The usual period of time in which applicant must file his brief is two months from the date of the appeal. However, rule 192 alternatively permits the brief to be filed 'within the time allowed for response to the action appealed from, if such time is later".

In the event that applicant finds that he is unable to file a brief within the time allotted by the rules, he may file a petition, without any fee, to the examining group, requesting additional time (usually one month), and giving his reasons for the request. The petition should be filed in duplicate and contain the address to which the response is to be sent. If sufficient cause is shown and the petition is filed prior to the expiration of the period sought to be extended (rule 192), the group appeals clerk is authorized to grant the extension not in excess of one month. The group directors have authority to grant subsequent extensions. Additional time, in excess of two months, will not be granted, unless extraordinary circumstance are involved. The time extended is added to the last calendar day of the original period, as opposed to being added to the day it would have been due when said last day is a Saturday, Sunday or holiday.

If after an appeal has been filed, but prior to the date for submitting a brief, an interference

is declared, applicant's brief need not be filed until two months after either the non-appealable decision of the Patent Interference Examiner or the expiration of the time for appealing from the Patent Interference Examiner's appealable decision, the decision of the Board of Patent Interferences or from any subsequent decision of a reviewing court. If a petition for reconsideration is filed, there is a 30 day appeal limit following the decision on petition. In the event that a seasonable petition to the Commissioner is filed with respect to the Patent Interference Examiner's decision, a 30 day period begins with the mailing of the decision on the petition. See §§ 1109.01 and 1109.02.

Likewise, when an application is revived after abandonment for failure on the part of the applicant to make appropriate action after final rejection, and the petition to revive was accompanied by a Notice of Appeal, applicant has two months, from the mailing date of the Commissioner's affirmative decision on the petition, in which to file his brief.

With the exception of the institution of an interference or the suggestion and timely copying of claims for an interference, the appeal ordinarily will be dismissed if the brief is not filed within the period provided by rule 192(a) or within such additional time as may be properly granted.

Attention is directed to the fact that a brief must be filed to preserve applicant's right to the appealed claims, notwithstanding circumstances such as:

(1) the possibility or imminence of an interference involving the subject application, but not resulting in withdrawal of the final rejection prior to the brief's due date;

(2) the filing of a petition for supervisory action under rule 181;

(3) the filing of an amendment, even if it is one which the examiner previously has indicated may place one or more claims in condition for allowance, unless the examiner, in acting on the amendment, disposes of all issues on appeal;

(4) the receipt of a letter from the examiner stating that prosecution is suspended, without the examiner either withdrawing the final rejection from which appeal has been taken, instituting an interference with the subject application or suggesting claims for an interference.

Although failure to file the brief within the permissible time will result in dismissal of the appeal, if any claims stand allowed, the application does not become abandoned by the dismissal, but is returned to the examiner for his action on the allowed claims. See § 1215.04. If there are no allowed claims, the case is abandoned as of the date the brief was due.

If the time for filing a brief has passed and the application has consequently become abandoned, the applicant may petition to revive the application, as in other cases of abandonment, and to reinstate the appeal; if the appeal is dismissed, but the application is not abandoned, the petition would be to reinstate the claims and the appeal, but a showing equivalent to that in a petition to revive under rule 137 is required. See § 1215.04. However, the $15 fee for reviving an application is not required in the latter case. In either event, a proper brief must be filed before the petition will be considered on its merits.

Where the dismissal of the appeal is believed to be a mistake resulting from inadvertence, filing a petition, pointing out the error, may be sufficient.

Appeal Brief

A $50 fee is required when the brief is filed for the first time in an application, 35 U.S.C. 41. Rule 192 provides that the applicant shall file a brief of the authorities and arguments on which he will rely to maintain his appeal, including a concise explanation of the invention which should refer to the drawing by reference characters, and a copy of the claims involved, at the same time indicating if he desires an oral hearing. Rule 192(a) requires the submission of three copies of the appeal brief.

For sake of convenience, the copy of the claims involved should be double spaced.

The brief, as well as every other paper relating to an appeal, should indicate the number of the examining group to which the application is assigned and the serial number. When the brief is received, it is forwarded to the group where it is entered in the file, and referred to the examiner.

Applicants are reminded that their briefs in appealed cases must be responsive to every ground of rejection stated by the examiner, including new grounds stated in his answer.

Where an applicant fails to respond by way of brief or reply brief to any ground of rejection, and it appears that the failure is inadvertent, applicant shall be notified by the examiner that he is allowed one month to correct the defect by filing a supplemental brief. Where this procedure has not been followed, the Board of Appeals should remand the application to the examiner for compliance. When the record clearly indicates intentional failure to respond by brief to any ground of rejection, for example, by failure to file a supplemental brief within the one-month period allowed for that

purpose, the examiner should inform the Board of Appeals of this fact in his answer and merely specify the claims affected.

Where the failure to respond by brief appears to be intentional, the Board of Appeals may dismiss the appeal as to the claims involved. Oral argument at a hearing will not remedy such deficiency of a brief.

The mere filing of any paper whatever entitled as a brief cannot necessarily be considered a compliance with rule 192. The rule requires that the brief must set forth the authorities and arguments relied upon and to the extent that it fails to do so with respect to any ground of rejection, the appeal as to that ground may be dismissed. It is essential that the Board of Appeals should be provided with a brief fully stating the position of the applicant with respect to each issue involved in the appeal so that no search of the record is required in order to determine that position. The fact that applicant may consider a ground to be clearly improper does not justify a failure to point out to the Board the reasons for that belief.

A distinction must be made between the lack of any argument and the presentation of arguments which carry no conviction. In the former case dismissal is in order, while in the latter case a decision on the merits is made, although it may well be merely an affirmance based on the grounds relied on by the examiner.

Applicant must traverse every ground of rejection set forth in the final rejection. Oral argument at the hearing will not remedy such a deficiency in the brief. Ignoring or acquiescing in any rejection, even one based upon formal matters which could be cured by subsequent amendment, will invite a dismissal of the appeal as to the claims affected. If this involves all of the claims, the proceedings in the case are considered terminated as of the date of the dismissal. Accordingly, any application filed thereafter will not be copending with the application on appeal. If in his brief, applicant relies on some reference, he is expected to provide the Board with at least one copy of it.

Once the brief has been filed, a petition to suspend proceedings may be considered on its merits, but will be granted only in exceptional cases, such as where the writing of the examiner's answer would be fruitless or the proceedings would work a hardship on the applicant.

For reply brief see § 1208.01. [R–42]

1207 Amendment Filed With or After Appeal [R–42]

To expedite the resolution of cases under final rejection, an amendment filed at any time after final rejection but before an appeal brief is filed, may be entered upon or after filing of an appeal provided the total effect of the amendment is to (1) remove issues from appeal, and/or (2) adopt examiner suggestions. Of course, if the amendment necessitates a new search, raises the issue of new matter, presents additional claims without cancelling a corresponding number of finally rejected claims, or otherwise introduces new issues, it will not be entered. Examiners must respond to all non-entered amendments after final rejection, and indicate the status of each claim of record or proposed, including the designation of claims that would be entered on the filing of an appeal if filed in a separate paper. It should be noted that an amendment placing a case in condition for allowance will be enterable by the examiner at any stage prior to forwarding the answer on appeal. Except where an amendment merely cancels claims and/or adopts examiner suggestions, removes issues from appeal, or in some other way requires only a cursory review by the examiner, compliance with the requirement of a showing under rule 116(b) will be expected of all amendments after final rejection.

If after appeal has been taken, a paper is presented which *on its face* clearly places the application in condition for allowance, such paper should be entered and a notice of allowability (POL–327) or an examiner's amendment promptly sent to applicant.

In accordance with the above, the brief must be directed to the claims and to the record of the case as they appeared at the time of the appeal, but it may, of course, withdraw from consideration on appeal any claims or issues as desired by applicant.

A timely filed brief will be referred to the examiner for his consideration of its propriety as to the appeal issues and for preparation of an examiner's answer if the brief is proper and the application is not allowable. The examiner's answer will normally be of the shortened type referring to and relying on the final action; it may withdraw rejection of claims or any objection or requirement as desired by the examiner. Note § 1201. No new ground of rejection or objection should be incorporated in the examiner's answer *without express approval in each case by the group director.* See § 1003, (15) and 1208.01. See § 714.13 for procedure on handling amendments filed after final action and before appeal.

1208 Examiner's Answer [R–42]

Rule 193. Examiner's answer. (a) The primary examiner may, within such time as may be directed by the Commissioner, furnish a written statement in answer to the appellant's brief including such explanation of the invention claimed and of the references and grounds of rejection as may be necessary, supplying a

copy to the appellant. If the primary examiner shall find that the appeal is not regular in form or does not relate to an appealable action, he shall so state and a petition from such decision may be taken to the Commissioner as provided in rule 181.

(b) The appellant may file a reply brief directed only to such new points of argument as may be raised in the examiner's answer, within twenty days from the date of such answer. However, if the examiner's answer states a new ground of rejection appellant may file a reply thereto within two months from the date of such answer; such reply may include any amendment or material appropriate to the new ground.

Appeal Conference

Appealed cases in which the brief has been filed may be reviewed by conference in the group, those participating being (1) a primary examiner, (2) the examiner charged with preparation of the examiner's answer and (3) another examiner, known as the conferee, having sufficient experience to be of assistance in the consideration of the merits of the issues on appeal.

The group director has the discretion as to whether or not appeal conferences are necessary in his group and, if so, in which instances they are to be held.

If a conference is held, the primary examiner responsible for signing the examiner's answer should weigh the arguments of the other examiners but it is his responsibility to make the final decision. During the conference, consideration should be given to the possibility of dropping cumulative art rejections and eliminating technical rejections of doubtful value.

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On the examiner's answer, the third person (conferee) should place his initials below those of the examiner who prepared the answer, thus: ABC (conf.). This does not indicate, necessarily, concurrence with the position taken in the answer.

If the examiner charged with the responsibility of preparing the answer reaches the conclusion that the appeal should not be forwarded and the primary examiner approves, no conference is held.

Before preparing the answer, the examiner should make certain that all amendments approved for entry, including those to the drawing, have in fact been physically entered. The clerk of the Board will return to the group any application in which approved amendments have not been entered.

Answer

The examiner should furnish the applicant with a written statement in answer to the applicant's brief within 2 months after the filing of the brief.

The answer should contain a response to the allegations or arguments in the brief and should call attention to any errors in applicant's copy of the claims. Grounds of rejection not argued in the examiner's answer are usually treated as having been dropped, but may be considered by the Board if it desires to do so. The examiner should treat affidavits, declarations or exhibits in accordance with rule 195, reporting his conclusions only on those admitted. Any affidavits or declarations in the application swearing behind a patent should be clearly identified by the examiner as being considered under either rule 131 or 204. The distinction is important since the Board of Appeals will usually consider holdings on rule 131 affidavits or declarations but not on rule 204 affidavits or declarations.

If the brief fails to respond to any or all grounds of rejection advanced by the examiner, he should follow the indicated procedure for handling such briefs set forth in § 1206. If the failure to respond appears intentional or is not corrected within the period allowed by the notice calling the defect to applicant's attention, the examiner should simply inform the Board of Appeals of this fact in his answer and specify the particular claims affected. Since such lack of response to any ground of rejection will result in dismissal of the appeal as to the claims affected, the claims involved need not be treated further by the examiner in his answer. A dismissal of the appeal will result if all the claims are involved and the Board concurs in the examiner's conclusion.

Because of the practice of the Patent Office in entering amendments after final action under justifiable circumstances for purpose of appeal, many cases coming before the Board of Appeals for consideration contain claims which are not the claims treated in the examiner's final rejection. They are either entirely new claims or amended versions of the finally rejected claims, or both. The new claims or finally rejected claims as amended frequently contain limitations not in the claims treated in the final rejection and the arguments in the applicant's brief are directed to the new claims. Under such circumstances the mere reference in the examiner's answer to the final rejection for a statement of his position would leave the Board, insofar as the new claims are concerned, with an uncrystallized issue and without the benefit of the examiner's view, which complicates the task of rendering a decision.

It also frequently happens that an examiner will state his position in the answer in a manner that represents a shift from the position stated in the final rejection without indicating that the last stated position supersedes the former. Such a situation confuses the issue and likewise poses difficulties for the Board since it is not clear exactly what the examiner's ultimate position is.

In view of the complete and thorough development of the issues at the time of final rejection it is possible to save time in preparing the examiner's answer required by rule 193 by taking the following steps:

A. Examiners may incorporate in the answer their statement of the grounds of rejection merely by reference to the final rejection (or a single other action on which it is based, § 706.07). Only those statements of grounds of rejection as appear in *single* prior action may be incorporated by reference. An examiner's answer should not refer, either directly or indirectly, to more than one prior Office action. Statements of grounds of rejection appearing in actions other than the aforementioned single prior action should be *quoted* in the answer. The page and paragraph of the final action or other single prior action which it is desired to incorporate by reference should be explicitly identified. Of course, if the examiner feels that some further explanation of the rejection is necessary he should include it in the answer but ordinarily he may avoid another recital of the issues and another elaboration of the grounds of rejection. The answer should also include any necessary rebutal of arguments presented in the applicant's brief if the final action does not adequately meet the arguments.

B. If the applicant (1) fails to describe the invention, as required by rule 192, or (2) fails

to describe the reference, the examiner is no longer required to provide these omissions. The examiner should, however, include such description and explanation in the answer if he feels it necessary to present properly and effectively his case to the Board of Appeals.

The examiner should reevaluate his position in the light of the arguments presented in the brief, and should expressly withdraw any rejections not adhered to, especially if the rejection was made in an action which is incorporated by reference. This should be done even though any rejection not repeated and discussed in the answer may be taken by the Board as having been withdrawn.

The Board has authority to remand a case to the examiner for a fuller description of the claimed invention and, in the case of a machine, a statement of its mode of operation. In certain cases where the pertinence of the references is not clear, the Board may call upon the examiner for a further explanation. In the case of multiple rejections of a cumulative nature, the Board may also remand for selection of the preferred or best ground. The Board may also remand a case to the examiner for further search where it feels that the most pertinent art has not been cited.

All correspondence with the Board of Appeals, whether by the examiner or the applicant must be on the record. No unpublished decisions which are unavailable to the general public by reason of 35 U.S.C. 122 can be cited by the examiner or the applicant except that either the examiner or the applicant has the right to cite an unpublished decision in an application having common ownership with the application on appeal.

When files are forwarded, soft copies and prints of references therein should not be disturbed.

If an examiner's answer is believed to contain a new interpretation or application of the existing patent law, the examiner's answer, application file and an explanatory memorandum should be forwarded to the group director for consideration, see § 1003, item 16. If approved by the group director, the examiner's answer should be forwarded to the Office of the Assistant Commissioner for Patents for final approval.

A form suitable for the examiner's answer is as follows:

POL–84

IN RE APPLICATION OF

Ser. No. ------	
Filed ----------	Before the Board of Appeals
For ----------	

EXAMINER'S ANSWER

"This is an appeal from the final rejection of claims ------. Claims ------ are allowable."

"A correct copy of the appealed claims appears on page — of the applicant's brief." (If any claims are incorrect, they should be correctly reproduced in the answer in clean copy without any underlining or brackets as required by rule 121(b)).

Statement as to any ground of rejection not argued or responded to by applicant and the particular claims affected by such lack of response.

"The references of record relied on are:

1,736,481	Smith	6–20
1,894,324	Jones	7–23

"New References" See § 1208.01.

(The examiner's answer must cite all references relied on in the appeal and cannot refer to other papers for this information. In citing non-patent references, the current location of the reference should be specified by class and subclass or, if not classified, the particular location in the Office where a copy can be found. In addition, the citation should specify the precise page or pages of the reference relied on. Omit listing of references not involved in the appeal.)

"Statement of the grounds of rejection."

Reference may be made to a final rejection or single prior action for a clear exposition of the rejection. If not all of the prior rejections in such a referred to prior action are maintained, they should be specifically noted as not being applied. If necessary, a description and explanation of the alleged invention and references may be made to present the examiner's case properly. If pertinent, a statement should be included that a new ground of rejection is contained in the answer.

Response to the allegations and arguments in the brief not already met by the final rejection.

If a new ground of rejection is raised, see § 1208.01.

For case having patentability report see § 705.01(a).

Request by the examiner to present arguments at the oral hearing.

1208.01 New Reference, New Objection or New Ground of Rejection in Examiner's Answer [R–42]

At the time of preparing his answer to an appeal brief, the examiner may decide that he should cite a new reference, raise a new objection, or apply a new ground of rejection (new reference, double patenting, statutory bar or

other reason for rejection) against some or all of the appealed claims. The group director's approval must be obtained prior to writing the answer for any new reference or new ground of rejection or objection incorporated in the examiner's answer. See § 1003, item 15.

After prior approval of the group director is obtained, all answers citing new references or containing new grounds of rejection or objection must be routed over the supervisory primary examiner's desk. These should then be brought to the attention of the director for his review and approval. The director will stamp "approved" on all copies of the answer

if it meets with his approval. If approval is given to the citation of new references, the answer will be mailed by the group and will include copies of the new references. Reference Processing Unit (RPU) will not be involved in these actions. Also, a PO–892 must be completed for the file for use by the printer in case of issuance as a patent. The Board will return to the group director's office any answer containing (1) any newly cited reference (for any purpose) or (2) a new ground of rejection, where such answer does not bear an approved stamp.

In order to introduce a new ground of rejection it is necessary either to reopen the ex parte prosecution before the examiner or to include the new rejection in the examiner's answer, depending on existing circumstances. The choice of action to be followed will depend on such factors as the history of the prosecution, the number of claims affected, the importance of the new ground of rejection, the significance of the new reference and the nature of the response to be expected. For example, if the reference is basic and materially better in meeting all of the claims, reopening of the prosecution and making the action final would ordinarily be approved. Should applicant desire to have the Board review the examiner's action, he must file a new appeal (without fee) and a new brief (without fee). On the other hand, if the new reference anticipates some but not all of the claims or supplies a minor lack in art already relied on, inclusion of the new ground in the examiner's answer would normally be the approved procedure. Of course, if the new ground of rejection applies to any claim standing allowed the prosecution should be reopened.

It is important that the new ground with regard to which the group director has been consulted be clearly indicated as such so that the Board of Appeals can readily identify those applications where the applicant is entitled to a period of two months for reply. Any new reference should be cited under the caption "New Reference(s)."

Likewise when a ground of rejection not involving a new reference is raised for the first time in the answer after consultation with the group director the fact that it is a new ground should be clearly indicated, thus: THIS IS A NEW GROUND OF REJECTION, or some equivalent statement.

The examiner's answer which includes a new ground of rejection should conclude with the following paragraph:

> "In view of the new ground of rejection applicant has two months within which he may file a reply to this answer. Such reply may include any amendment or material appropriate to the new ground and may request remand to the examiner to consider such amendment or material. Prosecution otherwise remains closed. Failure to respond to the new ground of rejection will result in dismissal of the appeal of the claims so rejected if said failure to respond is construed as an acquiescence in this rejection."

Reply Brief

Where a new ground of rejection is raised in the examiner's answer, the applicant, under rule 193(b) has two months within which he may file a reply brief. The applicant's reply, insofar as the new ground of rejection is concerned, may include any amendment or material appropriate to the new ground. Consideration will be limited to amendments and facts pertinent to the new ground of rejection.

The examining group appeal clerks are authorized to grant, upon the first request therefor, 1-month extensions of time to file the brief or reply brief. Any further extensions or any initial request for an extension of more than 1 month may be granted by the group directors.

An amendment limited to the new ground of rejection is entitled to entry. Ex parte Abseck et al., 133 USPQ 411.

Where new points of argument have been raised in the examiner's answer, applicant may file a reply brief within twenty days from the date of such answer. Applicants should clearly and specifically indicate in their reply briefs the new points of argument "raised in the examiner's answer" to which said reply briefs are directed. Rule 193(b) does not permit general rebuttal of each statement made in the examiner's answer; consequently a reply brief which is not restricted to answering "new points" may be refused consideration in toto.

Applicants are reminded that their briefs in appealed cases must be responsive to every ground of rejection stated by the examiner, including new grounds stated in his answer.

Where an applicant fails to respond by way of brief or reply brief to any ground of rejection, and it appears that the failure is inadvertent, applicant shall be notified by the examiner that he is allowed one month to correct the defect by filing a supplemental brief. Where this procedure has not been followed, the Board of Appeals should remand the application to the examiner for compliance. When the record clearly indicates intentional failure to respond by brief to any ground of rejection, for example, by failure to file a supplemental brief within the one-month period allowed for that purpose, the examiner should inform the Board of Appeals of this fact in his answer and merely specify the claims affected.

Where the failure to respond by brief appears to be intentional, the Board of Appeals may dismiss the appeal as to the claims involved. Oral argument at a hearing will not remedy such deficiency of a brief.

SUPPLEMENTAL EXAMINER'S ANSWER

Normally, when a reply brief has been filed by the applicant following an examiner's answer, the application should be forwarded to the Board of Appeals without any need for the preparation of a supplemental answer by the examiner. The examiner should simply write "noted" on the reply brief along with his initials and the date. This will indicate to the clerical staff and the Board of Appeals that the examiner has seen the reply brief. However, where good reason to respond is apparent, the examiner may issue a supplemental answer in response to the reply brief before forwarding the case to the Board.

A supplemental examiner's answer may not contain a new ground of rejection.

In those situations where a reply brief is *clearly* unwarranted (e.g. no new grounds of rejection or new points of argument in the examiner's answer), the examiner should refuse entry of the reply brief. See rule 193(b). [R–36]

1208.02 Withdrawal of Final Rejection [R–28]

The examiner may withdraw the final rejection at any time prior to the mailing of the examiner's answer. It is possible that after reading the brief, the examiner may be convinced that some or all of the finally rejected claims are allowable. Where he is of the opinion that some of the claims are allowable he should so specify in the examiner's answer and confine his arguments to the remaining rejected claims. If he finds, upon reconsideration, that all the rejected claims are allowable, or where the applicant in his brief withdraws the appeal as to some of the rejected claims and the examiner finds the remaining claims to be allowable, he should pass the case to issue. **The Board should be notified whenever a remanded application is withdrawn from appeal under any circumstance.** See §§ 706.07(c) to 706.07(e).

In applications where an interference has resulted from the applicant copying claims from the patent which provided the basis for final rejection, the rejection based on that patent should be withdrawn and the appeal dismissed as to the involved claims.

1209 Oral Hearing [R–30]

Rule 194. Hearing. If no request for oral hearing has been made by the appellant, the appeal will be assigned for consideration and decision. If the appellant has requested an oral hearing, a day of hearing will be set, and due notice thereof given to the appellant. Hearing will be held as stated in the notice, and oral argument will be limited to one-half hour unless otherwise ordered before the hearing begins.

If applicant desires to argue his case before the Board, he must file a brief and at the same time indicate if he desires an oral hearing. If no request has been made by applicant, the appeal will be assigned for consideration and decision. That is, the decision will be rendered on the brief.

Preferably, the request for oral hearing should appear in the first paragraph of the brief and should be set out prominently.

A notice of hearing, stating the date, the time and the docket, is forwarded to the applicant in due course. If applicant fails to confirm within the stated time (14 days), the appeal is removed from the hearing docket and assigned on brief in due course. Similarly, after confirmation, if no appearance is made at the scheduled hearing, the appeal is decided on brief. Since failure to notify the Board of waiver of hearing in advance of the assigned date results in a waste of the Board's resources, applicant should inform the Board of a change in plans at the earliest possible opportunity.

If the time set in the notice conflicts with prior commitments or if subsequent events make appearance impossible, the hearing may be rescheduled on written request. However, postponements are discouraged and will not be granted in the absence of convincing reasons in support of the requested change.

If applicant has any special request, such as for a particular date or day of the week, this will be taken into consideration in setting the cases, if made known to the Board in advance, as long as such request does not unduly delay a decision in the case.

The arguments at the hearing may be presented by applicant's attorney or agent if he is duly authorized in accordance with rule 34.

Usually a half hour is allowed for applicant to explain his position. If applicant believes that additional time will be necessary, a request for such time should be made well in advance and will be taken into consideration in assigning the hearing date. The final decision on whether additional time is to be granted rests within the discretion of the senior member of the panel hearing the case.

Primary examiners are permitted to present oral arguments before the Board of Appeals in appeals where the applicant has been granted an oral hearing. After the applicant has made his presentation, the examiner will be allowed fifteen minutes to reply as well as to present a

OUTLINE OF PROPOSED RESTRICTION REQUIREMENT IN VIEW OF IN RE HAAS AND IN RE WOLFRUM

Pursuant to authority delegated by the Commissioner of Patents under 35 USC 121, restriction is hereby required between the independent and distinct inventions claimed in the present application and recited in claim _____, identified as follows:

I.

II.

III.

Etc.

~~The above inventions are regarded as "independent" because they are unconnected in operation, and one does not require the other for ultimate use. No dependent relationship among these has been disclosed in the specification or otherwise shown to exist. (or) The intermediates of Group I are useful per se in addition to being useful to make the compounds of Group II.~~

The above inventions are regarded as ~~not~~ independent and distinct because (1) they obviously are separate entities and/or (2) they ~~are~~ potentially patentable in view of each other.

It is to be noted that Congress has provided the Commissioner with discretion in S. 121 to restrict the application to one of two or more independent and distinct inventions. S. 121 does not purport to distinguish between two or more independent and distinct inventions recited in one claim vis-a-vis two or more independent and distinct inventions recited in more than one claim. Accordingly, applicant is required to limit the application to one of the above independent and distinct inventions.

statement which clearly sets forth his position with respect to the issues and rejections of record. Applicant may utilize any allotted time not used in the initial presentation for rebuttal.

Currently, up to two examiners are permitted to attend any one hearing as observers, where the case is related to the examiners' field of technology. The time of a hearing may be obtained by the examiners by telephoning the Board of Appeals about one month after the appeal is forwarded. The time should be checked a few days prior to the hearing to see if any change has been made. The examiner's request for an oral hearing should appear in the last paragraph of his examiner's answer.

1210 Actions Subsequent to Examiner's Answer but Before Board's Decision [R–39]

Jurisdiction of Board

The application file and jurisdiction of the application are transferred from the examining groups to the Board of Appeals at one of the following times:

1) After 2 months from the examiner's answer, plus mail room time, if a "new ground of rejection" has been indicated in the examiner's answer and no reply brief has been timely filed.
2) After 20 days from the examiner's answer, plus mail room time, where no new ground of rejection has been indicated in the examiner's answer and no reply brief has been timely filed.
3) After a supplemental examiner's answer has been mailed in reply to a timely reply brief.
4) After the examiner has determined by initialing and dating the reply brief, that he will not prepare a supplemental examiner's answer in response to a timely reply brief.

Any amendment, affidavit, or other paper relating to the appeal, filed thereafter but prior to the decision of the Board, may be considered by the examiner only in the event the case is remanded to him by the Board for that purpose.

Divided Jurisdiction

Where appeal is taken from the final rejection of one or more copied claims only, jurisdiction of the rest of the case remains with the examiner, and prosecution of the remaining claims may proceed as though the entire case was under his jurisdiction. Also, where the examiner certifies in writing that there is no conflict of subject matter, an appeal to the Board of Appeal may proceed concurrently with an interference.

Abandonment of Appeal

To avoid the rendering of decisions by the Board of Appeals in applications which have already been refiled as continuations, applicants should promptly inform the clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Failure to exercise appropriate diligence in this matter may result in the Board's refusing an otherwise proper request to vacate its decision.

Except in those instances where a withdrawal of an appeal would result in abandonment of the application, an attorney not of record in an application may file a paper under rule 34(a) withdrawing an appeal. In such instances where no allowable claims appear in the application, the withdrawal of an appeal is in fact an express abandonment and does not comply with rule 138.

1211 Remand by the Board To Consider Amendment [R–39]

There is no obligation resting on the Board to consider new or amended claims submitted while it has jurisdiction of the appeal. In re Sweet, 1943 C.D. 535; 58 USPQ 327; 30 CCPA 1124. A proposed amendment, affidavit, declaration, or other paper may be remanded for such consideration as the examiner may see fit to give. Such an amendment, unless filed under rule 193(b), will be treated as an amendment filed after appeal. See § 1207.

If the proposed amendment is in effect an abandonment of the appeal, as, by canceling the appealed claims, other claims being present which are patentable in the opinion of the examiner, the amendment should be entered and the clerk of the Board notified in order that the case may be removed from the Board's docket.

1212 Remand by the Board To Consider Affidavits or Declarations [R–39]

Rule 195. Affidavits or declarations after appeal. Affidavits, declarations, or exhibits submitted after the case has been appealed will not be admitted without a showing of good and sufficient reasons why they were not earlier presented.

Affidavits or declarations filed with or after appeal but before the mailing of the examiner's answer will be considered for entry only if the applicant makes the necessary showing under rule 195 as to why they were not earlier presented. Authority from the Board is not necessary to consider such affidavits or declarations. Affidavits or declarations filed after a final rejection and prior to a notice of appeal are handled as provided in §§ 715.09 and 716.

In the case of affidavits or declarations filed after the application has been forwarded to the Board of Appeals, the examiner is without authority to consider the same in the absence of a remand by the Board. When a case is remanded to the examiner for the consideration of such affidavits or declarations, the examiner, after having given such consideration as the facts in the case require, will return the case to the Board of Appeals with his answer on remand, a copy of which should be forwarded to the applicant. If such an affidavit or declaration is not accompanied by the showing required under rule 195, the examiner will not consider its merits. If the delay in filing such affidavit or declaration is satisfactorily explained, the examiner will admit the same and consider its merits. If this affidavit or declaration is accepted as overcoming the reference, or references, used in the final rejection, and a new reference having a filing date prior to the date of invention established in the record, or having a publication date more than one year prior to the applicant's filing date, is found, it may be substituted for the one overcome without thereby reopening the case to further prosecution before the examiner. Ex parte Bowyer, 1939 C.D. 5; 42 USPQ 526.

It is not the custom of the Board to remand affidavits or declarations offered in connection with a request for reconsideration of its decision. Affidavits or declarations submitted for this purpose, not remanded to the examiner, are considered only as arguments. In re Martin, 1946 C.D. 180; 69 USPQ 75; 33 CCPA 842.

1213 Decision by Board [R–20]

Extract of Rule 196. Decision by the Board of Appeals. (a) The Board of Appeals, in its decision, may affirm or reverse the decision of the primary examiner in whole or in part on the grounds and on the claims specified by the examiner. The affirmance of the rejection of a claim on any of the grounds specified constitutes a general affirmance of the decision of the primary examiner on that claim, except as to any ground specifically reversed.

After consideration of the record including applicant's brief and the examiner's answer, the Board writes its decision, affirming the examiner in whole or in part, or reversing his decision, sometimes also setting forth a new ground of rejection.

On occasion the Board of Appeals has refused to consider an appeal until after the conclusion of a pending civil action or appeal to the C.C.P.A. involving issues identical with and/or similar to those presented in the later appeal. Such suspension of action, postponing consideration of the appeal until the Board has the benefit of a court decision which may be determinative of the issues involved, has been recognized as sound practice. An applicant is not entitled, after obtaining a final decision by the Patent Office on an issue in a case, to utilize the prolonged pendency of a court proceeding as a means for avoiding res judicata while relitigating the same, or substantially the same issue in another application.

An applicant may request that the decision be withheld to permit the refiling of the application at any time prior to the mailing of the decision. Up to 30 days may be granted, although the time is usually limited as much as possible. The Board will be more prone to entertain the applicant's request where the request is filed early, obviating the necessity for an oral hearing or even for the setting of the oral hearing date. If the case has already been set for oral hearing, the petition should include a request to vacate the hearing date, *not* to postpone it.

In a situation where a withdrawal of the ap-

peal is filed on the same day that the decision is mailed, a petition to vacate the decision will be denied.

Since review of the decisions of the Board is committed by statute to the courts, its decisions are properly reviewable on petition only to the extent of determining whether they involve obvious error or abuse of discretion. Reasonable rulings made by the Board on matters resting in its discretion will not be disturbed upon petition. Thus, for example, the Board's opinion as to whether it has employed a new ground of rejection will not be set aside on petition unless said opinion is found to be clearly unwarranted.

1213.01 Recommendations of Board [R–20]

Extract of Rule 196. Decision by the Board of Appeals. . . . (c) Should the decision of the Board of Appeals include an explicit statement that a claim may be allowed in amended form, applicant shall have the right to amend in conformity with such statement, which shall be binding on the primary examiner in the absence of new references or grounds of rejection.

If the examiner knows of references or reasons which were not before the Board, such a favorable recommendation is not binding upon him. Likewise, any change in a favorably recommended claim other than the amendments recommended would tend to destroy the force of such recommendation. Ex parte Young, 18 Gour. 24: 31.

In the absence of an express recommendation, a remark by the Board that a certain feature does not appear in a claim is not to be taken as a recommendation that the claim be allowed if the feature is supplied by amendment. Ex parte Norlund, 1913 C.D. 161; 192 O.G. 989.

Applicant's right to amend in conformity with the recommendation may only be exercised within the period allowed for seeking court review, ordinarily sixty days from the date of the Board's decision.

1214 Actions Following Decision by Board [R–28]

Board of Appeals decisions may be published, if requested by the Board or group. In the event that the application has become abandoned, applicant's permission is sought prior to publication.

1214.01 New Ground of Rejection [R–25]

Extract from Rule 196. Decisions by the Board of Appeals . . . (b) Should the Board of Appeals have knowledge of any grounds not involved in the appeal for rejecting any appealed claim, it may include in its decision a statement to that effect with its reasons for so holding, which statement shall constitute a rejection of the claims. The appellant may submit an appropriate amendment of the claims so rejected or a showing of facts, or both, and have the matter considered by the primary examiner. The statement shall be binding upon the primary examiner unless an amendment or showing of facts not previously of record be made which, in the opinion of the primary examiner, avoids the additional ground for rejection stated in the decision. The applicant may waive such reconsideration before the primary examiner and have the case reconsidered by the Board of Appeals upon the same record before them. Where request for such reconsideration is made the Board of Appeals shall, if necessary, render a new decision which shall include all grounds upon which a patent is refused. The applicant may waive reconsideration by the Board of Appeals and treat the decision, including the added grounds for rejection given by the Board of Appeals, as a final decision in the case.

A. A request for reconsideration by the Board must be filed within thirty days from the date of the decision, the period set by rule 197(b). By proceeding in this manner the applicant waives his right to further prosecution before the examiner. In re Greenfield, 1930 C.D. 531; 5 USPQ 474.

B. Where the Board's decision completely removes the examiner's rejection as to one or more claims and substitutes a new one under rule 196(b), the applicant, if he elects to proceed before the examiner, must take such action within the period for response set in the Board's decision, which may not exceed six months from the Board's decision. See In re application filed July 13, 1950 at 693 O.G. 136; 1955 C.D. 3. A shortened period for response of thirty days ordinarily is set in the Board's decision.

The applicant may amend the claims involved, or substitute new claims to avoid the art or reasons adduced by the Board. Ex parte Burrowes, 1904 C.D. 155; 110 O.G. 599. Such amended or new claims must be directed to the same subject matter as the appealed claims, Ex parte Comstock, 1923 C.D. 82; 317 O.G. 4.

Argument without amendment of the claims so rejected can result only in a final rejection of the claims, since the examiner is without authority to allow the claims unless amended or unless the rejection is overcome by a showing of facts not before the Board. The new ground of rejection raised by the Board does not reopen the prosecution except as to that subject matter to which the new rejection was applied.

C. As a third option, applicant may treat such decision of the Board as final and file either a direct appeal therefrom to the C.C.P.A., or a civil action under 35 U.S.C. 145. In re Crowell, 1930 C.D. 360; 397 O.G. 3. Where the applicant avails himself of the third option, he waives his right to reconsideration by the Board, or by the examiner, discussed above. In re Heinz, 1910 C.D. 292; 151 O.G. 1014.

1214.02 Procedure After Decision [R–20]

Extract from Rule 197. Action following decision. (a) After decision by the Board of Appeals, the case shall be returned to the primary examiner, subject to the applicant's right of appeal or other review, for such further action by the applicant or by the primary examiner, as the condition of the case may require, to carry into effect the decision.

After an appeal to the Board of Appeals has been decided, a copy of the decision is mailed to the applicant and the original placed in the file. The clerk of the Board notes the decision on the file wrapper and in the record of appeals, and then forwards the file to the primary examiner through the office of the group director immediately if the examiner is reversed, and after 30 days if the examiner is affirmed.

1214.03 Rehearing and Reconsideration [R–35]

Extract from rule 197. Action following decision. . . . (b) Any request or petition for rehearing or reconsideration, or modification of the decision, must be filed within thirty days from the date of the original decision, unless that decision is so modified as to become, in effect, a new decision, and the Board of Appeals so states.

"No petition for rehearing or reconsideration filed outside the time specified shall operate to extend the period of sixty days" for appeal to the U.S. Court of Customs and Patent Appeals or for commencing a civil action, rule 304. The Commissioner may suspend or waive the sixty day limit of rule 304, Eckey v. Watson, 122 USPQ 5; 1959 C.D. 119. In such a petition an adequate showing under rule 183 is demanded.

All copies of references in the file wrapper should be retained therein.

1214.04 Examiner Reversed [R–42]

A complete reversal of the examiner's rejection brings the case up for immediate action by the examiner.

The examiner should never regard such a reversal as a challenge to make a new search to uncover other and better references. This is particularly so where the application has meanwhile been transferred or assigned to an examiner other than the one who finally rejected the claims. The second examiner should give full faith and credit to his predecessor's search. Of course, if the examiner has specific knowledge of the existence of a particular reference which obviously meets the terms of any of the appealed claims as to which the examiner was reversed, he should submit the matter to the group director for authorization to reopen prosecution under rule 198 for the purpose of entering the new rejection. Note §§ 1002.02(c), item 2, and 1214.07. The group director's approval should appear on the action reopening prosecution.

All requests by the examiner to the Board of Appeals for reconsideration of a decision, must be approved by the group director and must be forwarded to the office of the Deputy Assistant Commissioner for Patents.

1214.05 Cancellation of Withdrawn Claims [R–20]

Where an applicant withdraws some of the appealed claims, and the Board reverses the examiner on the remaining appealed claims, the withdrawal is treated as an authorization to cancel the withdrawn claims. It is not necessary to notify the applicant of the cancellation of the withdrawn claims.

1214.06 Examiner Sustained in Whole or in Part [R–39]

Extract from Rule 197. Action following decision . . . (c) When an appeal is or stands dismissed, or when the time for appeal to the court or review by civil action (rule 304) has expired and no such appeal or civil action has been filed, proceedings in the application are considered terminated as of the dismissal or expiration date except in those applications in which claims stand allowed or in which the nature of the decision requires further action by the examiner. If an appeal to the court or a civil action has been filed, proceedings in the application are similarly considered terminated when the appeal or civil action is terminated.

If the examiner was sustained either in whole or in part, it is improper to notify applicant of the status of the case unless asked to do so. See Ex parte Buchenberg 1924 C.D. 55; 327 O.G. 216.

The time for seeking review of a decision of the Board of Appeals by the C.C.P.A. or the District Court is the same for both tribunals, that is, sixty days, or sixty days with the extension provided by rule 304 in the event a petition for reconsideration or rehearing is seasonably filed before the Board, or as extended

by the Commissioner. See § 1214.03. When the time for seeking court review (plus two weeks to allow for information as to the filing of an appeal or civil action, if any, to reach the examiner) has passed without such review, being sought, the examiner must take up the case for consideration. The situations which can arise will involve one or more of the following six circumstances:

A. *No claims stand allowed.* The proceedings in the application are terminated as of the date of the expiration of the time for filing court action. The application is no longer considered as pending. It is to be stamped abandoned and sent to abandoned files without notifying applicant.

B. *Claims stand allowed.* The applicant is not required to file a response. The examiner takes the case up and passes it to issue on the claims which stand allowed. A red ink line should be drawn through the refused claims and the notation "Board Decision" written in the margin in red ink.

If uncorrected matters of form which cannot be handled without written correspondence remain in the case, the examiner should take appropriate action but prosecution is otherwise closed. A letter such as the following is suggested:

"In view of the fact that the period for seeking court review of the decision by the Board of Appeals rendered (*date of decision*) has expired and no further action has been taken by applicant, the proceedings as to the rejected claims are considered terminated; see rule 197(c)."

"The application will be passed to issue on claims (*identify*) which stand allowed provided the following formal matter(s) is (are) promptly corrected. Prosecution is otherwise closed."

(Set out formal matter(s) requiring correction.)

(Set a thirty day Shortened Statutory Period for response.)

C. *Claims require action.* If the decision of the Board is an affirmance in part and includes a reversal of a rejection that brings certain claims up for action on the merits, such as a decision reversing the rejection of generic claims in a case containing claims to nonelected species not previously acted upon, the examiner will take the case up for appropriate action on the matters thus brought up, but the case is not considered open to further prosecution except as to such matters.

D. *Rule 196(b) rejection.* Where the Board makes a new rejection under rule 196(b) and no action is taken with reference thereto by the applicant within six months, *or such shortened period as may be set in the Board's decision*, the examiner should proceed in the manner indicated for situations A, B, or C, depending on which is appropriate to the case. See § 1214.01.

If the Board sustains the examiner's rejection, but also enters a new ground of rejection under rule 196(b), the filing of a request for reconsideration on the affirmed rejection will defer the end of the period for appeal to the courts until 30 days after the decision on reconsideration, to allow time for the examiner to consider any amendments and/or evidence offered to traverse the new ground of rejection.

E. *Rule 196(c) recommendation.* Where the Board makes a recommendation under rule 196(c) and no action is taken with reference thereto by the applicant within the time permitted for court review, ordinarily sixty days from the date of the decision, the examiner should proceed in the manner indicated for situations A, B, or C, depending on which is appropriate to the case. See § 1213.01.

F. *Appeal dismissed.* Where the appeal has been dismissed for failure to argue a ground of rejection involving all the appealed claims see § 1215.04.

The practice under situations A, B, and C is similar to the practice after a decision of the court outlined in § 1216.01.

In view of the above practice, examiners must be very careful that applications which come back from the Board of Appeals are not overlooked because every case, except those in which all claims stand rejected after the Board's decision, is up for action by the examiner in the event no court review has been sought. Consequently, when a file is received after decision by the Board of Appeals, it must be examined and appropriate precautions taken to indicate the presence of allowed claims, if any. This may be done by writing the notation "Allowed Claims" or "Rejection Reversed" on "Contents" of file wrapper immediately below endorsement "Decision by Board".

See §§ 1216.01 and 1216.02 for procedure where court review is sought.

1214.07 Reopening of Prosecution [R–25]

Rule 198. Reopening after decision. Cases which have been decided by the Board of Appeals will not be reopened or reconsidered by the primary examiner, except under the provisions of rule 196, without the written authority of the Commissioner, and then only for the consideration of matters not already adjudicated, sufficient cause being shown.

Sometimes an amendment is filed after the Board's decision which does not carry into ef-

fect any recommendation made by the Board and which presents a new or amended claim or claims. In view of the fact that the prosecution of the case is definitely closed, the applicant clearly is not entitled to have such amendment entered as a matter of right. However, if the amendment obviously places the case in condition for allowance, the primary examiner should endorse on the amendatory paper a recommendation that the amendment be admitted, and with the concurrence of the group director, the amendment will be entered. Note § 1003, item 14.

Where the amendment cannot be entered, the examiner should write to the applicant notifying him that the amendment cannot be entered and stating the reason why. The refusal should never be made to appear arbitrary or capricious. A letter such as the following might be used:

"The amendment filed _____ after the Board's decision is refused entry because the prosecution is closed and the new claims (or claims as amended) raise new issues which require further consideration or search."

In the event that claims stand allowed in the case under the conditions set forth in § 1214.06 (paragraph B), the case should be passed to issue.

Since October 16, 1969, the Commissioner has entertained petitions under rule 198 to reopen certain cases in which an applicant has sought review under 35 U.S.C. 141 or 145. This procedure is restricted to cases which have been decided by the Board of Appeals and which are amenable to settlement without the need for going forward with the court proceeding. Note § 1002.02(c), item 2. Such petitions will ordinarily be granted only in the following categories of cases:

1. When the decision of the Board of Appeals asserts that the rejection of the claims is proper because the claims do not include a disclosed limitation or because they suffer from some other curable defect, and the decision reasonably is suggestive that claims including the limitation or devoid of the defect will be allowable;

2. When the decision of the Board of Appeals asserts that the rejection of the claims is proper because the record does not include evidence of a specified character, and is reasonably suggestive that if such evidence were presented, the appealed claims would be allowable, and it is demonstrated that such evidence presently exists and can be offered; or

3. When the decision of the Board of Appeals is based on a practice, rule, law, or judicial precedent which, since the Board's decision, has been rescinded, repealed, or overruled.

Any such petition must be accompanied by the proposed amendment, evidence, or argument said to justify allowance of the claims. The petition further must point out how the case falls within one of the preceding categories. Failure to do so or failure of the case to qualify as coming within one of the categories will usually constitute basis for denying the petition. In any event, no case will be reopened unless it is for the consideration of matters not already adjudicated, and sufficient cause has been shown. Such petitions are referred to the group director for decision. Note § 1002.02(c), item 2. The group director's approval is indicated on the Office action which reopens the prosecution of the application.

Such petitions will not be ordinarily entertained after the filing of the Commissioner's brief in cases in which review has been sought under 35 U.S.C. 141, or after trial in a 35 U.S.C. 145 case.

In the case of an appeal under 35 U.S.C. 141, if the petition is granted, steps will be taken to request the court to remand the case to the Patent Office and if so remanded the proposed amendments, evidence, and arguments will be entered of record in the application file for consideration, and further action will be taken by the Board of Appeals in the first instance or by the examiner as may be appropriate. In the case of civil action under 35 U.S.C. 145, steps will be taken for obtaining dismissal of the action without prejudice to consideration of the proposals. [R–42]

1215 Withdrawal or Dismissal of Appeal

1215.01 Withdrawal of Appeal [R–42]

Except in those instances where a withdrawal of an appeal would result in abandonment of the application, an attorney not of record in an application may file a paper under rule 34(a) withdrawing an appeal. In such instances where no allowable claims appear in the application, the withdrawal of an appeal is in fact an express abandonment and does not comply with rule 138.

Where, after appeal has been filed and before decision by the Board of Appeals, an applicant withdraws his appeal after the period for response to the final rejection has expired, the application is to be considered abandoned as of the date on which the appeal was withdrawn unless there are allowed claims in the case.

Where a letter abandoning the application is filed in accordance with rule 138, the effective

date of abandonment is the date of filing of such letter.

If a brief has been filed within the time permitted by rule 192 (or any extension thereof) and an answer mailed and applicant withdraws the appeal, the case is returned to the examiner.

To avoid the rendering of decisions by the Board of Appeals in applications which have already been refiled as continuations, applicants should promptly inform the clerk of the Board in writing as soon as they have positively decided to refile or to abandon an application containing an appeal awaiting a decision. Failure to exercise appropriate diligence in this matter may result in the Board's refusing an otherwise proper request to vacate its decision.

1215.02 Claims Standing Allowed [R–20]

If the application contains allowed claims, as well as claims on appeal, the withdrawal of the appeal does not operate as an abandonment of the application, but is considered a withdrawal of the appeal as to those claims and authority to the examiner to cancel the same. An amendment canceling the appealed claims is equivalent to a withdrawal of the appeal.

1215.03 Partial Withdrawal [R–20]

A withdrawal of the appeal as to some of the claims on appeal operates as a cancelation of those claims from the case and the appeal continues as to the remaining claims. The withdrawn claims will be canceled by direction of the examiner when necessary without further action by the applicant.

1215.04 Dismissal of Appeal [R–42]

If no brief is filed within the time prescribed by rule 192, the appeal stands dismissed by operation of the rule. The letter (form POL–333) notifying the applicant that the appeal stands dismissed is not an action in the case and does not start any period for reply. If no claims stand allowed the application is considered as abandoned on the date the brief was due. No notification to the applicant that the application is abandoned is necessary. If claims stand allowed in the application, the failure to file a brief and consequent dismissal of the appeal is to be treated as a withdrawal of the appeal and of any claim not standing allowed. The application should be passed to issue forthwith.

However, if formal matters remain to be attended to, the examiner should take appropriate action on such matters, setting a shortened period for reply, but the application is to be considered closed to further prosecution except as to such matters.

A letter such as the following is suggested:

"In view of applicant's failure to file a brief within the time prescribed by rule 192, the appeal stands dismissed and the proceedings as to the rejected claims are considered terminated; see rule 197(c).

"This application will be passed to issue on claims (*identify*) which stand allowed provided the following formal matter(s) is (are) corrected. Prosecution is otherwise closed."

(Set out formal matter(s) requiring correction.)

(Set a thirty day shortened statutory period for response.)

1215.05 Case Before the Court [R–20]

When the case is before the court either on appeal, 35 U.S.C. 141, or in a civil action under 35 U.S.C. 145, the status of the application in the event of a dismissal must be determined according to the circumstances leading to the dismissal. In no event will the application be considered abandoned as of a date prior to the date of the dismissal by reason of the dismissal alone.

1216 Appeals to Courts [R–35]

Rule 304. Time for appeal or civil action. The time for filing the notice and reasons of appeal to the U.S. Court of Customs and Patent Appeals (rule 302) or for commencing a civil action (rule 303) is sixty days from the date of the decision of the Board of Appeals or the Board of Patent Interferences. If a petition for rehearing or reconsideration is filed within thirty days after the date of the decision of the Board of Appeals or Board of Patent Interferences, the time is extended to thirty days after action on the petition. No petition for rehearing or reconsideration filed outside the time specified herein after such decision, nor any proceedings on such petition shall operate to extend the period of sixty days hereinabove provided. The times specified herein are calendar days. If the last day of the time specified for appeal or commencing a civil action falls on a Saturday, Sunday, or legal holiday, the time is extended to the next day which is neither a Saturday, Sunday nor a holiday. If a defeated party to an interference has taken an appeal to the U.S. Court of Customs and Patent Appeals and an adverse party has filed notice under 35 U.S.C. 141 that he elects to have all further proceedings conducted under 35 U.S.C. 146 (rule 303(c)), the time for filing a civil action thereafter is specified in 35 U.S.C. 141.

Files of cases carried to the courts, either by appeal to the Court of Customs and Patent Appeals or by civil action in the District Court for the District of Columbia, are not opened by the Patent Office to the public.

During the pendency of a suit the application is not under the jurisdiction of the examiner; and any amendment, as one copying claims from a patent for interference purposes, can be admitted only under the provisions of rule 198.

Service of Court Papers on Commissioner of Patents

Those having occasion to serve on the Commissioner of Patents papers having to do with court proceedings are reminded that proper service by mail may be effected only by mailing the papers to the Solicitor of the Patent Office as counsel for the Commissioner. Rule 5(b) of the Federal Rules of Civil Procedure provides in pertinent part:

> Whenever under these rules service is required or permitted to be made upon a party represented by an attorney the service shall be made upon the attorney unless service upon the party himself is ordered by the court. Service upon the attorney * * * shall be made by delivering a copy to him or by mailing it to him at his last known address * * *.

Rule 25(b) of the Federal Rules of Appellate Procedure similarly provides, "Service on a party represented by counsel shall be made on counsel." The clerk of the U.S. Court of Customs and Patent Appeals has stated that, inasmuch as the rules of the Court are not specific on the manner of service in patent cases, the procedure outlined herein has the Court's approval.

Accordingly, all service copies of papers filed in court proceedings in which the Commissioner of Patents is a party which are served by mail should be addressed:

"(Name of Solicitor), Solicitor
U.S. Patent Office
Washington, D.C. 20231."

1216.01 To Court of Customs and Patent Appeals [R–34]

Rule 301. Appeal to U.S. Court of Customs and Patent Appeals. Any applicant dissatisfied with the decision of the Board of Appeals, and any party to an interference dissatisfied with the decision of the Board of Patent Interferences, may appeal to the U.S. Court of Customs and Patent Appeals. The appellant must take the following steps in such an appeal: (a) In the Patent Office give notice to the Commissioner and file the reasons of appeal (see rules 302 and 304); (b) in the court, file a petition of appeal and a certified transcript of the record within a specified time after filing the reasons of appeal, and pay the fee for appeal, as provided by the rules of the court. The transcript will be transmitted to the Court by the Patent Office on order of and at the expense of the appellant. Such order should be filed with the notice of appeal, but in no case should it be filed later than 15 days thereafter.

35 U.S.C. 141. Appeal to Court of Customs and Patent Appeals. An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case.

35 U.S.C. 142. Notice of appeal. When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints.

35 U.S.C. 143. Proceedings on appeal. The United States Court of Customs and Patent Appeals shall, before hearing such appeal, give notice of the time and place of the hearing to the Commissioner and the parties thereto. The Commissioner shall transmit to the court certified copies of all the necessary original papers and evidence in the case specified by the appellant and any additional papers and evidence specified by the appellee and in an ex parte case the Commissioner shall furnish the court with the grounds of the decision of the Patent Office, in writing, touching all the points involved by the reasons of appeal.

35 U.S.C. 144. Decision on appeal. The United States Court of Customs and Patent Appeals, on petition, shall hear and determine such appeal on the evidence produced before the Patent Office, and the decision shall be confined to the points set forth in the reasons of appeal. Upon its determination the court shall return to the Commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office and govern the further proceedings in the case.

Rule 302. Notice and reasons of appeal. (a) When an appeal is taken to the U.S. Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and file in the Patent Office, within the time specified in rule 304, his reasons of appeal specifically set forth in writing.

(b) In interferences and other contested cases, the notice and reasons must be served as provided in rule 248.

If an applicant is dissatisfied with the decision of the Board of Appeals and desires to have said decision reviewed on the record, he must file a "Notice of Appeal" in the Patent Office, within 60 days after the date of the Board's decision or 30 days from a decision on reconsideration, in order to have the Court of Customs and Patent Appeals consider his appeal. See 35 U.S.C. 142.

When the Office of the Solicitor receives the notice of appeal, it acknowledges receipt of the notice and requests that an order (called praecipe) be filed within 20 days. The order or praecipe states the exact papers to be certified which forms the transcript of record that is transmitted to the court.

The transcript of record, petition and $50.00 fee must be filed in the court within 40 calendar days from the date upon which said "Notice of Appeal" was filed; provided the Commissioner does not extend such time. If the 40th day falls on a Saturday, Sunday or legal holiday, the period runs until the end of the next day which is not a Saturday, Sunday or legal holiday. See rules 5.2 and 4.1 of the Rules of the United States Court of Customs and Patent Appeals.

The appeal is docketed in the Court if the petition, transcript and fee are timely filed. If not timely filed, there is no specific order of dismissal by the Court but the rules of the Court restore jurisdiction to the Patent Office. If no claims stand allowed proceedings are considered terminated on the last day the petition, transcript and fee were due (since up to this day the case was alive and applicant could take some action) Ex parte Vossen, 1967 C.D. 29; 155 USPQ 109.

After restoration of jurisdiction to the Patent Office the action taken by the examiner will be the same as set forth in the paragraphs under "Action Following Decision by Court" below.

After the court has heard and decided the appeal, a copy of the decision is sent to the Patent Office and one to the applicant. Where the applicant files a petition for rehearing, the Court's ruling thereon is communicated to the Office and to the applicant by the Clerk of the Court.

Finally, the Clerk of the Court forwards to the Office a certified copy of the Court's decision on the appealed claims. This copy is a duplicate of the uncertified copy first forwarded, unless modified as a result of the petition for rehearing or, possibly, altered to correct some minor error. The date of receipt of this copy by the Patent Office marks the conclusion of the appeal. Continental Can Company, Inc., et al. v. Schuyler, 168 USPQ 625. The decision of the Court is published; but unless the application becomes a patent, the Patent Office does not give the public access to the application file. Since a transcript of the application becomes a part of the court record, it may of course be inspected there by anyone, In re Mosher, 45 CCPA 701; 115 USPQ 140.

The Solicitor enters the certified copy of the Court's decision in the application file and returns it to the primary examiner.

Action Following Decision by Court

1. All claims rejected. If all claims in the case stand rejected, proceedings on the application are considered terminated on the date of receipt of the Court's certificate and the application is not open to subsequent amendment and prosecution by the applicant since the application is no longer considered pending. Continental Can Company, Inc., et al. v. Schuyler, 168 USPQ 625 (D.C.D.C. 1970). Exceptions may occur where the court mandate clearly indicates that another action is to be taken.

2. Some claims allowed. If some claims in the case stand allowed, either by reversal of the Office decision by the Court or the Board of Appeals or by having been allowed by the examiner, proceedings are considered terminated as to the rejected claims. Action by the applicant canceling the rejected claims is not considered necessary. The examiner will pass the case for issue forthwith on the allowed claims, the applicant being advised of such action. The rejected claims may be canceled by the examiner with an appropriate notation on the margin, to avoid confusion of the printer. However, if formal matters remain to be attended to, the examiner should take appropriate action on such matters, setting a 30 day shortened period for reply, but the application is considered closed to further prosecution except as to such matters. If all claims in the case stand allowed after the Court's decision formal matters if any should be taken care of and the case passed for issue.

3. Remand. If the decision of the Court is such that it brings certain claims up for action on the merits, such as a decision allowing generic claims in a case containing claims to non-elected species not previously acted upon, the examiner will take the case up for appropriate action on the matters thus brought up, but the case is not considered open to further prosecution except as to such matters. A remand by the Court is a remand to the Board of Appeals and not to the examiner. The examiner may only act on the application if

it is remanded to him by the Board. Note In re Fisher, 171 USPQ 292.

4. Reopening of prosecution. In unusual situations it may be desirable to reopen prosecution of an application after a court decision. Office actions proposing to reopen prosecution after a court decision must be forwarded to the Deputy Assistant Commissioner for Patents for approval. The Deputy Assistant Commissioner for Patents will indicate his approval to reopen on the Office action.

Dismissal of Appeal

After the appeal is docketed in the Court, failure to prosecute the appeal, as by failure to print the record or failure to file the brief, will result in dismissal of the appeal by the Court; or there may be a dismissal by the Court at the request of the appellant. The proceedings are considered terminated and the application abandoned if applicable as of the date of dismissal, see § 1215.05.

After dismissal, if no claims stand allowed the action taken by the examiner will be the same as set forth in paragraph 1 above; if claims stand allowed the action is in accordance with paragraph 2.

1216.02 Civil Suits [R–25]

Rule 303. Civil action under 35 U.S.C. 145, 146. (a) Any applicant dissatisfied with the decision of the Board of Appeals, and any party dissatisfied with the decision of the Board of Patent Interferences, may, instead of appealing to the U.S. Court of Customs and Patent Appeals (rule 301), have remedy by civil action under 35 U.S.C. 145 and 146 respectively. Such civil action must be commenced within the time specified in rule 304.

(b) If an applicant in an ex parte case has taken an appeal to the U.S. Court of Customs and Patent Appeals, he thereby waives his right to proceed under 35 U.S.C. 145.

(c) If a defeated party to an interference proceeding has taken an appeal to the U.S. Court of Customs and Patent Appeals, and any adverse party to the interference shall, within twenty days after the appellant shall have filed notice of the appeal to the court (rule 302), file notice with the Commissioner that he elects to have all further proceedings conducted as provided in 35 U.S.C. 146, certified copies of such notices will be transmitted to the U.S. Court of Customs and Patent Appeals for such action as may be necessary. The notice of election must be served as provided in rule 248.

35 U.S.C. 145. Civil action to obtain patent. An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

If an applicant is dissatisfied with the decision of the Board of Appeals and desires to have said decision reviewed, within 60 days after the date of the Board's decision or 30 days after the date of a Board's decision on reconsideration, he must file a complaint in the United States District Court for the District of Columbia and have the marshall serve a summons on the Commissioner of Patents.

When a suit under 35 U.S.C. 145 is filed a notice thereof signed by the Solicitor of the Patent Office is placed in the application file. The file is kept in the Solicitor's office pending termination of the suit. When the suit is terminated, a statement indicating the final disposition of it by the Court is placed on the original notice by the Solicitor and the application is returned to the examiner, whose subsequent procedure is the same as his action following appeal, described in § 1216.01. If the exact date when proceedings were terminated is material, it may be ascertained by inquiring at the Solicitor's office.

The applicant ordinarily furnishes to the court a certified copy of the file wrapper and contents at the time of the trial (28 U.S.C. 1744). If the suit is dismissed before coming to trial, no disclosure of the application to the public necessarily results. Unlike an appeal to the U.S. Court of Customs and Patent Appeals, the filing of a civil action does not require the immediate filing of a transcript of the application. The complaint, however, is open to the public.

Files subpoenaed by the Court may be sent to the Court in care of a Patent Office employee along with a certified copy, under stipulation that the copy be retained by the court and the original brought back to the Office by said employee.

Chapter 1300 Allowance and Issue

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1301 Substantially Allowable Case, Special [R–30]

When an application is in condition for allowance, except as to matters of form, the case will be considered special and prompt action taken to require correction of formal matters. See § 710.02(b).

1302 Final Review and Preparation for Issue

1302.01 General Review of Disclosure [R–30]

When an application is apparently ready for allowance, it should be reviewed by the examiner to make certain that the whole case meets all formal requirements and particularly that the brief summary of the invention and the descriptive matter are confined to the invention to which the allowed claims are directed and that the language of the claims finds clear support or antecedent basis in the specification. Neglect to give due attention to these matters may lead to confusion as to the scope of the patent.

Frequently the invention as originally described and claimed was of much greater scope than that defined in the claims as allowed. Some or much of the subject matter disclosed may be entirely outside the bounds of the claims accepted by the applicant. In such case the examiner should require the applicant to modify his brief summary of the invention and restrict his descriptive matter so as to be in harmony with the claims. However valuable for reference purposes the examiner may consider the matter which is extraneous to the claimed invention, patents should be confined in their disclosures to the respective inventions patented. (rule 71.) Of course enough background should be included to make the invention clearly understandable. See §§ 608.01(d) and 608.01(e).

There should be clear support or antecedent basis in the specification for the terminology used in the claims. Usually the original claims follow the nomenclature of the specification; but sometimes in amending the claims or in adding new claims, applicant employs terms that do not appear in the specification. This may result in uncertainty as to the interpretation to be given such terms. See § 601.01(o).

Where a copending application is referred to in the specification, the examiner should ascertain whether it has matured into a patent or become abandoned and that fact or the patent number added to the specification.

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The claims should be renumbered as required by rule 126, and particular attention should be given to claims dependent on previous claims to see that the numbering is consistent. See §§ 608.01(j), 608.01(n) and 1302.04(g).

The abstract should be checked for an adequate and clear statement of the disclosure. See § 608.01(b).

The title should also be checked. It should be as short and specific as possible. If a satisfactory title is not supplied by the applicant, the examiner may change the title on or after allowance. See §§ 606 and 606.01.

All pencil notes made by the examiners must be erased when the case is passed to issue.

The Mail Room receipt date of all amendments should be reviewed to assure that they were timely filed.

1302.02 Requirement for a Rewritten Specification [R–24]

Whenever interlineations or cancellations have been made in the specification or amendments which would lead to confusion and mistake, the examiner should require the entire portion of specification affected to be rewritten before passing the case to issue. See rule 125 in § 608.01(q).

1302.03 Status Letter of Allowability, POL–327 [R–31]

Form POL–327 is used whenever an application has been placed in condition for allowance as a result of a communication from or an interview with applicant except where an examiner's amendment will be mailed promptly.

The date of the communication or interview which resulted in the allowance and the name of the person with whom the interview, if any, was held should be included in the letter.

Immediately after determining that a POL 327 letter or examiner's amendment is necessary, it should be prepared and mailed before preparing the application for allowance. See § 714.13.

1302.04 Examiner's Amendments and Changes [R–31]

Except by formal amendment duly signed or as hereinafter provided, no corrections, erasures, or interlineations may be made in the body of written portions of the specification or any other paper filed in the application for patent. (See rule 121.)

Correction of the following obvious errors and omissions only may be made with pen by the examiner of the case who will then initial the sheet margin and assume full responsibility for the change. When correcting *originally filed* papers, clean red ink *must* be used (not blue or black ink).

1. Misspelled words.
2. Disagreement of a noun with its verb.
3. Inconsistent "case" of a pronoun.
4. Disagreement between a reference character as used in the description and on the drawing. The character may be corrected in the description but only when the examiner is certain of the propriety of the change.
5. Entry of "now Patent No. ____" to identify a patent which has been granted on a U.S. application referred to by serial number in the specification.
6. Other obvious minor grammatical errors such as misplaced or omitted commas, improper parentheses, quotation marks, etc.
7. Obvious informalities in the application, other than the ones noted above, or of purely grammatical nature.

The fact that applicant is entitled under 35 U.S.C. 120 to an earlier U.S. effective filing date is sometimes overlooked. To minimize this possibility, the statement that, "This is a division (continuation, continuation-in-part) of Application Serial No. ____, filed _____." should appear as the first sentence after the abstract except in the case of design applications where it should appear as set forth in § 1503.01. Any such statements appearing elsewhere in the specification should be relocated. The clerk indicates the change for the printer in the appropriate margin when checking new applications for matters of form.

Other obvious informalities in the application may be corrected by the examiner, but such corrections must be by a formal examiner's amendment, signed by the primary examiner, placed in the file, and a copy sent to the applicant. The changes specified in the amendment are entered by the clerk in the regular way.

The amendment or cancellation of claims by formal examiner's amendment is permitted when passing an application to issue where these changes have been authorized by applicant (or his attorney or agent) in a telephone or personal interview. The examiner's amendment should indicate that the changes were authorized, the date and type (personal or telephone) of interview, and with whom it was held.

The examiner's amendment practice may be used to make charges against deposit accounts under special conditions. Such charges must not exceed $50.00 for any one patent application.

An examiner's amendment can be used to make a charge against a deposit account, provided prior approval is obtained from the applicant, attorney or agent, in order to ex-

pedite the issuance of a patent on an application otherwise ready for allowance. When such an examiner's amendment is prepared the prior approval is indicated by identification of the name of the authorizing party, the date and type (personal or telephone) of authorization, the purpose for which the charge is made (drawing correction, additional claims, etc.), and the deposit account number. Further identifying data, if deemed necessary and requested by the attorney, should also be included in the examiner's amendment.

A change in the abstract may be made by examiner's amendment.

Where a reference to the parent application in an otherwise allowable rule 60 case has inadvertently been omitted by the applicant, the examiner should insert the required reference by examiner's amendment (see § 201.11).

References cited as being of interest by examiners when passing an application to issue will not be supplied to applicant. The references will be cited as usual on form PO–892, a copy of which will be attached to examiner's amendment form POL–37.

Where an application is ready for issue except for a slight defect in the drawing not involving change in structure, the examiner will note in pencil on the drawing the addition or alteration to be made. He will also prepare an examiner's amendment indicating the changes made and send the drawing to the Draftsman for the required correction.

See also § 608.02(w).

No other changes may be made by any person in any record of the Patent Office without the written approval of the Commissioner of Patents.

In reviewing the application all errors should be carefully noted. It is not necessary that the language be the best; it is, however, essential that it be clear in meaning, and free from errors in syntax. Any necessary examiner's amendment is usually made at the time a case is being prepared for issue by the examiner. However, the need for such may not be noted until after the proof of the patent is read and the case is sent up to the examiner with a "printer waiting" slip (Form PO–97). A copy of any formal examiner's amendment is sent to applicant even if the application is already in the printer's hands. See § 1309.01.

Examiners will not cancel claims on the basis of an amendment which argues for certain claims and, alternatively, purports to authorize their cancellation by the examiner if other claims are allowed, In re Willingham, 127 USPQ 211, CCPA (1960).

In all instances, both before and after final rejection, in which an application is placed in condition for allowance as by an interview or amendment, applicant should be notified promptly of this fact by means of form letter POL–327 or an examiner's amendment. [R–41]

1302.04(a) Title of Invention [R–24]

Where the title of the invention is not specific to the invention as claimed, see § 606.01.

1302.04(b) Cancellation of Non-Statutory Claim [R–17]

When a case is otherwise in condition for allowance the examiner may cancel an obviously non-statutory claim such as one to "A device substantially as shown and described." Applicant should be notified of the cancellation of the claim by an examiner's amendment.

1302.04(c) Cancellation of Claims to Non-Elected Invention [R–24]

See §§ 821.01 and 821.02.

1302.04(d) Cancellation of Claim Lost in Interference [R–24]

See § 1109.02.

1302.04(e) Cancellation of Rejected Claims Following Appeal [R–24]

See §§ 1214.06, 1215.03, and 1215.04.

1302.04(f) Data of Copending Application Referred to Should Be Brought Up to Date [R–41]

Where a patent application which is ready for issue refers by serial number to a U.S. application which has matured into a patent, the examiner is authorized to enter the patent number without a formal examiner's amendment. This entry should be in the following form: "now Patent No. ____." Where a referred to patent application has been published as a Defensive Publication, the examiner should enter "now Defensive Publication No. T——, ——" following the serial number. This entry is to be initialed and dated in the margin by the examiner to fix responsibility for the same. The entry and the initials should be in red ink.

If the application referred to has become abandoned, the entry "and now abandoned" should be made in red ink, and initialed and dated by the examiner in the margin. A formal examiner's amendment is not required.

1302.04(g) Identification of Claims [R–17]

To identify a claim, a formal examiner's amendment should refer to it by the original number and, if renumbered in the allowed application, also by the new number.

1302.05 Correction of Drawing [R–24]

Where a case otherwise ready for issue requires correction of the drawing, the examiner, before sending the file to the Draftsman, should attach thereto a slip indicating that the case is ready for allowance. Slight defects may be corrected on the examiner's initiative as set forth in § 608.02(w) and a formal examiner's amendment prepared.

Correction of some slight defects may be obviated, see § 608.02—"Waiving of Corrections".

1302.06 Prior Foreign Application

See §§ 201.14(c) and 202.03.

1302.07 Use of Retention Labels To Preserve Abandoned Companion Applications [R–41]

Related applications referred to in patent specifications are preserved from destruction by a retention label (Form PO–150) which is attached to the outside of the file wrapper. The final review clerk of the group prepares such a label for use as indicated below on each application (which has not become a patent) which is referred to in the specification or oath or declaration of the application ready for allowance (or in any Office letter therein).

If the case referred to is

Still pending:

Fill in and paste label on the face of the pending file wrapper in the space provided. Make no change in specification of the allowable application.

Abandoned for failure to pay issue fee:

If file has been forwarded to abandoned files, fill in label and send it to Abandoned Files Unit for attachment to the wrapper. If not forwarded, treat the same as pending case. If the period for filing a petition for delayed payment has expired, "now abandoned" by red ink and initialing to the allowable application. If period has not expired, make no change in specification of the allowable application.

Abandoned:

If file has been forwarded fill in label and send it to Abandoned Files Unit for attachment to the wrapper. If not forwarded treat the same as pending case. Add "now abandoned" by red ink and initialing to the allowable application.

Already patented:

No label is required. Insert patent number in specification if not already present. Formal examiner's amendment not necessary if this is only change.

In issue:

Fill in label. Make no change in the specification of the allowable application. Clip the label to the serial register card of the case in issue. If case in issue is abandoned or is withdrawn from issue, it is returned to the group, where the serial register card is pulled. The label is attached at this time. If case in issue is patented, the label is destroyed when the card is pulled.

Examiners are reminded that only one retention label is necessary. Thus, if a retention label is already present, it is sufficient to merely add "et al." to the serial number cited thereon.

1302.08 Interference Search [R–24]

Assuming that the case is found ready for issue, the examiner makes an "interference search" and notes the date and class and subclasses searched in the file wrapper. To do this, he inspects all the pending prints and drawings (or all the digests if the invention is not susceptible of illustration) in the relevant subclasses of the class in which the application is classified, and all other pertinent classes, whether in his group or elsewhere, in order to ascertain whether any other applicant is claiming substantially the same subject matter as is being allowed in the case in hand. When any of the drawings or digests shows such a condition to be likely, he examines the corresponding file.

If the search does not disclose any interfering application, the examiner should prepare the case for issue.

1302.09 Notations on File Wrapper [R–41]

The examiner preparing the application for issue fills out, in black ink, the appropriate spaces on the face of the file wrapper.

To aid the Patent Issue Division and the printers, examiners should write the class and subclass on the outside of the file wrapper as carefully and legibly as possible. Each numeral should be distinct and any decimal point should be shown clearly and in its proper position.

Spaces are provided on the file wrapper for identifying data of a prior abandoned application for which the instant application is a Substitute, and for the parent application(s) and prior foreign application(s).

The class and subclass and the name of the examiner which are written in pencil on the file wrapper should correspond to the class and subclass in which the patent will issue and to the name of the examiner preparing the application for issue.

See § 202.02 for notation as to parent or prior U.S. application to be placed on file wrapper.

See § 202.03 for notation as to foreign patent application to be placed on file wrapper.

See § 1302.13 for name of examiner.

From January 1, 1968 to September 24, 1974, if an issuing application contained an abstract, the abstract was published in the Official Gazette instead of a claim. After October 1, 1974, claims appear in the Official Gazette.

Examiners, when preparing an application for issue, are to record the number of the claim selected for printing in the Official Gazette in the box labeled "PRINT CLAIM(S):" which has been stamped on the inside left flap of the file wrapper above the "Index of Claims".

The claim or claims should be selected in accordance with the following instructions:

1. The broadest claim should be selected.
2. Examiners should ordinarily designate but one claim on each invention, although when a plurality of inventions are claimed in an application, additional claims up to a maximum of five may be designated for publication.
3. A dependent claim should not be selected unless the independent claim on which it depends is also printed.
4. In reissue applications, the broadest claim with changes or the broadest additional reissue claim should be selected for printing.

When recording this information in the box provided, the following items should be kept in mind:

1. Write the claim number clearly in black ink.
2. If multiple claims are selected, the claim numbers should be separated by commas.
3. The claim designated must be referred to by using the renumbered patent claim number rather than the original application claim number.

1302.10 Notations on Drawings and on Classification (Issue) Slip [R–24]

The class and subclass and the name of the assistant examiner which have been written in pencil in the upper lefthand corner of the drawing should not be erased. See § 717.03.

On the margin of the first sheet of drawing, the examiner indicates in black ink in the spaces provided by the Draftsman's stamp the figure which he selects for printing in the Official Gazette and also the final official classification of the case. Ordinarily a single figure is selected for printing. This figure should be consistent with the portion of the application to be printed in the Official Gazette. The numerals should fill as much of the space provided as feasible.

If the selected figure is not on the first sheet, the examiner should indicate it also on the sheet where it does appear. If there is no figure illustrative of or helpful in understanding the claimed invention, no figure need be selected. "None" may be written after "O.G. Fig." If, through inadvertence, the stamped legend for O.G. Fig. and class and subclass appears within the margin of the drawing, the examiner, should make the notations *outside* of the margins.

The only date entered on the front of the drawings is the date of mailing of the Notice of Allowance, which is done by the Patent Issue Division. Under current practice, the clerk of the examining group does NOT enter any date when the case is "sent to issue". See §§ 903.07, 903.07(b) and 903.09 for notation to be applied to the Issue Classification Slip (Form PO–270).

In all reissue applications, a horizontal line should be drawn through the middle of the "NAME" box. The applicant's name should be placed in the upper portion of the box and the number of the original patent which is being reissued should be placed in the lower portion of the box.

To ensure that both copies of the slip do not become separated from the file, examiners should affix the entire unit set to the inside left flap of the file wrapper by stapling it at the upper right hand corner, using one staple only in the space marked "cross references". It is not necessary to remove the carbon paper.

The Allowed Files Unit of the Patent Issue Division remove the original for use by Machine Operations Branch and leave the carbon copy in the file for use by the printer.

1302.11 Reference to Assignment Division [R–41]

The practice of referring certain applications to the Assignment Division when passing them to issue is no longer followed. See § 303.

1302.12 Listing of References [R–41]

All references which have been cited during the prosecution, including those appearing in Board of Appeals decisions, and those submitted by applicant if they conform to the requirements set forth in §§ 707.05(b) or 708.02, will be printed in the patent.

At time of allowance, the examiner may cite pertinent art in an examiner's amendment. Such pertinent art should be listed as usual on form PO–892, a copy of which is attached to the examiner's amendment form POL–37. Such pertinent art is not sent to the applicant. Such citation of art is important in the case of continuing applications where significant prior art is often of record in the parent case. In the rare instance where no art is cited in a continuation application, all the references cited during the prosecution of the parent application will be listed at allowance for printing in the patent. See §§ 707.05 and 707.05(a).

When preparing an application for allowance, the "final review" clerk will verify that there is at least one list of references (PO–892) in the application. All lists of references are maintained in the center section of the file wrapper.

In the first action after termination of an interference, the examiner should make of record in each application all references not already of record which were pertinent to any motions to dissolve and which were discussed in the decision on motion.

In any case, otherwise ready for issue, in which the erroneous citation has not been formally corrected in an official paper, the examiner is directed to correct the citation by an examiner's amendment. See § 707.05(g).

Any new reference cited when the case is in issue, under the practice of § 1308.01, should be added by way of a PO–892.

All copies of references placed in the file wrapper during prosecution, should be retained therein, when the allowed application forwarded to the Office of Quality Review.

1302.13 Signing [R–18]

The primary examiner and the assistant examiner involved in the allowance of an application will print or stamp their names on the file wrapper in place of their signatures. Each examiner shall place his initials after his printed or stamped name. A primary examiner who prepares an application for issue himself prints or stamps his name and initials the file wrapper *only* in the "Primary Examiner" space. A line should be drawn through the "Assistant Examiner" box to make it clear that the absence of a name in the box was not an oversight.

Only the names of the primary examiner and the assistant examiner appearing on the face of the application file wrapper will be listed in the printed patent.

1303 Notice of Allowance [R–41]

Rule 311. Notice of allowance. If, on examination, it shall appear that the applicant is entitled to a patent under the law, a notice of allowance will be sent to him, his attorney or his agent, calling for the payment of a specified sum constituting the issue fee or a portion thereof, which shall be paid within three months from the date of the notice of allowance.

The appropriate form of notice of allowance is prepared and mailed, and the mailing date appearing thereon is stamped on the file wrapper by the Patent Issue Division.

1303.01 Amendment Received After Allowance [R–24]

If the amendment is filed under rule 312, see §§ 714.15 to 714.16(e). If the amendment contains claims copied from a patent, see § 1101.02(g).

1303.02 Undelivered [R–24]

In case a notice of allowance is returned, and a new notice is sent (see § 707.13), the date of sending the notice must be changed in the file to agree with the date of such remailing.

1303.03 Not Withheld Due to Death of Inventor [R–24]

The notice of allowance will not be withheld due to death of the inventor if the executor or administrator has not intervened. See § 409.01(f).

1304 Withholding From Issue of "Secrecy Order" Cases [R–24]

"Secrecy Order" cases are not sent to issue even when all of the claims have been allowed. Instead of mailing an ordinary notice of allowance a D–10 Notice is sent. See § 107.02.

If the "Secrecy Order" in a case is with-

drawn after the D–10 notice is mailed, the case should then be treated like an ordinary application in condition for allowance.

1304.01 Amendments After D–10 Notice [R–24]

For amendments received after D–10 Notice, see § 107.02.

1305 Jurisdiction [R–41]

Jurisdiction of the application remains with the primary examiner until the notice of allowance is mailed by the Patent Issue Division. However, the examiner may make examiner's amendments correcting obvious errors, as, when brought to the attention of the examiner by the printer, and also may admit amendments under rule 312 which are confined to matters of form in specification or claims, or to the cancellation of a claim or claims. The examiner's action on other amendments under rule 312 consists of a recommendation to the Commissioner.

To regain jurisdiction over the case, the examiner must write a letter to the Commissioner requesting it. See §§ 1112.04, 1308, and 1308.02.

Once the patent has been granted, the Patent Office can take no action concerning it except as provided in 35 U.S.C. 135 and 35 U.S.C. 251 through 256. See chapter 1400.

1306 Issue Fee [R–43]

35 U.S.C. 41 (a) 2. For issuing each original or reissue patent, except in design cases, $100; in addition, $10 for each page (or portion thereof) of specification as printed, and $2 for each sheet of drawing.

35 U.S.C. 151. If it appears that applicant is entitled to a patent under the law, a written notice of allowance of the application shall be given or mailed to the applicant. The notice shall specify a sum, constituting the issue fee or a portion thereof, which shall be paid within three months thereafter.

Upon payment of this sum the patent shall issue, but if payment is not timely made, the application shall be regarded as abandoned.

Any remaining balance of the issue fee shall be paid within three months from the sending of a notice thereof, and, if not paid, the patent shall lapse at the termination of this three-month period. In calculating the amount of a remaining balance, charges for a page or less may be disregarded.

If any payment required by this section is not timely made, but is submitted with the fee for delayed payment and the delay in payment is shown to have been unavoidable, it may be accepted by the Commissioner as though no abandonment or lapse had ever occurred.

Rule 314. Issuance of patent. If payment of the issue fee or that portion thereof specified in the notice of allowance is timely made, the patent will issue in regular course.

The Office has discontinued the practice of estimating the number of printed pages of specification in advance of printing. Instead, a Base Issue Fee is due three months from the date of the Notice of Allowance. The amount of the Base Issue Fee is shown on the Notice of Allowance and consists of $100 plus $10 for the first page of printed specification plus $2 for each sheet of drawing.

The Office calculates the balance of issue fee due, after payment of the Base Issue Fee specified by the Notice of Allowance, at the rate of $10 a page, as provided in 35 U.S.C. 41, for each printed page of specification (including claims) for which payment has not previously been received. As the Base Issue Fee includes a $10 charge for one printed page of specification, a Balance of Issue Fee is due for each patent which consists of more than one printed page. A "page" consists of one side of a printed sheet containing any amount of specification (including claims). A notification of the Balance of Issue Fee Due is mailed in each such case along with the original patent grant.

Applicants and their attorneys or agents are urged to use the special fee transmittal forms provided with the Notice of Allowance and the Notice of Balance of Issue Fee Due when submitting their payments.

The payment of the balance of issue fee due may be simplified by using a Patent and Trademark Office Deposit Account for such a fee. A statement, in duplicate, at the time of payment of the minimum issue fee, indicating that applicant's or attorney's Deposit Account may be billed for the balance of the issue fee will be considered as sufficient authorization to make such a payment.

The above mentioned fees will not be accepted from anyone other than the applicant, attorney, agent or a party in interest as shown by the records of the Office.

1307 Change in Classification of Cases Which Are in Issue [R–24]

See § 903.07

1308 Withdrawal From Issue [R–36]

Rule 313. Withdrawal from issue. (a) After the notice of allowance of an application is sent, the case will not be withdrawn from issue except by approval of the Commissioner, and if withdrawn for further action on the part of the Office, a new notice of allowance will be sent if the application is again allowed.

(b) When the issue fee or that portion thereof specified in the notice of allowance has been paid, and the patent to be issued has received its date and number, the application will not be withdrawn from issue on account of any mistake or change of purpose of the applicant, his attorney or his agent, nor for the purpose of enabling the inventor to procure a foreign patent, nor for any other reasons except mistake on the part of the Office, or because of fraud or illegality in the application, or for interference.

If the applicant wishes to have the case withdrawn from issue, he must petition the Commissioner. Withdrawal is permitted only for the reasons stated in the rule. For withdrawal procedure by examiner see § 1308.02.

1308.01 Rejection After Allowance [R–36]

A claim noted as allowable shall thereafter be rejected only with the approval of the primary examiner. Great care should be exercised in authorizing such rejection. See § 706.04.

When a new reference is discovered, which obviously is applicable to one or more of the allowed claims in an application in issue, and where a sufficient portion of the statutory period for payment of the issue fee remains, the examiner is authorized to enter a letter inform-

ing applicant of the proposal of requesting withdrawal from issue for the purpose of rejecting the claim or claims as fully met by, or obviously unpatentable over the new reference. The letter should apply the reference in detail and should also set a time limit (within such statutory period), within which applicant may respond by way of argument or amendment under rule 312 to overcome the reference and avoid the necessity for withdrawal from issue. Such a letter, with the reference and file, should be submitted to the group director before mailing. After the letter is mailed, the file wrapper should be retained by the examiner to prevent inadvertent issuance of the patent.

If insufficient time remains to carry out the above, or if no response is received, or if a response is filed and it fails to overcome the reference, or if the above appears fruitless, a letter is addressed to the group director, requesting that the application be withdrawn from issue for the purpose of applying the new reference. This letter should cite the reference, and, if need be, briefly state its application. The letter should be submitted with the reference and the file wrapper. Upon approval of this request, the letter is taken to the Patent Issue Division and the application is stamped "Withdrawn" over the name stamp and initials of the primary examiner. It is then returned to the group from which it came; the withdrawal from the issue is entered on the register, and the application is thus restored to its former status as a pending application awaiting action by the examiner. The examiner at once writes a letter in the case stating that the application has been withdrawn from issue, citing the new reference, and rejecting the claims met thereby.

The letter is given a paper number and placed in the file.

If the examiner's proposed action is not approved, the letter requesting withdrawal from issue should not be placed in the file.

1308.02 For Interference Purposes [R–22]

It may be necessary to withdraw a case from issue for reasons connected with an interference. For the procedure to be followed see §§ 1101.01(o) and 1112.04.

1308.03 Quality Review Program for Examined Patent Applications [R–41]

A new Quality Review Program was instituted in the Office on April 1, 1974.

The purpose of the program is to evaluate the quality of the product of the patent examining process and to assist in determining where substantive and procedural adjustments in the patent examination process are appropriate.

The program involves randomly selecting a sample of allowed applications from each of the Art Units in the Patent Examining Corps before the applications are forwarded to the Patent Issue Division for Mailing of the "Notice of Allowance." The quality review will be concerned with three major aspects of the patent examining process, namely:

(1) patentability of the allowed claims in view of the prior art of record or other reasons determined by the reviewer;
(2) compliance with current examining practices and procedures; and
(3) correctness of the field of search and the classification of each application.

The quality review program also provides for the re-search of some of the allowed applications in the sample.

If, during the quality review process, it is determined that one or more claims of a reviewed application are clearly unpatentable, the prosecution of the application will be reopened. Only those applications wherein the prosecution has been reopened will reflect in the record that a quality review has taken place.

1309 Issue of Patent [R–43]

The files of allowed cases (not patented files) are kept in the Patent Issue Division, arranged in the serial number order. When the Issue fee is paid within the time allowed by law, the file is given a patent number and date, after which it is sent for printing of the specification. A bond paper copy of the drawing and specification is ribboned and sealed in the Patent Issue Division and finally signed.

Patent Printing Priority

The applications placed in the weekly formulation of an issue set aside for printing will be selected according to the following priorities:

1. Allowed cases which were made special by the Commissioner (including those under the Special Examining Procedure).
2. Allowed cases that have a U.S. effective filing date more than five years old.
3. Allowed reissue applications.
4. Allowed applications having an effective filing date earlier than that required for declaring an interference with a copending application claiming the same subject matter.
5. Allowed application of a party involved in a terminated interference.

6. Allowed applications in which the applicant has filed a request in the nature of a petition setting forth his reasons for advancing the printing date.
7. Allowed applications ready for printing and not covered by any of the six preceding categories. The selection of cases in the involved category will be by chronological sequence based on the date the issue fee was paid.

To ensure that any application falling within the scope of the categories outlined above and identified by numbers 1 to 5 receives special treatment the examiners should staple on the file wrapper a tag entitled "Special in Patent Issue Division." The special tag, PO–1101, may be obtained from the group clerk. The examiner shall print directly on the tag the recitation "In Patent Issue Division" and the appropriate printing category outlined above. The application is then forwarded to Patent Issue Division.

The personnel in Patent Issue Division will then set the tagged cases aside and make a notation on all copies of the Notice of Allowance to be mailed that further processing of this application will be "special."

In cases falling in category No. 6, the request must be filed after the Notice of Allowance has been received and no later than the date the issue fee is paid. The request must be directed to the Head of the Patent Issue Division.

→ *35 U.S.C. 2. Seal.* The Patent and Trademark Office shall have a seal with which letters patent, certificates of trademark registrations, and papers issued from the Office shall be authenticated.

35 U.S.C. 153. How issued. Patents shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Commissioner or have his signature placed thereon and attested by an officer of the Patent and Trademark Office designated by the Commissioner, and shall be recorded in the Patent and Trademark Office.

35 U.S.C. 154. Contents and term of patent. Every patent shall contain a short title of the invention and a grant to the patentee, his heirs or assigns, for the term of seventeen years, subject to the payment of issue fees as provided for in this title, of the right to exclude others from making, using, or selling the invention throughout the United States, referring to the specification for the particulars thereof. A copy of the specification and drawings shall be annexed to the patent and be a part thereof.

Printing Practitioners' Names on Patents

→ The Office has adopted the following procedure for printing a firm name, the names of up to three registered patent practitioners, or no practitioner's name on the patent.

The Notice of Allowance form, POL–85, has been redesigned in part to provide a space on POL–85*b*, the Base Issue Fee Transmittal form, for the person submitting the base issue fee to indicate, for printing, the names of up to three registered patent attorneys and agents or, alternatively, the name of a single firm which has as a member at least one registered patent attorney or agent. If the person submitting the base issue fee desires that no practitioner's name be printed on the patent, the space provided on the revised Base Issue Fee Transmittal form should be left blank. If no name is given, no name will be printed.

This procedure is intended to solve various problems encountered since the practice of recognizing firms was discontinued. While some slight additional effort on the part of the attorney or agent is thus involved if he desires to have a printed entry on the patent, the following advantages are provided by the new procedure: (1) it permits printing firm names on patents even though firms are no longer registered with or recognized by the Office in new applications; (2) it allows the names of those individuals who actually performed the work of preparing and prosecuting the application to appear on the printed patent; and (3) it grants an attorney or agent the option of not having his name appear on the printed patent.

Assignment Printed on Patent

The Issue Fee Transmittal Form portion (POL–85b) of the Notice of Allowance as revised in December 1969 and May 1973, provides a space (item 2) for assignment data which should be completed in order to comply with rule 334 (37 CFR 1.334). Unless an assignee's name and address are identified in item 2 of the Issue Fee Transmittal Form POL–85b, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for correction of error arising from incomplete or erroneous information furnished in item 2 of POL–85b will not be granted as a matter of course and will be subject to adherence to all the requirements of rule 323 (37 CFR 1.323).

Various officials including the head of the Patent Issue Division have been designated as attesting officer to attest to the name of the Commissioner. The assistant head of the Patent Issue Division acts as attesting officer in the absence or unavailability of the head of the Division.

1309.01 "Printer Waiting" Cases [R–43]

When the printer finds an apparent error in an application, the file is returned to the Office with an attached "Printer Waiting" slip noting the supposed error.

The Patent Issue Division forwards such "printer waiting" applications to the Office of Quality Review (OQR) at periodic intervals throughout each working day. The applications are recorded in OQR for control purposes and then hand carried by a messenger from OQR with a control list to the group director's secretary. The secretary acts as a control center in each examining group and forwards the applications to the examiner by the appropriate route. The application should be taken up and acted on immediately and returned to the group director's secretary within 24 hours (excluding weekends and holidays). Either necessary corrective action should be taken or an indication should be made that the application is considered to be correct as it stands.

If the examiner concurs in the criticisms, the errors should, if possible, be corrected in clean red ink and initialed or be corrected by examiners' amendment. See § 1302.04.

If the required correction cannot be cured by examiner's amendment, the application may have to be withdrawn from issue. This may sometimes be avoided if the attorney or his representative is telephoned immediately, and the error is corrected by amendment under rule 312.

The applications are picked up from the secretary's office by the messenger from OQR and returned to OQR for processing and then returned to the Patent Issue Division for forwarding to the printer. THESE APPLICATIONS SHOULD NOT BE MAILED TO THE PATENT ISSUE DIVISION OR TO THE OQR.

1309.02 Protest Against Issue [R–36]

Rule 291. Protests to the grant of a patent. The patent statutes do not provide for opposition to the grant of a patent on the part of the public. Protests to the grant of a patent are ordinarily merely acknowledged, and filed after being referred to the examiner having charge of the subject matter involved for his information.

A party properly obtaining a knowledge of an application pending in the Office may file a protest against the issue of a patent upon it and may therein call attention to any facts within his knowledge which, in his opinion, would make the grant of a patent improper. He does not, however, thereby obtain the right to argue the question before the tribunals of the Office. The question of patentability has been uniformly looked upon as ex parte in character. It is a question between the applicant and the Office on behalf of the public, and no one member of the public can be recognized as having such an interest in the grant of a patent as to entitle him to contest the matter any further than to call attention to matters which he considers bars. The Office will consider facts called to its attention, but will not give the protestant a hearing as a matter of right. Carey v. The New Home Sewing Machine Co., 1901 C.D. 165; 97 O.G. 1171.

When a protest is filed against the issuance of a patent the same shall, after consideration by the examiner, be forwarded to the group director and shall not be entered in the file of the application to which it refers.

Chapter 1400 Correction of Patents

1401 **Reissue**
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1402 **Certificate of Correction—Office Mistake**
1402.01 Applicant's Mistake
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1403 **Statutory Disclaimer**

Errors in a patent may be corrected in three ways, namely by reissue, by the issuance of a certificate of correction which becomes a part of the patent, and by disclaimer.

1401 Reissue [R–41]

35 U.S.C. 251. Reissue of defective patents. Whenever any patent is, through error without any deceptive intention, deemed wholly or partly inoperative or invalid, by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than he had a right to claim in the patent, the Commissioner shall, on the surrender of such patent and the payment of the fee required by law, reissue the patent for the invention disclosed in the original patent, and in accordance with a new and amended application, for the unexpired part of the term of the original patent. No new matter shall be introduced into the application for reissue.

The Commissioner may issue several reissued patents for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for a reissue for each of such reissued patents.

The provisions of this title relating to applications for patent shall be applicable to applications for reissue of a patent, except that application for reissue may be made and sworn to by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

No reissued patent shall be granted enlarging the scope of the claims of the original patent unless applied for within two years from the grant of the original patent.

The usual grounds for a reissue are that the claims are too narrow or too broad, or that the disclosure has inaccuracies. A reissue was granted in Brenner v. State of Israel, 862 O.G. 661; 158 USPQ 584, where the only ground urged was failure to file a certified copy of the original foreign application to obtain the right of foreign priority under 35 U.S.C. 119 before the patent was granted. The correction of misjoinder of inventors was held to be a ground for reissue in Ex parte Scudder, 169 USPQ 814.

When a reissue application is filed within two years from the date of the original patent, a rejection on the ground of lack of diligence or delay in filing the reissue should not be made.

A "claim" for the benefit of an earlier filing date in a foreign country under 35 U.S.C. 119 must be made in a reissue application even though such a claim was made in the application on which the original patent was granted. However, no additional certified copy of the foreign application is necessary. The procedure is similar to that for "Continuing Applications" in § 201.14(b).

The heading on printed copies will not be carried forward to the reissue from the original patent. Therefore, it is important that the file wrapper be endorsed under "Claims Foreign Priority."

The applicant is permitted to present every claim that was issued in the original patent for a fee of 65 dollars. Additional claims must be paid for in the same manner as claims must be paid for in original applications.

1401.01 Requisites

Rule 171. Application for reissue. An application for reissue must contain the same parts required for an application for an original patent, complying with all the rules relating thereto except as otherwise provided, and in addition, must comply with the requirements of the rules relating to reissue applications. The application must be accompanied by a certified copy of an abstract of title or an order for a title report, to be placed in the file, and by an offer to surrender the original patent (rule 178).

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1401.02 By Whom Filed and to Whom Granted [R–25]

Rule 172. Applicants, assignees. (a) Reissue applications must be signed and sworn to, or declaration made, by the inventors except as otherwise provided (see rules 42, 43, 47), and must be accompanied by the written assent of all assignees, if any, owning an undivided interest in the patent, but a reissue application may be made and sworn to or declaration made by the assignee of the entire interest if the application does not seek to enlarge the scope of the claims of the original patent.

(b) A reissue will be granted to the original patentee, his legal representatives or assigns as the interest may appear.

The examiner must inspect the abstract of title to determine whether rule 172 has been complied with.

1401.03 Notice in Original File [R–34]

Rule 179. Notice of reissue application. When an application for a reissue is filed, there will be placed in the file of the original patent a notice stating that an application for reissue has been filed. When the reissue is granted or the reissue application is otherwise terminated, the fact will be added to the notice in the file of the original patent.

The notice is entered on the file wrapper of the original patent and pertinent data filled in by the Application Division. When the reissue is granted or the prosecution of the reissue application is terminated, it is important that the Record Room be informed of that fact by written memo and the information is applied by the Record Room on the notice in the patented file.

1401.04 Offer To Surrender Original Patent and When Such Patent Is Returned [R–34]

Rule 178. Original patent. The application for a reissue must be accompanied by an offer to surrender the original patent. The application should also be accompanied by the original patent, or if the original is lost or inaccessible, by an affidavit or declaration to that effect. The application may be accepted for examination in the absence of the original patent or the affidavit or declaration, but one or the other must be supplied before the case is allowed. If a reissue be refused, the original patent will be returned to applicant upon his request.

The examination of the reissue application on the merits is made even though the offer to surrender the original patent or an affidavit or declaration to the effect that the original is lost or inaccessible has not been received, but in such case the examiner should require one of them in the first action.

If applicant requests the return of his patent, on abandonment of the reissue application, it will be sent to him by the Mail and Correspondence Division and not by the examining group.

1401.05 Use of Original Drawing [R–37]

Rule 174. Drawings. (a) The drawings upon which the original patent was issued may be used in reissue applications if no changes whatsoever are to be made in the drawings. In such cases, when the reissue application is filed, the applicant must submit a temporary drawing which may consist of a copy of the printed drawings of the patent or a photoprint of the original drawings securely mounted by pasting on sheets of drawing board of the size required for original drawing, or an order for the same.

(b) Amendments which can be made in a reissue drawing, that is, changes from the drawing of the patent, are restricted.

Applicant must submit a mounted copy of the original drawing or "an order for same" (rule 174) if transfer of the original drawing is contemplated.

Provided that no alteration whatsoever is to be made in the drawings, including canceling an entire sheet, the drawings of the original patent may be used in lieu of new drawings.

The mounted copy of the drawing will be marked "Informal, AFE" (Admitted for Examination) by the Draftsman, but the examiner should disregard this since the informality will be corrected by formal transfer of the drawing before final allowance.

When the reissue case is ready for allowance the examining group makes the formal transfer of the original drawing to the reissue case. See § 608.02(k).

1401.06 Form of Specification and Claims [R–22]

Rule 173. Specification. The specification of the reissue application must include the entire specification and claims of the patent, with the matter to be omitted by reissue enclosed in square brackets; and any additions made by the reissue must be underlined, so that the old and the new specifications and claims may be readily compared. Claims should not be renumbered and the numbering of claims added by reissue should follow the number of the highest numbered patent claim. No new matter shall be introduced into the specification.

Cut up soft copies of the original patent, with each COLUMN securely mounted on a separate sheet may be used in preparing the specification and claims. It should be noted

that *amendments* to the reissue applications should not be prepared in this way. In reissue applications, both the descriptive portion and the claims must be amended as specified in rule 121(a). Note rule 121(e).

An example of the form for a twice-reissued patent is found in Re. 23,558.

1401.07 New Matter [R–25]

New matter, that is, matter not present in the patent, is excluded from a reissue application with even greater strictness than in an ordinary case. The claims in the reissue case must also be for matter which the applicant had the right to claim in the original patent. New matter may exist by virtue of the omission of a feature or of a step in a method. See United States Industrial Chemicals, Inc. v. Carbide & Carbon Chemicals Corp. 1942 C.D. 751; 315 U.S. 668; 53 USPQ 6.

1401.08 The Reissue Oath or Declaration of [R–40]

Rule 175. Reissue oath or declaration. (a) Applicants for reissue, in addition to complying with the requirements of the first sentence of rule 65, must also file with their applications a statement under oath or declaration as follows:

(1) That applicant verily believes the original patent to be wholly or partly inoperative or invalid, and the reasons why.

(2) When it is claimed that such patent is so inoperative or invalid "by reason of a defective specification or drawing," particularly specifying such defects.

(3) When it is claimed that such patent is inoperative or invalid "by reason of the patentee claiming more or less than he had a right to claim in the patent," distinctly specifying the excess or insufficiency in the claims.

(4) Particularly specifying the errors relied upon, and how they arose or occurred.

(5) That said errors arose "without any deceptive intention" on the part of the applicant.

(b) Corroborating affidavits or declarations of others may be filed and the examiner may, in any case, require additional information or affidavits or declarations concerning the application for reissue and its object.

The question of the sufficiency of the reissue oath or declaration filed under rule 175 must in each case be reviewed and decided personally by the primary examiner.

The reissue oath or declaration must point out very specifically what the defects are and how the errors arose. The statements of the oath or declaration must be of facts and not conclusions.

An allegation that the specification is insufficient merely because the claims are too narrow ordinarily satisfies paragraph (a)(3) of the rule.

A broadened reissue claim is one which brings within its scope any subject matter not embraced by the patent claims. A claim broadened in one limitation is a broadened claim though it may be narrower in other details. Fox Typewriter Co. v. Corona Typewriter Co., 282 F. 502 In re Bostwick, 26 CCPA 1117, 102 F. 2d 886, 41 USPQ 279; Schenk et al. v. United Aircraft Corp., 43 F. Supp. 679, 51 USPQ 519; and Mercoid Corp. v. Milwaukee Gas Specialty Co., 33 F. Supp. 681, 46 USPQ 23; and In re Rogoff, 120 USPQ 185 (CCPA 1958).

Relative to paragraph (a)(4) of the rule, deliberate cancellation of a claim in the original patent application is ordinarily regarded as evidence that the failure to include claims to the involved subject matter in the patent is not due to error. The patent statutes afford no authority for the reissue of a patent merely to add other claims of the same scope as those already granted, In re Wittry, 180 USPQ 320 (CCPA 1974). An error arising from a lack of understanding or knowledge of applicant's attorney as to the real invention may be an acceptable reason for reissue. However, where an alleged lack of understanding by applicant or his attorney is based on a new factual situation, which did not exist at the time the patent was taken out, reissue is improper.

Where the reissue oath or declaration is found insufficient, all new claims in the reissue application to which the insufficiency applies should be rejected on the basis that the reissue oath or declaration is insufficient, In re Wittry, 180 USPQ 320 (CCPA 1974).

1401.09 Examination of Reissue

Rule 176. Examination of reissue. An original claim, if re-presented in the reissue application, is subject to reexamination, and the entire application will be examined in the same manner as original applications, subject to the rules relating thereto, excepting that division will not be required. Applications for reissue will be acted on by the examiner in advance of other applications.

Reissue cases are "special" and remain "special" even though applicant does not respond promptly.

Examination of a reissue application involves two aspects, first, it is examined in the same manner as an original application and second, it must be examined for compliance with the reissue statute and rules. The prosecution of the original patent must be carefully studied for its bearing on the reissue questions.

While an original claim is subject to reexamination, the rejection of such a claim constitutes the rejection of a previously allowed claim and must be personally considered by the primary examiner with great care. To be

effective, a reference must be prior to the effective filing date of the original patent.

1401.09(a) Adjudication of Original Patent [R–31]

When a reissue application is filed, the examiner should determine whether the original patent has been adjudicated by a court. The decision of the court and also other papers in the suit may give information essential to the examination of the reissue. The patented file will contain notices of the filing and termination of infringement suits on the patent, which notices are required by law to be filed by the clerks of the District Courts. These notices do not indicate if there was an opinion by the court, nor whether a decision was published. Shepard's Federal Citations and the cumulative digests of the United States Patents Quarterly, both of which are in the Law Library, contain tables of patent numbers giving the citation of published decisions concerning the patent. Where papers are not otherwise conveniently obtainable, the applicant may be requested to supply or lend copies of papers and records in suits, or the Office of the Solicitor may be requested to obtain them from the court. The information thus obtained should be carefully considered for its bearing on the proposed claims of the reissue, particularly when the reissue application was made in view of the holding of a court.

1401.10 Restriction and Election of Species [R–22]

The examiner may not require restriction in a reissue application (rule 176 in § 1401.09). If the original patent contains claims to different inventions which the examiner may nevertheless consider independent and distinct, and the reissue application also claims the same inventions, the examiner should not require restriction between them or take any other action with respect to the question of plural inventions. Restriction is entirely at the option, in the first instance, of the applicant. If the reissue application contains claims to an independent and distinct invention which was not claimed in the original patent, these claims may be treated by a suitable rejection, such as: lack of inoperativeness of, or defect in, the original patent; lack of error; or not being for matter which might have been claimed in the original patent.

When the original patent contains claims to a plurality of species and the reissue application contains claims to the same species, election of species should not be required even though there is no allowable generic claim. If the reissue application presents claims to species not claimed in the original patent, election of species should not be required, but the added claims may be rejected on an appropriate ground which may be lack of inoperativeness of, or defect in, the original patent and lack of error in obtaining the original patent. Most situations require special treatment.

1401.10(a) Divisional Reissue Applications [R–25]

As is pointed out in the preceding section the examiner cannot require restriction in reissue applications, and if the original patent contains several independent and distinct inventions they can only be granted in separate reissues if the applicant demands it. The following rule sets forth the only possibility of divisional reissue applications.

Rule 177. Reissue in divisions. The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant, and upon payment of the required fee for each division. Each division of a reissue constitutes the subject of a separate specification descriptive of the part or parts of the invention claimed in such division; and the drawing may represent only such part or parts, subject to the provisions of rules 83 and 84. On filing divisional reissued applications, they shall be referred to the Commissioner. Unless otherwise ordered by the Commissioner, all the divisions of a reissue will issue simultaneously; if there be any controversy as to one division, the others will be withheld from issue until the controversy is ended, unless the Commissioner shall otherwise order.

1401.11 Allowance and Issue [R–41]

In all reissue applications prepared for issue, a horizontal line should be drawn through the middle of the "NAME" box on the blue Issue Classification Slip. The applicant's name should be placed in the upper portion of the box and the number of the original patent being reissued should be placed in the lower portion of the box.

The specifications of reissue patents will be printed in such a manner as to show the changes over the original patent by printing material omitted by reissue enclosed in heavy brackets [ ] and material added by reissue in italics. Rule 173 (see § 1401.06) requires the specification of a reissue application to be presented in a specified form, specifically designed to facilitate this different manner of printing, as well as for other reasons.

The printed reissue specification will carry the following heading which will be added by the Patent Issue Division:

"Matter enclosed in heavy brackets [ ] appears in the original patent but forms no part

of this reissue specification; matter printed in italics indicates the additions made by reissue."

The examiners should see that the specification is in proper form for printing. Matter appearing in the original patent which is omitted by reissue should be enclosed in heavy brackets, while matter added by reissue should be underlined. All the claims of the patent should appear in the specification, with omitted claims enclosed in brackets. New claims should follow the number of the highest numbered patent claims and be underlined to indicate italics. The provisions of rule 173 that claims should not be renumbered applies to the reissue application as filed. When the reissue is allowed, any claims remaining which are additional to the patent claims are renumbered in sequence starting with the number next higher than the number of claims in the original patent. Therefore, the number of claims allowed will not

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necessarily correspond to the number of the last claim in the reissue application, as allowed.

In the case of reissue applications which have not been prepared in the indicated manner, the examiner may request from the applicant a clean copy of the reissue specification prepared in the indicated form. However, if the deletions from the original patent are small, the reissue application can be prepared for issue by putting the bracketed inserts at the appropriate places and suitably numbering the claims.

All parent application data on the original patent file wrapper should be placed on the reissue file wrapper, if it is still proper.

The list of references to be printed at the end of the reissue specification should include both the references cited during the original prosecution as well as the references cited during the prosecution of the reissue application.

NOTE.—Transfer of drawing, § 1401.05.

There is no issue fee for reissue applications in which the patent being reissued was granted prior to October 25, 1965. For reissue applications in which the patent being reissued was granted after October 25, 1965, the issue fee is set forth in 35 U.S.C. 41(a)2. [R–44]

1401.12 Reissue Filed While Patent Is in Interference [R–20]

If an application for reissue of a patent is filed while the patent is involved in interference, that application must be called to the attention of the Commissioner before any action by the examiner is taken thereon.

When an application for reissue of a patent is filed while the patent is involved in interference, a letter with titling relative to the interference is placed in the interference file and in the reissue application file, and a copy thereof is sent to each of the interfering parties, giving notice of the filing of the reissue application. See § 1111.08.

1402 Certificates of Correction—Office Mistake [R–44]

35 U.S.C. 254. Certificate of correction of Patent and Trademark Office mistake. Whenever a mistake in a patent, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office, the Commissioner may issue a certificate of correction stating the fact and nature of such mistake, under seal, without charge, to be recorded in the records of patents. A printed copy thereof shall be attached to each printed copy of the patent, and such certificate shall be considered as part of the original patent. Every such patent, together with such certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form. The Commissioner may issue a corrected patent without charge in lieu of and with like effect as a certificate of correction.

Rule 322. Certificate of correction of Office mistake.

(a) A certificate of correction under 35 U.S.C. 254, may be issued at the request of the patentee or his assignee. Such certificate will not be issued at the request or suggestion of anyone not owning an interest in the patent, nor on motion of the Office, without first notifying the patentee (including any assignee of record) and affording him an opportunity to be heard.

(b) If the nature of the mistake on the part of the Office is such that a certificate of correction is deemed inappropriate in form, the Commissioner may issue a corrected patent in lieu thereof as a more appropriate form for certificate of correction, without expense to the patentee.

Mistakes incurred through the fault of the Office are the subject of Certificates of Correction under rule 322. If such mistakes are of such a nature that the meaning intended is obvious from the context, the Office may decline to issue a certificate and merely place the correspondence in the patented file, where it serves to call attention to the matter in case any question as to it arises.

Letters which merely call attention to errors in patents, with a request that the letter be made of record in the patented file, will not be acknowledged. Unless notification to the contrary is received within thirty days, it may be assumed that such letters have been made of record as requested.

In order to expedite all proper requests, a Certificate of Correction should be requested only for errors of consequence. Letters making errors of record should be utilized whenever possible.

Each issue of the Official Gazette (patents section) numerically lists all United States patents having Certificates of Correction. The list appears under the heading "Certificates of Correction for the week of (date)."

1402.01 Applicant's Mistake [R–44]

35 U.S.C. 255. Certificate of correction of applicant's mistake. Whenever a mistake of a clerical or typographical nature, or of minor character, which was not the fault of the Patent and Trademark Office, appears in a patent and a showing has been made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issue a certificate of correction, if the correction does not involve

such changes in the patent as would constitute new matter or would require re-examination. Such patent, together with the certificate, shall have the same effect and operation in law on the trial of actions for causes thereafter arising as if the same had been originally issued in such corrected form.

Rule 323. Certificate of correction of applicant's mistake. Whenever a mistake of a clerical or typographical nature or of minor character which was not the fault of the Office, appears in a patent and a showing is made that such mistake occurred in good faith, the Commissioner may, upon payment of the required fee, issued a certificate of correction, if the correction does not involve such changes in the patent as would constitute new matter or would require reexamination.

Rule 323 relates to the issuance of Certificates of Correction for the correction of errors which were not the fault of the Office. A mistake is not of a minor character if the requested change would materially affect the scope or meaning of the patent.

The Issue Fee Transmittal Form portion (POL–85b) of the Notice of Allowance as revised in December 1969 and May 1973, provides a space (item 2) for assignment data which should be completed in order to comply with rule 334 (37 CFR 1.334). Unless an assignee's name and address are identified in item 2 of the Issue Fee Transmittal Form POL–85b, the patent will issue to the applicant. Assignment data printed on the patent will be based solely on the information so supplied.

A request for correction of error arising from incomplete or erroneous information furnished in item 2 of POL–85b will not be granted as a matter of course and will be subject to adherence to all the requirements of rule 323 (37 CFR 1.323).

35 U.S.C. 256. Misjoinder of inventor. Whenever a patent is issued on the application of persons as joint inventors and it appears that one of such persons was not in fact a joint inventor, and that he was included as a joint inventor by error and without any deceptive intention, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate deleting the name of the erroneously joined person from the patent.

Whenever a patent is issued and it appears that a person was a joint inventor, but was omitted by error and without deceptive intention on his part, the Commissioner may, on application of all the parties and assignees, with proof of the facts and such other requirements as may be imposed, issue a certificate adding his name to the patent as a joint inventor.

The misjoinder or nonjoinder of joint inventors shall not invalidate a patent, if such error can be corrected as provided in this section. The court before which such matter is called in question may order correction of the patent on notice and hearing of all parties concerned and the Commissioner shall issue a certificate accordingly.

Rule 324. Correction of error in joining inventor. Whenever a patent is issued and it appears that there was a misjoinder or non-joinder of inventors and that such misjoinder or omission occurred by error and without deceptive intention, the Commissioner may, on application of all the parties and the assignees and satisfactory proof of the facts, or on order of a court before which such matter is called in question, issue a certificate deleting the misjoined inventor from the patent or adding the non-joined inventor to the patent.

The "satisfactory proof of facts" required by rule 324 must be of the same type and character as the proof required to justify converting an application, as described in § 201.03. An oath or declaration of the type required by rule 65 corresponding to the newly asserted inventorship must be submitted, together with the original patent for attachment of the certificate.

1402.02 Handling of Requests for Certificates of Correction [R–44]

Requests for certificates of correction will be forwarded by the Correspondence and Mail Division, to the Solicitor's Office, where they will be listed in a permanent record book.

Determination as to whether an error has been made, the responsibility for the error, if any, and whether the error is of such a nature as to justify the issuance of a certificate of correction will be made by the Solicitor's office. If a report is necessary in making such determination, the case will be forwarded to the appropriate group with a request that the report be furnished. If no certificate is to issue, the party making the request is so notified by the Solicitor's Office, and the request, report, if any, and copy of the communication to the person making the request are placed in the file and entered thereon under "Contents" by the Solicitor's Office. The case is then returned to the patented files. If a certificate is to issue, it will be prepared and forwarded to the person making the request by the Patent Issue Division. In that case, the request, the report, if any, and a copy of the letter transmitting the certificate of correction to the person making the request will be placed in the file and entered thereon under "Contents".

Applicants, or their attorneys or agents, are urged to submit the text of the correction on a special Certificate of Correction Form, PO–1050, which can serve as the camera copy for use in direct offset printing of the certificate of correction. Both parts of form PO–1050 must

accompany the request since the second part will be placed in the application file for internal use.

A perforated space at the bottom of form PO–1050 has been provided for the patentee's current mailing address, and for ordering any desired additional copies of the printed certificate. The fee for each additional copy ordered is 30 cents per page. The fee should accompany the request.

To facilitate the use of the Form PO–1050, the public may obtain as many copies as needed from the Correspondence and Mail Division or from the receptionist in the lobby of building 3 at Crystal Plaza.

Where only a part of a request can be approved, or where the Office discovers and includes additional corrections, the appropriate alterations are made on the form PO–1050 by the Office. The patentee is notified of the changes on the Notification of Approval-in-part form POL–404. The certificate is issued approximately 6 weeks thereafter.

Form PO–1050 should be used exclusively regardless of the length or complexity of the subject matter. Intricate chemical formulas or page of specification or drawings may be reproduced and mounted on a blank copy of PO–1050. Failure to use the form has frequently delayed issuance since the text must be retyped by the Office onto a PO–1050.

The exact page and line number where the errors occur in the application file should be identified on the request. However, on form PO–1050, only the column and line number in the printed patent should be used.

The patent grant should be retained. The Office does not attach the certificate of correction to patentee's copy of the patent. The patent grant will be returned to the patentee if submitted.

Below is a sample form illustrating a variety of corrections and the suggested manner of setting out the format. Particular attention is directed to:

a. Identification of the exact point of error by reference to column and line number of the printed patent or to claim number and line where a claim is involved.

b. Conservation of space on the form by typing single space, beginning two lines down from the printed message.

c. Starting the correction to each separate column as a sentence, and using semicolons to separate corrections within said column, where possible.

d. Two inch space left blank at bottom for signature of attesting officer.

e. Use of quotation marks to enclose the exact subject matter to be deleted or corrected; use of double hyphens(- -) to enclose subject matter to be added, except for formulas.

f. Where a formula is involved, setting out only that portion thereof which is to be corrected or, if necessary pasting a photocopy onto form PO–1050.

The examiner's comments are requested on form PO–306 revised, where, under rule 323, there is a question involving change in subject matter.

UNITED STATES PATENT OFFICE

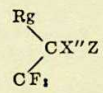
CERTIFICATE OF CORRECTION

Patent No. _____ Dated April 1, 1969

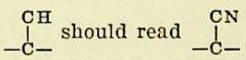
James W. Worth

It is certified that error appears in the above-identified patent and that said Letters Patent is hereby corrected as shown below:

In the drawings, Sheet 3, Fig. 3, the reference numeral 225 should be applied to the plate element attached to the support member 207. Column 7, lines 45 to 49, the left-hand formula should appear as follows:



Column 10, formula XXXV, that portion of the formula reading



Formula XXXVII, that portion of the formula reading "–CH_2CH–" should read -- –CHCH– --. Column 2, line 68 and column 3, lines 3, 8 and 13, for the claim reference numeral "2", each occurrence, should read --1--. Column 10, line 16, cancel beginning with "12. A sensor device" to and including "tive strips." in column 11, line 8, and insert the following claim:

12. A control circuit of the character set forth in claim 1 and for an automobile having a convertible top, and including; means for moving said top between raised and lowered retracted position; and control means responsive to said sensor relay for energizing the top moving means for moving said top from retracted position to raised position.

1403 Statutory Disclaimer [R–44]

35 U.S.C. 253. Disclaimer. Whenever, without any deceptive intention, a claim of a patent is invalid the remaining claims shall not thereby be rendered invalid. A patentee, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of any complete claim, stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, and recorded in the Patent

and Trademark Office; and it shall thereafter be considered as part of the original patent to the extent of the interest possessed by the disclaimant and by those claiming under him.

In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

Rule 321. Statutory disclaimer. (a) A disclaimer under 35 U.S.C. 253 must identify the patent and the claim or claims which are disclaimed, and be signed by the person making the disclaimer, who shall state therein the extent of his interest in the patent. A disclaimer which is not a disclaimer of a complete claim or claims may be refused recordation. A notice of the disclaimer is published in the Official Gazette and attached to the printed copies of the specification. In like manner any patentee or applicant may disclaim or dedicate to the public the entire term, or any terminal part of the term, of the patent granted or to be granted.

(b) A terminal disclaimer, when filed in an application to obviate a double patenting rejection, must include a provision that any patent granted on that application shall be enforceable only for and during such period that said patent is commonly owned with the application or patent which formed the basis for the rejection. See rule 21 for fee.

The examination as to formal matters is done by the Patent Issue Division.

Terminal disclaimers may affect the prosecution of other applications. They are brought to the examiner's attention by the Patent Issue Division which attaches a label to the file wrapper after having a title search made, endorsing the paper on the "Contents" and otherwise insuring that the patent, if issued, will be properly headed.

Terminal Disclaimer in Pending Application Practice

Since the claims of pending applications are subject to cancellation, amendment or renumbering, a terminal disclaimer directed to a particular claim or claims will not be accepted; the disclaimer must be of a terminal portion of the term of the entire patent to be granted. The statute does not provide for conditional disclaimers and accordingly, a proposed disclaimer which is made contingent on the allowance of certain claims cannot be accepted. The disclaimer should identify the disclaimant and his interest in the application and should specify the date when the disclaimer is to become effective. An acceptable form for such a disclaimer is as follows:

To the Commissioner of Patents and Trademarks:

Your petitioner, John Doe, residing at _____ in the county of _____ and State of _____ represents that he is (here state exact interest of disclaimant and, if he is an assignee, set out the liber and page or reel and frame where the assignment is recorded) of Application No. _____, filed on the _____ day of _____ 19__ for _____. Your petitioner hereby disclaims all that portion of the term of any patent to be issued on the said application subsequent to _____ 19____.

The disclaimer must be accompanied by the statutory fee.

Form 53—Terminal Disclaimer To Obviate a Double Patenting Rejection

To the Commissioner of Patents and Trademarks:

Your petitioner, _____, residing at _____ in the county of _____ and State of _____ represents that he is (here state exact interest of the disclaimant and, if he is an assignee, set out the liber and page or reel and frame where the assignment is recorded) of application Serial No. _____, filed on the _____ day of _____, 19__ for _____. Your petitioner, _____, hereby disclaims the terminal part of any patent granted on the above-identified application, which would extend beyond the expiration date of Patent No. _____ and hereby agrees that any patent so granted on the above-identified application shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to United States Patent No. _____, this agreement to run with any patent granted on the above identified application and to be binding upon the grantor its successors or assigns.

Chapter 1500 Design Patents

1501 Rules Applicable
1502 Definition of a Design
1503 Elements of a Design Application
1503.01 Specification and Claim
1503.02 Drawing
1504 Examination
1505 Allowance and Term of Design Patent
1506 Foreign Filing Dates

The right to a patent for a design stems from:

35 U.S.C. 171. Patents for designs. Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

1501 Rules Applicable [R–20]

Rule 151. Rules applicable. The rules relating to applications for patents for other inventions or discoveries are also applicable to applications for patents for designs except as otherwise provided.

Rules 152–155, which relate only to design patents, are reproduced in the sections of this chapter.

1502 Definition of a Design

The design of an object consists of the visual characteristics or aspects displayed by the object. It is the appearance presented by the object which creates an impression, through the eye upon the mind of the observer.

As a design is manifested in appearance the subject matter of a design application may relate to the configuration or shape of an object, to the surface ornamentation thereof, or both.

A design is inseparable from the object and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method.

1503 Elements of a Design Application [R–35]

A design application has essentially the elements required of an application for a patent for a "mechanical" invention or discovery (see Chapter 600). However, unlike the latter where a preamble to the specification is no longer required, a preamble still remains a requirement in a design application (rule 154).

If the single signature form is used it must be accompanied by a separate sheet of specification which includes a preamble.

In design applications, in addition to the instruction set forth in §§ 605.04 to 605.05(a) pertaining to signature and name, if the name is typewritten without the middle initial or name, but the signature contains the middle initial or name, amendment should be required that the typewritten name conform with applicant's signature.

1503.01 Specification and Claim [R–35]

Rule 153. Title, description and claim, oath or declaration. (a) The title of the design must designate the particular article. No description, other than a reference to the drawing, is ordinarily required. The claim shall be in formal terms to the ornamental design for the article (specifying name) as shown, or as shown and described. More than one claim is neither required nor permitted.

(b) The oath or declaration required of the applicant must comply with rule 65 except that the period of twelve months specified therein with respect to foreign applications is six months in the case of designs.

Rule 154. Arrangement of specification. The following order of arrangement should be observed in framing design specifications:

(a) Preamble, stating name of the applicant and title of the design.

(b) Description of the figure or figures of the drawing.

(c) Description, if any.

(d) Claim.

(e) Signature of applicant. (See rule 57.)

If applicant is entitled under 35 U.S.C. 120 to the benefit of an earlier U.S. filing date, the statement that, "This is a division [continuation, continuation-in-part] of design application Serial No. ----------, filed ----------." should appear immediately before the claim heading.

A design application cannot be considered to be a division of a utility application, and is not entitled to the filing date thereof, even though the drawings of the earlier filed utility application show the same article as that in the design application. In re Campbell, 1954 C.D. 191; 101 USPQ 406: Certiorari denied, 348 U.S. 858.

Title

The title is of great importance in a design application. It serves to identify the article in which the design is embodied and which is shown in the drawing, by the name generally used by the public. The title should be to a specific definite article. Thus a stove would be called a "Stove" and not a "Heating Device." The same title is used in the petition, in the preamble to the specification, in the description of the drawing, and in the claim. The title of the article being claimed in a design patent must correspond to the name of the article shown in solid lines in the drawing.

To allow latitude of construction it is permissible to add to the title—"or similar article." The title must be in the singular.

The title implies that the type of article named is old, but that the form shown is new. The title may particularize the type of article named by specifying a use "Bottle for Perfume" or by indicating a structural type—"Vacuum Bottle."

Description

Any description of the claimed design in the specification other than a brief description of the drawing figures is generally not necessary, for as a rule the illustration is its own best description. If there is a special description it should be of the appearance of the article. Special descriptions denoting the nature and environmental use of the claimed design are permissible where an appropriate title cannot satisfy this requirement. Special descriptions describing the construction of the claimed design are not permitted.

Where there is a particular feature of novelty in a case, this feature should be described in the specification by means of a "characteristic" feature clause, rule 71(c).

Statements in the specification which describe or suggest modifications of the design shown on the drawing are not permitted.

A disclaimer directed to any portion of the claim design invention is improper and not permitted in a design application. (35 U.S.C. 112). See Ex parte Remington, 114 O.G. 761, 1905 C.D. 761 and Ex parte Blum, 153 USPQ 177.

Claim

A claim is required and should be in formal terms to the ornamental design for the article (as specified in the title) as shown. Only one claim is permissible. (In re Rubinfield, 1959 C.D. 412; 123 USPQ 210.)

The claim may include the words "and described" following "shown." If there is any descriptive or declaratory matter in the specification other than the brief descriptions or definitions of the drawing figures, the words "and described" must follow "shown."

1503.02 Drawing [R–35]

Rule 152. Drawing. The design must be represented by a drawing made in conformity with the rules laid down for drawings of mechanical inventions and must contain a sufficient number of views to constitute a complete disclosure of the appearance of the article. Appropriate surface shading must be used to show the character or contour of the surfaces represented.

The necessity for good drawings in a design application cannot be overemphasized. As the drawing constitutes substantially the whole disclosure of the design, it is of utmost importance that it be so well executed both as to clarity of showing and completeness that nothing regarding the shape, configuration and surface ornamentation of the article sought to be patented is left to conjecture. An insufficient drawing may be fatal to validity. (35 U.S.C. 112.)

The ornamental design which is being claimed must be shown in solid lines in the drawing. Dotted lines for the purpose of indicating unimportant or immaterial features of the designed article are not permitted. There are no portions of a claimed design which are immaterial or unimportant. In re Blum, 852 O.G. 1045; 153 USPQ 177.

The drawing disclosure should make clear the article on which design patent protection is sought. Environmental structure may be shown only in broken lines, where necessary, as where the nature and intended application of the claimed design cannot be adequately indicated by a reasonably concise title or statement in the specification as set forth in § 1503.01. Such showing by broken lines should not be in a manner as to obscure or confuse the appearance of the claimed design (note 35 U.S.C. 112). In general, such broken lines should not intrude upon or cross the showing of the claimed design; and should not be of heavier weight than the lines used in depicting the claimed design. Where a broken line showing of environmental structure must necessarily cross or intrude upon the representation of the claimed design, an il-

lustration of the article with the broken line showing of environmental structure may be included as a separate figure in addition to the figures fully disclosing the article itself for which the design protection is sought. The specification should make it clear that the structure shown in broken lines is not part of the design sought to be patented.

With practically all articles, except flat, thin goods, such as fabrics, at least two views are necessary, showing the article in three dimensions.

The drawing figures should be appropriately surface shaded to show character or contour of the surface represented. This is of particular importance in the showing of three dimensional articles where it is necessary to clearly delineate plane, concave, convex, raised and depressed surfaces of the article and distinguish between open and closed areas thereof.

While a sectional view that more clearly brings out the design is permissible (ex parte Lohman, 1912 C.D. 336; 184 O.G. 287) those that are presented for the evident purpose of including purely structural features, or exhibiting mechanical functions, are not favored. It is the article as seen by the observer, and not internal structure, which should be shown.

In design applications, as in "mechanical" cases, additional or amended illustration involving new matter is refused entry (35 U.S.C. 132, rule 118). In a design case, erasure of original disclosure may constitute new matter.

The practice of including in the application papers when filed a photograph of the article, or in the case of a flat, thin article such as cloth, a sample showing a complete unit of the design, is permissible and may be followed.

1504 Examination [R–35]

In design cases as in "mechanical" cases, novelty and unobviousness are necessary prerequisites to the grant of a patent. In the case of designs, the inventive novelty resides in the shape or configuration or ornamentation as determining the appearance or visual aspect of the object or article of manufacture, in contradistinction to the structure of a machine, article of manufacture or the constitution of a composition of matter.

The fact that an object is new and ornamental is not conclusive of its patentability as a design, since the ornate effect may be due to color, workmanship, finish, and the like, factors of appearance that play no part in determining the question of patentable design.

Whether or not a design is new and original must generally be determined by a search in the class of design patents to which the article claimed belongs and in analogous classes. If no satisfactory anticipation is found here, the search must be extended to the mechanical group handling inventions of the same general type. Catalogs and trade journals are also consulted. In fact, there are no definite limits to the field of search.

Inasmuch as a design patent deals with appearance only, the test to be applied in determining the question of anticipation is identity or similarity of appearance. If a reference is found that is identical in appearance, the question of patentability is, of course, definitely settled in the negative (35 U.S.C. 102).

However, it more often occurs that the reference differs in some respects from the design claimed and the question of unobviousness is thus presented. Is the difference in configuration or ornamentation in the claimed design unobvious and does the difference add to its ornamental value? Is the difference for structural or functional reasons, or for the purpose of ornamentation? See § 706.

As novelty of configuration or surface ornamentation is a requisite for design patentability, a design which is merely simulative of a known object is not patentable and this is true even though it is used for a different purpose or function.

It is permissible, in a proper case, to illustrate more than one embodiment of a design invention in a single application. However, such embodiments can be presented only if they involve a single inventive concept and are not patentably distinct from each other. An unreasonable number of embodiments of the same invention will not be permitted. The disclosure of plural embodiments does not require or justify more than a single claim which claim must be in formal terms to the ornamental design for an article as shown and described. In re Rubinfield 1959 C.D. 412; 123 USPQ 210.

If two or more patentably distinct articles are disclosed and attempted to be claimed in a single design application, the examiner may require that the application be restricted to one invention. When a requirement for restriction is made, action on the merits of the claim will ordinarily be held in abeyance.

Procedures for handling restriction and double patenting situations are fully covered in Chapter 800 and for interference issues in Chapter 1100.

A utility patent and a design patent may be based on the same subject matter; however, there must be a clearly patentable distinction between them. Where the utility invention as defined by the claims cannot be made without infringing the design, double patenting exists and two patents cannot issue; but no double

patenting is present where a device can be made in accordance with the claims of the utility patent that has an appearance so different from the design as not to infringe the same. (In re Barber, 1936 C.D. 184; 465 O.G. 724; In re Thorington et al, 163 USPQ 644.)

With respect to copies of references provided without charge to applicant in design applications see § 707.05(a). [R–42]

1505 Allowance and Term of Design Patent [R–35]

35 U.S.C. 173. Term of design patent. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant, in his application, elects.

Rule 155. Issue and term of design patents. If, on examination, it shall appear that the applicant is entitled to a design patent under the law, a notice of allowance will be sent to him, his attorney or his agent, calling for the payment of an issue fee in an appropriate amount dependent on the duration of the term desired by the applicant. If this issue fee is not paid within three months of the date of the notice of allowance, the application shall be regarded as abandoned. If this fee is not timely paid but is submitted, with the fee for delayed payment, within three months of its due date with a verified showing of sufficient cause for the late payment, it may be accepted by the Commissioner as though no abandonment had ever occurred.

35 U.S.C. 41(a). Patent fees. 3. In design cases: a. On filing each design application, $20. b. On issuing each design patent: For three years and six months, $10; for seven years, $20; and for fourteen years, $30.

There is a standard filing fee for all design applications. There is also an issue fee which varies according to the term elected for issue. It is no longer necessary for applicants to request notification prior to allowance to afford them the opportunity to choose a longer term. The choice of term is incorporated into the formal notice of allowance form. No design patent will issue unless an issue fee is paid.

The term of a design patent may not be extended by reissue. Ex parte Lawrence, 1946 C.D. 1; 70 USPQ 326. The fee for a design reissue application is $65 (35 U.S.C. 41(a) 4).

1506 Foreign Filing Dates [R–35]

35 U.S.C. 172. Right of priority. The right of priority provided for by section 119 of this title and the time specified in section 102(d) shall be six months in the case of designs.

The provisions of 35 U.S.C. 119 apply also to design applications. However, in order to obtain the benefit of an earlier foreign filing date, the United States application must be filed within six months of the earliest date on which any foreign application for the same design was filed.

Registration of a design abroad is considered to be equivalent to patenting under 35 U.S.C. 119 and 35 U.S.C. 102(d), whether the foreign grant is published or not, Ex parte Weiss. 852 O.G. 255; 159 USPQ 122.

The time for filing the papers required by the statute is the date for payment of the issue fee unless earlier required as specified in rule 55. See § 201.14(a).

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Chapter 1600 Plant Patents

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1601 Introduction: The Act, Scope, Type of Plants Covered

The right to a plant patent stems from:

35 U.S.C. 161. Patents for plants. Whoever invents or discovers and asexually reproduces any distinct and new variety of plant, including cultivated sports, mutants, hybrids, and newly found seedlings, other than a tuber propagated plant or a plant found in an uncultivated state, may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this title relating to patents for inventions shall apply to patents for plants, except as otherwise provided.

Asexually propagated plants are those that are reproduced by means other than from seeds, such as by the rooting of cuttings, by layering, budding, grafting, inarching, etc.

With reference to tuber propagated plants, for which a plant patent cannot be obtained, the term "tuber" is used in its narrow horticultural sense as meaning a short, thickened portion of an underground branch. Such plants covered by the term "tuber propagated" are the Irish potato and the Jerusalem artichoke. This exception is made because this group alone, among asexually reproduced plants, is propagated by the same part of the plant that is sold as food.

The term "plant" has been interpreted to mean "plant" in the ordinary and accepted sense and not in the strict scientific sense and thus excludes bacteria. (In re Arzberger, 1940 C.D. 653; 46 USPQ 32; 27 CCPA 1315.)

35 U.S.C. 163. Grant. In the case of a plant patent the grant shall be of the right to exclude others from asexually reproducing the plant or selling or using the plant so reproduced.

1602 Rules Applicable

Rule 161. Rules applicable. The rules relating to applications for patent for other inventions or discoveries are also applicable to applications for patents for plants except as otherwise provided.

1603 Elements of a Plant Application [R–19]

An application for a plant patent consists of the same parts as other applications and must be filed in duplicate (rule 163(b)), but only one need be signed and executed; the second copy may be a legible carbon copy of the original. Two copies of color drawings must be submitted, rule 165(b). The reason for thus providing an original and duplicate file is that the duplicate file is utilized for submission to the Department of Agriculture for a report on the plant variety, the original file being retained in the Patent Office at all times.

Applications for plant patents which fail to include two copies of the specification and two copies of the drawing when in color, will be accepted for filing only. The Application Branch will notify the applicant immediately of this deficiency and require the same to be rectified within one month. Failure to do so will result in loss of the filing date.

1604 Applicant, Oath [R–25]

Rule 162. Applicant, oath or declaration. The applicant for a plant patent must be the person who has invented or discovered and asexually reproduced the new and distinct variety of plant for which a patent is sought (or as provided in rules 42, 43, and 47). The oath or declaration required of the applicant, in addition to the averments required by rule 65, must state that he has asexually reproduced the plant. Where the plant is a newly found plant the oath or declaration must also state that it was found in a cultivated area.

In an application for a plant patent there can be joint inventors. See Ex parte Kluis et al. Board of Appeals decision in Plant Patent File 707.

1605 Specification and Claim [R–19]

35 U.S.C. 162. Description, claim. No plant patent shall be declared invalid for noncompliance with sec-

tion 112 of this title if the description is as complete as is reasonably possible.

The claim in the specification shall be in formal terms to the plant shown and described.

Rule 163. Specification. (a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

(b) Two copies of the specification (including the claim) must be submitted, but only one need be signed and executed; the second copy may be a legible carbon copy of the original.

Rule 164. Claim. The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

The specification should include a complete detailed description of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, expressed in botanical terms in the general form followed in standard botanical text books or publications dealing with the varieties of the kind of plant involved (evergreen tree, dahlia plant, rose plant, apple tree, etc.), rather than a mere broad nonbotanical characterization such as commonly found in nursery or seed catalogs. The specification should also include the origin or parentage of the plant variety sought to be patented and must particularly point out where and in what manner the variety of plant has been asexually reproduced. Where color is a distinctive feature of the plant the color should be positively identified in the specification by reference to a designated color as given by a recognized color dictionary.

A plant patent is granted on the entire plant. It therefore follows that only one claim is necessary and only one is permitted. A method claim in a plant patent application is improper.

1606 Drawings [R–30]

Rule 165. Drawings. (a) Plant patent drawings are not mechanical drawings and should be artistically and competently executed. Figure numbers and reference characters need not be employed unless required by the examiner. The drawing must disclose all the distinctive characteristics of the plant capable of visual representation.

(b) The drawing may be in color and when color is a distinguishing characteristic of the new variety, the drawing must be in color. Two copies of color drawings must be submitted. Color drawings may be made either in permanent water color or oil, or in lieu thereof may be photographs made by color photography or properly colored on sensitized paper. Permanently mounted color photographs are acceptable. The paper in any case must correspond in size, weight and quality to the paper required for other drawings. See rule 84. Nonpermanently mounted copies will be correctly mounted at applicant's expense, rule 21(l).

1607 Specimens [R–25]

Rule 166. Specimens. The applicant may be required to furnish specimens of the plant, or its flower or fruit, in a quantity and at a time in its stage of growth as may be designated, for study and inspection. Such specimens, properly packed, must be forwarded in conformity with instructions furnished to the applicant. When it is not possible to forward such specimens, plants must be made available for official inspection where grown.

Specimens of the plant variety, its flower or fruit, should not be submitted unless specifically called for by the examiner.

1608 Examination [R–25]

Rule 167. Examination. (a) Applications may be submitted by the Patent Office to the Department of Agriculture for study and report.

(b) Affidavits or declarations from qualified agricultural or horticultural experts regarding the novelty and distinctiveness of the variety of plant may be received when the need of such affidavits or declarations is indicated.

The authority for submitting plant applications to the Department of Agriculture for report is given in:

Executive Order No. 5464, October 17, 1930. Facilitating the consideration of applications for plant patents. I, Herbert Hoover, President of the United States of America, under the authority conferred upon me by act of May 23, 1930 (Public No. 245) [now 35 U.S.C. 164], entitled "An act to provide for plant patents," and by virtue of all other powers vested in me relating thereto, do hereby direct the Secretary of Agriculture: (1) to furnish the Commissioner of Patents such available information of the Department of Agriculture, or (2) to conduct through the appropriate bureau or division of the department such research upon special problems, or (3) to detail to the Commissioner of Patents such officers and employees of the department, as the Commissioner may request for the purpose of carrying said act into effect.

35 U.S.C. 164. Assistance of Department of Agriculture. The President may by Executive order direct the Secretary of Agriculture, in accordance with the request of the Commissioner, for the purpose of carrying into effect the provisions of this title with respect to plants (1) to furnish available information of the Department of Agriculture, (2) to conduct through the appropriate bureau or division of the Department research upon special problems, or (3) to detail to the Commissioner officers and employees of the Department.

With the application judged complete and acceptable for submission to the Department of Agriculture, the duplicate file and duplicate

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drawing (if in color) are forwarded to the Agricultural Research Service, Horticultural Crops Research Branch, Department of Agriculture. It is the practice to forward the duplicate file and duplicate drawing of the application with a letter of transmittal (Form POL–86) including such data as the examiner has developed that will enable the Agricultural Research Service to render a report on the application as to whether the variety of plant disclosed in the application is distinct over known varieties of plant.

The initial step in taking the application up for action is for the examiner to brief the application on the search brief cards (there being a printed form for each of the plant subclasses in class 47), The sufficiency of the specification and drawings are determined as to their completeness and compliance with the rules, and the applicant is advised of any deficiencies in the disclosure. Transmittal of the duplicate file to the Department of Agriculture may be deferred until such time as the applicant submits by appropriate amendment, in duplicate, the necessary additional matter and/or corrections. [R–23]

1609 Report of Agricultural Research Service [R–31]

The report of the Agricultural Research Service (A.R.S.) is usually accompanied by the duplicate file and drawing. The report is in duplicate, the original being signed by the Chief of the Branch. The original copy of the report is retained in the duplicate file. As the report is merely advisory to the Office, it is not a part of the official record of the application and is therefore not given a paper number and is not placed in the original file. The carbon copy of the report is customarily utilized by the examiner in the preparation of his action on the case and is also retained in the duplicate file.

The report may embody criticisms and objections to the disclosure, may offer suggestions for correction of such, may require specimens of the plant, flower or fruit thereof, may require affidavits of recognized authorities to corroborate the allegations of the applicant as to certain or all of the distinguishing features of the variety of plant sought to be patented, may state that the plant will be inspected by a field representative of the Department of Agriculture, etc., or the report may merely state that:

"Examination of the specification submitted indicates that the variety described is not identical with others with which our specialists are familiar."

1610 The Action [R–31]

The action on the application by the examiner will include all matters as provided for in other types of patent applications. See rule 161.

The action may include so much of the report of the A.R.S. as the examiner deems necessary, or may embody no part of it. In the event of an interview, the examiner, in his discretion, may show the entire report to the inventor or attorney.

With reference to the examination of the claim, the language must be such that it is directed to the "new and distinct variety of plant." This is important as under no circumstance should the claim be directed to a new variety of flower or fruit in contradistinction to the plant bearing the flower or the tree bearing the fruit. This is in spite of the fact that it is accepted and general botanical parlance to say—A variety of apple or a variety of blackberry—, to mean a variety of apple tree or a variety of blackberry plant.

Where the application may be allowed a claim which recites, for example—A new variety of apple, characterized by _____ may be amended by the insertion of—tree—after "apple" by an examiner's amendment.

By the same token the title of the invention must relate to the entire plant and not to its flower or fruit, thus: Apple Tree, Rose Plant.

Care should also be exercised that the specification does not contain unwarranted advertising, for example, "the disclosed plant being grown in the XYZ Nurseries of Topeka, Kansas." It follows, also, that in the drawings any showing in the background of a plant, as a sign carrying the name of an individual, nursery, etc., is objectionable and deletion thereof is required. Nor should the specification include laudatory expressions, such as, "The rose is prettier than any other rose." Such expressions are wholly irrelevant. Where the fruit is described, statements in the specification as to the character and quality of products made from the fruit are not necessary and should be deleted.

The Office action is typed with an additional copy which is placed in the duplicate file. The papers in the duplicate file are not noted on the index at the back of the duplicate file wrapper.

When it appears that the application must be resubmitted to the A.R.S., as when the report indicates that the duplicate file and drawing are retained, applicant is notified that response papers must be in duplicate.

Frequently the A.R.S. in its report states that in view of its lack of sufficient information, data, specimens, etc., its specialists are unable to determine whether the variety of plant under

consideration is new and distinct and suggests that the Patent Office require the applicant to submit affidavits or declarations from recognized experts as to the newness of the variety. See rule 167.

The report of the A.R.S. is not in the nature of a publication and matters raised therein within the personal knowledge of the specialists of the A.R.S. are not sufficient basis for a rejection unless it is first ascertained by the examiner that the same can be supported by affidavits by said specialists. (rule 107.) See Ex parte Rosenberg 46 USPQ 393. Board of Appeals decision in Plant Patent File 412.

1611 Issue [R–23]

The preparation of a plant patent application for issue involves the same procedure as for other applications (rule 161), with the exception that where there are colored drawings, the better one of the two judged, for example, by its sharpness or cleanliness is selected, and to this one the issue slip is affixed. The duplicate file is retained in the examining group until after the application has been patented. At certain periods thereafter such duplicate files are collected and sent to the abandoned files for storage.

Chapter 1700 Miscellaneous

1701 Examiners Not to Express Opinion on Validity
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1701 Examiners Not To Express Opinion on Validity [R–35]

Congress, in 35 U.S.C. 282, has endowed every patent granted by the Patent Office with a presumption of validity. Public policy demands that every employee of the Patent Office refuse to express to any person any opinion or view as to the invalidity of any United States Patent. The question of validity or invalidity is exclusively a matter for the courts to determine. Each member of the examining corps is cautioned to be especially wary of any inquiry from any person outside the Patent Office (including any employee of another government agency), the answer to which might indicate that a particular patent should not have been issued.

Further, when a field of search for an invention is requested, Patent Office employees should routinely inquire whether the invention has been patented.

Examiners are especially cautioned against answering inquiries from any person outside the Patent Office as to whether or not a certain reference was considered and whether or not a claim would have been allowed over that reference. This applies to anything in the patented file, including the extent of the field of search and any entry relating thereto. The record of a patented file must speak for itself. Practitioners can be of material assistance in this regard by refraining from making such inquiries of members of the examining corps. Answers to inquiries of this nature must of necessity be refused, and such refusal should be considered neither discourteous nor an expression of opinion as to validity. Searches suggested to members of the public who conduct validity searches might well serve as a basis for concluding that the examiner who examined the application during its prosecution overlooked a pertinent area of prior art during his search. This might adversely affect the presumption of validity in the court of patent litigation.

The examiner who offers suggestions as to fields of search might well find himself in a position where his offer to help might lead to statements made by him which adversely reflect on the patent itself. These statements, while not part of the Patent Office written record, may result in the examiner being sought for testimony in connection with litigation resulting from the issuance of that patent. While § 1701.01 points out that the testimony of examiners can be taken by deposition in appropriate situations, the circumstances noted are not appropriate. Examiner's testimony is limited to factual amplification of the written record established during the application's prosecution history. In validity search situations, comments made by the examiner occur after the fact (issuance of the patent) and could only lead to improper examiner testimony since they amount to "second guessing" of the original examiner's work methods and professional judgment. As pointed out above, the determination of validity of a United States patent is strictly a matter for determination by competent judicial authority.

1701.01 Examiners Not To Testify as Patent Experts [R–40]

Inasmuch as public policy does not permit examiners to decide, as judges in the Patent Office, questions upon which they have been retained to give opinions as expert witnesses in patent cases in the courts, every examiner who shall testify as an expert in a patent case pending in any court will be dismissed, unless he shall have so testified involuntarily, upon compulsion by competent judicial authority, and without retainer or preparation.

Whenever an examiner is asked or subpoenaed to testify in a suit concerning a patent, trademark registration, or application for either, he is directed to report that fact *immediately* to the Solicitor. Where the suit involves a patent or an application for a patent, the examiner must also promptly notify the Office of the Deputy Assistant Commissioner for Patents.

Also, examiners are reminded that, in view of the long established policy of the Patent Office to refuse to permit members of the staff of the Patent Office to testify in patent suits, they should, before allowing an application, determine that the written record is accurate and complete.

Patent examiners are forbidden to testify as patent experts or to express opinions, in testimony or otherwise, as to the invalidity of any issued patent. Patent examiners have, in connection with litigation involving patent validity, been called to testify on factual matters. In those cases, the practice has been to permit the examiner to testify only upon the issuance of a subpoena.

However, under current practice, patent examiners are permitted to testify on deposition in patent suits, without the need for a subpoena, provided the following conditions are satisfied:

1) The party proposing to take the testimony will state in writing, that the questions to be asked of the examiner will be phrased to comply with the permissible scope of inquiry as outlined in the protective orders contained in the Court opinions in In re Mayewsky, 162 USPQ 86, 89, and Shaffer Tool Works v. Joy Manufacturing Co., 167 USPQ 170, 171:

> "* * * the scope of the oral depositions of the patent examiners is hereby limited to matters of fact and must not go into hypothetical or speculative areas or the bases, reasons, mental processes, analyses or conclusions of the patent examiners in acting upon the patent applications maturing into the patent [in suit]." 167 USPQ 171.

2) That in addition to complying with the requirements of Rule 30 of the Federal Rules of Civil Procedure, the party taking the testimony will agree to give notice of the taking of the deposition of the patent examiner to the Solicitor, at least thirty days prior to the date on which the taking of the deposition is desired.

3) That the party taking the deposition arrange with the Solicitor to notice the deposition at a place convenient to the Patent Office.

If the party desiring to take the testimony of the examiner does not agree to the conditions enumerated, the Patent Office will not permit the examiner to be deposed without a subpoena and compliance with the procedure set forth in Section 7.02, Department of Commerce Administrative Order 205–12, June 29, 1967 as amended April 10, 1970. That section states:

> In any case where it is sought by subpoena, order or other compulsory process or other demand of a court or other authority (hereinafter referred to as a "demand") to require the production or disclosure of any record in the files of the Department of Commerce or other information acquired by an officer or employee of the Department as a part of the performance of his official duties or because of his official status, the matter shall be immediately referred for determination to the appropriate official described in subsection 4.01 of this order. If such official has discretion with respect to disclosure and he determines that it would be improper to comply with the demand, or if he has no discretion with respect to disclosure, the matter shall be promptly referred to the Secretary of Commerce for final determination. Unless and until the Secretary determines that the records or information should be produced, the officer or employee who appears in answer to the demand shall inform the court or other authority (a) that the section 7 of this order prohibits the officer or employe from producing or disclosing the records or other information demanded without the prior approval of the Secretary of Commerce, and (b) that the demand has been, or is being, as the case may be, referred for the prompt consideration of the Secretary. The officer or employee shall also provide the court or other authority with a copy of the regulations prescribed in this section 7 of this order, and shall respectfully request the court or other authority to stay the demand pending the receipt of instructions or directions from the Secretary of Commerce concerning the demand.

See also Monsanto Company v. Dawson Chemical Company et al., 176 USPQ 349 (1972), Standard Packaging Corporation v. Curwood, Inc., 180 USPQ 235 (1973) and Fischer & Porter Company v. Corning Glass Works, 181 USPQ 399 (1974).

1702 Restrictions on Examiners Resigning From the Office [R–31]

Extract from Rule 341, Registration of Attorneys and Agents. (g) *Former examiners.* No person who has served in the examining corps of the Patent Office will be registered after termination of his services, nor, if registered before such service, be reinstated, unless he undertakes (1) not to prosecute or aid in any manner in the prosecution of any application pending

in any examining group during his period of service therein; and (2) not to prepare or prosecute nor to assist in any manner in the preparation or prosecution of any application of another filed within two years after the date he left such group, and assigned to such group, without the specific authorization of the Commissioner. Associated and related classes in other groups may be required to be included in the undertaking or designated classes may be excluded. In case application for registration or reinstatement is made after resignation from the Office, the applicant will not be registered, or reinstated, if he has prepared or prosecuted, or assisted in the preparation or prosecution of any such application as indicated in this paragraph. (See further 18 U.S.C. 207).

See also § 309.

1703 The Official Gazette [R–40]

The *Patent Official Gazette* reports every Tuesday the patents, and design patents issued and defensive publications published on that day. As to each patent, the following information is given:

(1) the name and (2) the city and state of residence of the applicant with the Post Office address in the case of unassigned patents, and (3) the same data for the assignee, if any, (4) the filing date, and (5) the serial number of the application, (6) the patent number, (7) the title of the invention, (8) the number of claims, (9) the U.S. classification by class and subclass, (10) a selected figure of the drawing, if any, except in the case of a plant patent, (11) an abstract of the disclosure, (12) international classification, (13) U.S. parent application data, if any, and (14) foreign priority application data, if any. In the case of a reissue patent there are published the additional data of the number and date of the original patent and original application; and in the case of a design patent the term of the patent.

The Patent Official Gazette also includes notices of patent and trademark suits, indexes of patents, disclaimers filed, Certificates of Correction issued, list of patents available for license or sale, and general information such as orders, notices, changes in rules, changes in classification, certain adverse decisions in interferences, the condition of work in the Office, disbarment and registration of attorneys, and notices to parties not reached by mail. Annual subscription $211.00 ($52.75 additional for foreign mailing). Single copy $4.10.

Trademark Official Gazette. The official journal of the Patent Office relating to trademarks. Published every Tuesday, it contains an illustration of each trademark published for opposition, a list of trademarks registered, classified list of registered trademarks and Patent Office notices. Annual subscription $60.25 ($15.10 additional for foreign mailing). Single copy $1.25.

Orders should be addressed and remittances made payable to Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402.

1704 Records Kept in Examining Groups [R–40]

The principal records kept in the examining groups are two sets of cards, serial register form PO–205 which are arranged numerically and docket record form PO–206, of which those awaiting action are arranged by individual examiners. Each card contains data concerning the applications that have been assigned to the groups, identified by name of applicant, title of invention, serial number and filing date. Notation of attorneys is also made. Each set of cards also shows the name of the examiner to whom the examination is entrusted or the assigned docket designation and the class and subclass considered most pertinent for examination, the successive actions taken, and finally the patenting or abandonment or transfer of the case.

Miscellaneous records are also kept relating to matters such as cases on appeal, cases involved in interference, patentability report cases temporarily in or out of the groups, cases involving classification questions and applications or references charged out.

In the past the location and status information on the drum cards of the rotary file in the Application Division did not indicate when an application had been allowed by the group and forwarded to the Patent Issue Division. Information which indicates that an application has been allowed was not posted on the drum cards until the application matured into a patent. Therefore, the Application Division records merely indicated that such an application was pending in an examining group.

This procedure resulted in considerable time and effort being required in order to locate and determine the status of an application which had been allowed by the group but which had not yet matured into a patent.

In order to provide more up-to-date information on applications in this category, a new procedure was adopted on December 11, 1972. Under the new procedure, the date of forwarding and an indication of allowance should be posted on the docket record card of an application when it is allowed by the group and forwarded to the Patent Issue Division. The docket record card is then forwarded to the Application Division.

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On receipt of the docket record card, the Application Division updates the drum card of the rotary file to indicate that the application is now allowed and is in the Patent Issue Division. After the information is recorded on the drum card, the docket record card is destroyed.

1705 Examiner's Work Report and Actions To Be Counted Thereon [R-40]

Marking Action Cards

The following are instructions for completing the mark sense action cards:

Employee number—If the number has less than five digits, use leading zeros. For example, employee number 3781 is marked—03781.

Group—Use first two numbers, for example, for Group 320, mark—32.

Action—For final rejections mark "FIN. REJ.".
For allowances mark "=".
For all other actions mark "other action".

Action number—Prepunched on PO-525, use card number corresponding to action number. Mark the action number on all other action cards.

Art Unit—Use last digit of Group Art Unit number. For example, for Group Art Unit 323, mark —3.

Class—Mark all three columns. If the class has less than 3 digits, mark leading zeros to complete a 3-digit number. Thus, Class 28 is marked —028.

Subclass—Always mark the first three columns. If the subclass has only one or two digits, use leading zeros. Thus, subclass 3 is marked —003.

If a decimal number is a part of the subclass, include the decimal numbers, but do not mark trailing zeros after the decimal number. For example, subclass 32.8 would be marked —032.8.

Ignore any alpha characters in the subclass number. For example, subclass 131.15C would be marked as —131.15.

Classification is to be sense marked on:

1. PO-525 and PO-533 cards for all first actions.

2. PO-525, PO-526, and PO-533 cards for disposals (allowances, abandonments, and examiner's answers).

Classification is not marked on correction cards, PO-531 and PO-532.

Column 11—Column 11 is the one adjacent to the extreme right column (column 12). Column 11 is also above numerals 76 and 77 at the very bottom of the cards.

Column 11 is used in two instances:

1. Mark —0— if the action is a rejection other than a final rejection or a supplemental action.

2. Mark —1— if the action is a SECOND OR SUBSEQUENT ACTION in the case and the first action on the merits.

3. It is no longer necessary to mark —9— if the action was made on overtime. Therefore, —9— should be left blank.

Column 12—Column 12 is the extreme right hand column above numerals 79 and 80 at the bottom of the card.

1. Mark—0— if the action is limited to a requirement for restriction.

2. Mark —1— if the action is an advisory action after final rejection.

3. Mark —2— if the action is an ex parte Quayle action.

4. Mark —3— if the action is an examiner's answer to an appeal brief.

5. Mark —4— if the action involves an interference matter such as a letter suggesting claims, declaration or decision on motion.

6. Mark —5— if the action acknowledges an express abandonment.

7. Mark —6— for miscellaneous actions.

8. It is no longer required that —9— be marked for all actions made after a notice of appeal has been filed in the case. Therefore, line —9— should not be marked.

Series Code

For those action cards for which the series code and serial number are not prepunched and must be handwritten in ink (the Case Action Substitution card (PO-533), the Case Disposition Record card (PO-526), the Case Action Correction card (PO-531), and the Case Disposition Correction card (PO-532), write the appropriate application number *series code* in the box to the left of the serial number box as follows:

A. *For Invention, Plant, and Reissue Applications:*

SERIES CODE:	*Application series*
3	If filing date is prior to January 1, 1960.
4	If filing date is January 1, 1960 through December 31, 1969.
5	If filing date is January 1, 1970 or later.

B. *For Design Applications:*

SERIES CODE:	*Application series*
4	If "D" precedes serial number.
5	If filing date is January 1, 1971 or later *or* "D" does not precede serial number.

The determination of the correct series code must be made solely on the basis of *filing date* of the application. Serial number form and size, file wrapper color, type, and printed statement of series do *not* reliably indicate proper application number series.

Series code and serial number are prepunched in the Case Action Record Card (PO–525). However, for the other action cards, Case Action Substitution (PO–533), Case Disposition Record (PO–526), Case Action Correction (PO–531), and Case Disposition Correction (PO–532), the series code and serial number are not prepunched and must be handwritten in ink.

Serial Number

When recording serial number, there must be 6 digits. Thus, if serial number is less than 100,000, use lead zeros to complete a 6-digit number, e.g., for serial number 2,345, record 002,345 on the cards.

For design applications do not record the "D" even though it is part of the serial number.

Submitting Action Cards

All action cards (especially the Case Action Cards, PO–525's) should be submitted promptly with the application upon completion of an action since pickup of these cards from the Group clerks is on a *daily* basis.

Suggestions

The following suggestions are made relative to execution of the sense marking on the computer "action cards."

Use only the electrographic pencils. Ordinary or colored pencils do not contain enough graphite to produce a sufficiently dark dense mark to conduct electricity.

Make a dense firm mark with a pencil having a moderately sharp point. A broad mark may not obtain a continuous unbroken deposit of graphite. Examiners and clerks should make two strokes within each space.

Mark on a hard smooth surface. Avoid marking on a soft surface such as a blotter, etc.

Confine the mark to the space. Avoid a span which is either too short or too long. When the marked cards pass through the Reproducing Punch, three wire brushes sense the mark in the *middle* as well as at *each end*. Marks which are are too short will not be punched; those which are too long are likely to invade an adjoining vertical column.

Mark each space individually. Although it is possible to mark two or more spaces with an extended pencil stroke, the quality of the mark is impaired.

Do not mutilate or staple the tab cards since a hole in the card will cause mechanical difficulties.

Never write in a mark sensing area. Use only ink when writing on the action cards and write only in the non-marking area of the card.

Reports

All reporting of examiner's production, docket, and time activities is on a bi-weekly basis corresponding to the period covered by the Time and Attendance Reports, PO–516.

The Office of Computer Services generates the following reports for each art unit:

Examiner's Bi-Weekly Time and Activity Report, PO–912—This report is based on the Examiner's Case Action Record, Case Action Correction, Case Disposition, and Substitution Cards, PO–525, PO–531, PO–526 and PO–533, respectively, prepared by the examiner.

Examiner's Bi-Weekly Docket Activity Report, PO–290. This report covers information regarding the new and amended applications awaiting action. The information is

from the PO-690 prepared by the clerk and from a summary record from the Time and Activity Report, PO-912.

The dates of the various desks shall be advanced and reported as the actions are counted. The oldest dates of the group reported shall not be advanced except as the actions are mailed.

Counting of Actions

ACTIONS COUNTED

1. Regular actions in new and amended cases including:
   (a) Requirements for restriction
   (b) Letters or allowances by the examiner as the result of the examination of a new application or the reconsideration or reexamination of an amended application
   (c) Requirements for formal changes or corrections
   (d) Actions of the examiner applying or carrying into effect final decisions in interference, either on motions or on priority
   (e) Actions on cases remanded by an appellee tribunal for reconsideration in view of affidavits or proposed further amendments by appellants.
2. One action for each application which consists only in suggesting claims for interference and one for each application in declaring each interference.
3. Examiner's statements in answer to petitions from his actions.
4. Examiner's answers on appeals.
5. Decisions on motions in interference.
6. Letters advising of entry or nonentry of amendment after final action.
7. Letter advising applicant that express abandonment has taken place and the file will be sent to the Abandoned Files Unit in due course.
8. Declaration or redeclaration of an interference.

Where more than one amendment is filed in any case before it is reached for consideration of the first of such amendments, only one action will be counted in connection with all such amendments.

ACTIONS NOT COUNTED

The following should not be counted as actions: (1) Examiner's Amendments; (2) supplemental actions citing additional references or correcting the data of references of record; (3) letters acknowledging receipt of communications (new or supplemental oaths, orders for corrections of drawings, etc.), which do not bring the application up for action; (4) letters stating that the Notice of Allowance will be sent in due course; (5) answers to petitions to revive or to make cases special, amendments under Rule 312, and to status letters.

Transfers of individual cases and patentability reports are not counted as actions, but credit is given for the time spent.

Examiners are expected to make a reasonably careful examination of applications when they are first received to determine the proper classification before entering them on the register.

Non-examining time is listed on Examiner's Periodic Record of "Other" Time PO-690E. Examiners should check this in order to make sure that they are properly credited with such time.

Counting of Disposals

Examiners receive credit for a disposal upon submission of a first examiner's answer prepared in an appealed application. A Case Action Record Card (PO-525) should be marked in block numbered 3, extreme right hand column and turned in with the examiner's answer.

An examiner's "disposal" count consists of three items: (1) allowances, (2) abandonments, and (3) examiner's answers. These same items constitute the "disposals" for performance evaluation of examining art units and groups. However, disposals at the Office level consists only of allowances and abandonments.

After the first examiner's answer is submitted, the group clerical section should remove the remaining Case Action Cards from the file wrapper. No further disposal credit will be given.

In order to assure that errors be minimal, it is essential that the action cards be carefully mark sensed. The following are common errors which occur:

1. Card mark sensed too light.
2. Incomplete or no class and subclass on first action, allowance or abandonment card.
3. A mark in the last two columns of an abandonment card.
4. Group art unit number invalid.
5. Failure to identify type of "other action".

1706 Disclosure Documents [R-40]

The Patent Office accepts and preserves, for a limited time, "Disclosure Documents" as evidence of the dates of conception of inventions.

The Program

A paper disclosing an invention and signed by the inventor or inventors may be forwarded to the Patent Office by the inventor (or by any one of the inventors when there are joint in-

ventors), by the owner of the invention, or by the attorney or agent of the inventor(s) or owner. It will be retained for two years and then be destroyed unless it is referred to in a separate letter in a related patent application within two years.

The Disclosure Document is not a patent application, and the date of its receipt in the Patent Office will not become the effective filing date of any patent application subsequently filed. However, like patent applications, these documents will be kept in confidence by the Patent Office until a patent is granted.

This program does not diminish the value of the conventional witnessed and notarized records as evidence of conception of an invention, but it should provide a more creditable form of evidence than that provided by the popular practice of mailing a disclosure to oneself or another person by registered mail.

A Disclosure Document is available to the public when an application which refers to it issues as a patent.

Content of Disclosure Document

Although there are no restrictions as to content and claims are not necessary, the benefits afforded by the Disclosure Document will depend directly upon the adequacy of the disclosure. Therefore, it is strongly urged that the document contain a clear and complete explanation of the manner and process of making and using the invention in sufficient detail to enable a person having ordinary knowledge in the field of the invention to make and use the invention. When the nature of the invention permits, a drawing or sketch should be included. The use or utility of the invention should be described, especially in chemical inventions.

Preparation of the Document

The Disclosure Document must be limited to written matter or drawings on paper or other thin, flexible material, such as linen or plastic drafting material, having dimensions or being folded to dimensions not to exceed 8½ by 13 inches (21.6 by 33 cm.). Photographs also are acceptable. Each page should be numbered. Text and drawings should be sufficiently dark to permit reproduction with commonly used office copying machines.

Other Enclosures

In addition to the fee described below, the Disclosure Document must be accompanied by a stamped, self-addressed envelope and a separate paper in duplicate, signed by the inventor, stating that he is the inventor and requesting that the material be received for processing under the Disclosure Document Program. The papers will be stamped by the Patent Office with an identifying number and date of receipt, and the duplicate request will be returned in the self-addressed envelope together with a notice indicating that the Disclosure Document may be relied upon only as evidence and that a patent application should be diligently filed if patent protection is desired. The inventor's request may take the following form:

"The undersigned, being the inventor of the disclosed invention, requests that the enclosed papers be accepted under the Disclosure Document Program, and that they be preserved for a period of two years."

Disposition

The Disclosure Document will be preserved in the Patent Office for two years and then will be destroyed unless it is referred to in a separate letter in a related patent application filed within the two-year period. The Disclosure Document should be referred to in a separate letter filed in a pending application by identifying the Document by its title, number, and date of receipt. Acknowledgement of receipt of such letters is made in the next official communication or in separate letter from the Patent Office. Unless it is desired to have the Patent Office retain the Disclosure Document beyond the two-year period, it is not required that it be referred to in a patent application.

Acknowledgment

When a paper referring to a Disclosure Document is filed in a patent application within two years after the filing of a Disclosure Document, the group clerk either prepares (1) a memorandum indicating that a reference to Disclosure Document No. _____ has been made in application Serial No. _____, or (2) a copy of the paper filed in the application referring to the Disclosure Document. The memorandum or copy is forwarded to the Head of the Correspondence and Mail Division.

Upon receipt, the Correspondence and Mail Division prepares a retention label (PO–150) and attaches it to the Disclosure Document, indicates on the forwarded memo or copy that the retention label has been applied and returns the memo or copy to the group. The returned memo or copy is stapled to the inside left flap of the file wrapper so that the examiner's attention is directed to it when he prepares the next Office action. If prosecution before the examiner has been concluded, a separate letter indicating that the Disclosure Document will be retained should be sent to the applicant by the group clerk.

After the acknowledging letter is mailed, the paper in the application file referring to the Disclosure Document is noted with the paper number of the acknowledgment. The returned memo or copy is stapled to and retained with the original paper in the file wrapper referring to the Disclosure Document.

FEE

A fee of $10 is charged for filing a Disclosure Document. Payment must accompany the Disclosure Document when it is submitted to the Patent Office.

WARNING TO INVENTORS

The two-year retention period should not be considered to be a "grace period" during which the inventor can wait to file his patent application without possible loss of benefits. It must be recognized that in establishing priority of invention an affidavit or testimony referring to a Disclosure Document must usually also establish diligence in completing the invention or in filing the patent application since the filing of the Disclosure Document.

Inventors are also reminded that any public use or sale in the United States or publication of the invention anywhere in the world more than one year prior to the filing of a patent application on that invention will prohibit the granting of a patent on it.

If the inventor is not familiar with what is considered to be "diligence in completing the invention" or "reduction to practice" under the patent law, or if he has other questions about patent matters, the Patent Office advises him to consult an attorney or agent registered to practice before the Patent Office. A *Directory of Registered Patent Attorneys and Agents Arranged by States and Counties* is available for $2.85 from the Superintendent of Documents, U.S. Government Printing Office, Washington, D.C. 20402. Patent attorneys and agents may be found in the telephone directories of most major cities. Also, many large cities have associations of patent attorneys which may be consulted.

1710 U.S.-German Search Exchange [R–34]

The German and U.S. Patent Offices have initiated a continuing program for exchanging search results in cases where applications for the same inventions are filed in both countries.

In general, the plan provides that where an application is filed in the U.S. and LATER a corresponding application claiming U.S. priority is filed in Germany (U.S. origin application), the U.S. search results are sent to the German Patent Office after the first action on the merits. Conversely, the U.S. Patent Office receives a list of references cited by the German examiner in his action on an application filed first in Germany and later in the U.S. (German origin application).

The Customer Services Division, primarily through the Foreign Exchange Unit, is responsible for processing all matters in connection with the exchange program in cooperation with the examining groups.

1710.01 U.S. Origin Applications [R–40]

The German Patent Office will identify German applications which refer to a prior application for patent in the U.S. for the same invention, and request a search report from the U.S. This request is on a printed sheet (blue), designated by them as Form B, which gives the serial number of the U.S. application, and the application number of the German application.

The Foreign Exchange Unit receives and processes the forms. Where the application has been disposed of or has already received an action on the merits, the Foreign Exchange Unit will prepare from the files the list of citations for the German Office. If the U.S. application has not yet been acted on, a printed notice is placed in the inside left section of the file jacket to advise the examiner and the examining group that the search results will be furnished Germany when the action is written. This notice also contains information to assist the group in handling such cases.

The application will be acted on by the examiner when its regular turn is reached except that if it is over 24 months old or when it becomes 24 months old, it is to be made "Special" for the purpose of the first action, or if it is "Special" for some other reason.

When preparing the first action on the merits which contains reference citations, the examiner, when filling out PO–892, Notice of References Cited, will check the box at the bottom marked "Foreign Exchange" and will detach the Notice and include it in the folder with PO–892 which is forwarded to the Reference Processing Section.

If the first action on the merits does not cite any references, or if the application is being passed to issue on the first action, the clerk will check the appropriate place on the notice and return it to the Foreign Exchange Unit.

1710.02 German Origin Applications [R–34]

In the case of a U.S. application which refers to a prior German application for the same in-

vention, German search results are requested by the Foreign Exchange Unit when the U.S. applications are received in Application Division. A form, PO–952, identifying the U.S. and German applications is completed and forwarded to the German Patent Office. At the same time, a notice containing information to assist the group in handling the application is inserted in the left inside section of the file jacket to advise the group that search results may be expected.

In addition to the newly filed applications, cases already pending are included in the program. The Foreign Exchange Unit will identify and locate applications in the group, insert a copy of the notice in the file, and send a request for search results on PO–952 to the German Patent Office.

If the examiner notices an application in which there is a prior filed German application but which has not been marked by placing therein the notice, he may in his own discretion request the German search results through the Foreign Exchange Unit, if there is sufficient time before the case is to be reached for action.

The search report, on Form PO–952 (Form A), when received from Germany, together with copies of any references cited, will be forwarded to the examining group to be placed in the file, by the Foreign Exchange Unit.

Normally, the search report is expected to be received before the U.S. application is reached for action in regular course. If it is not in the file of the application when it is reached for action, an inquiry may be made of the Foreign Exchange Unit to ascertain if it has been received and is in process. But otherwise examination of the application is not to be deferred to await a search report. If one is received after the examiner's action, the references are to be considered in the same manner as references being considered for citation in the second action.

When the examiner is acting on a case in which a search report citing references has been received from Germany (copies of the references will have been placed in the file), he is to proceed with his own search and examination of the application in the usual manner, but taking advantage of any assistance furnished by the references cited by the German examiner; for example, features or anticipations adequately supplied need not be searched for again. The references cited by the German examiner, as well as any additional ones found, are to be considered, and if pertinent, cited and used in the usual manner. References should not be cited merely because they have been listed by the German Patent Office.

As indicated in the joint report published at 838 OG 1225–6, May 23, 1967, an exchange at the present time cannot completely replace the necessity for each office to conduct its own search. In particular, it should be noted that a U.S. patent which issued after the German filing date, but which has an earlier filing date, cannot be used as a reference in the German case and that the German examiner presumably will not have searched such patents, assuming that they had reached Germany. Hence, particular attention should be paid to searching recent U.S. patents. Also, the German examiner searches according to a classification system developed along principles somewhat different from the U.S. classification, and references in related or analogous arts are not used to the same extent as here.

In recording the field of search on the file wrapper, the examiner should indicate in the usual manner those sub-classes in which he has made his usual search; where he has found it necessary to make only a partial or updating search, the listing of the sub-classes thus searched should be so marked.

The search report and the notice are removed from the file when the application is disposed of and retained in the Foreign Exchange Unit.

1711 U.S.-Philippines Search Ex- [R–40]

The United States-Philippines search exchange program involves patent applications filed in the United States which are subsequently followed by corresponding applications filed in the Republic of the Philippines and patent applications filed in the Philippines subsequently followed by corresponding applications filed in the United States.

The program will operate as follows:

The applicant will file his application in the U.S. Patent Office which will process the application in the normal manner and examine the application in the usual time sequence.

If the applicant should later file a corresponding application in the Philippines Patent Office, he may elect to use the special filing procedure. Under this special filing procedure, applicant files his application in the Philippines accompanied by a notice of election to participate in the special procedure; which notice of election contains a certification that the description (excluding references to related applications), claims and drawings are identical to those of the corresponding application originally filed in the United States. The earlier filed application must be fully identified; and, in applications without a claim of priority, a certified copy of the earlier filed U.S. application must be sub-

mitted to the Philippines Patent Office. In addition, applicant must also agree that all amendments to his U.S. application will also be made with respect to his application filed in the Philippines.

In the U.S. Patent Office, applicant will regularly file two copies of each amendment, one copy must be marked "Copy for Philippines Patent Office." Upon termination of prosecution the U.S. Patent Office shall remove all copies so marked from the U.S. file and promptly forward the same to the Philippines Patent Office.

Election forms for participation in this special program must be signed in duplicate and simultaneously accompany the application to be filed in the Philippines.

Upon receipt of properly filed notice of election, the Philippines Patent Office will notify the U.S. Patent Office of the election by forwarding one copy of the election forms to the U.S. Patent Office. The Philippines Patent Office will defer action on the Philippines application pending receipt of information as to the disposition of the application by the U.S. Patent Office. If no such information is received by the Philippines Office within a reasonable amount of time from the date of filing in the Philippines, the Philippines Office may, either on its own initiative, or at applicant's request, inquire as to the status of the U.S. application and, if desired, proceed with its own independent examination.

Upon disposal of the application by the U.S. Patent Office, appropriate information will be sent to the Philippines Patent Office which will include all necessary identifying data, whether allowed or abandoned, notice of allowance, copies of documents cited during examination, a copy of the last office action and, when necessary, any earlier actions which may be included by reference in the last action. The Philippines Office will then make their own complete office action based upon the claims as amended with the U.S. Patent Office, performing whatever checks desired and search for copending interfering applications. Alternatively, the Philippines may request applicant to show cause why the results of the U.S. examination should not be accepted in the Philippines. All avenues of appeal will remain open to the applicant.

Where copending applications are cited and applied during examination in the U.S. Patent Office, full examination will not be forwarded to the Philippines Patent Office, and the fact that a U.S. copending application was cited would be noted as a matter of information, since such references are inapplicable in the Philippines.

Where the application originates in the Philippines Patent Office and is subsequently filed in the U.S. Patent Office, a similar procedure as outlined above consonant with U.S. Law will be followed.

It is believed that this program will facilitate the handling of U.S. origin applications filed in the Republic of the Philippines resulting in a savings in time and expense of prosecution to U.S. applicants.

Election forms for participation in this special program are now available from The Foreign Exchange Unit.

1712 U.S.-Swedish Search Exchange [R–22]

A program for the exchange of search results between the patent offices of Sweden and the United States was initiated in February 1969. The program involves patent applications filed in one country which are subsequently followed by corresponding applications filed in the other.

The program operates as follows:

The applicant files an application in the U.S. Patent Office which then processes the application in the customary manner and in the usual time sequence.

If the applicant later files an application in Sweden claiming the priority of the U.S. application, the Patent Office of Sweden notifies the U.S. Patent Office of this filing by forwarding a request for a list of the references cited by the U.S. examiner in the first office action on the merits.

Where the application originates in Sweden and is subsequently filed in the U.S. Patent Office, a similar procedure is followed whereby the U.S. Office requests and the Swedish Office supplies a list of references cited by the Swedish examiner.

This program, which involves only the furnishing of listings of references cited, could improve the quality of the patents granted by each office.

Appendix I Partial List of Trademarks

The following is a partial list of trademarks which may appear from time-to-time in patent applications. Proper usage of trademarks requires that they be capitalized at all times. See section 608.01(v).

Any question as to whether an apparent trademark is in fact a registered trademark or not, and to what particular goods it applies, should be referred to the Trademark Classification and Search Division (ext. 73281) for determination.

Trademark	*Particular goods on or in connection with which the trademark is used*
Adrenalin	Blood-pressure raising and stimulating preparations
Aerosol	Wetting agents
Airslide	Gravity conveyors
→ Airveyor	Conveyors for conveying and handling materials
Alemite	Automotive lubricants, additives and equipment
Alpha	Protein
Al-Si-Mag	Antacid and absorbent preparations
Alumel	Alloys containing nickel and aluminum
Alundum	Abrasive, polishing and heat refractory materials
Amberlite	Ion exchange resins, jewelry, insulation, resinous materials
Ameripol	Rubber-like materials
Anchor	Fence
Aquadag	Colloidal graphited water
Aqua Pik	Oral hygiene appliance
Areskap	Wetting, spreading and related materials
Aresket	Wetting, spreading and related materials
Aresklene	Wetting, spreading and related materials
Atraumatic	Surgical and dental needles
Bactratycin	Pharmaceutical ointment
Bakelite	Plastics, adhesives, varnishes, etc.
Banbury	Mixers, upholstery material, scotch whisky, tableware
Band-Aid	Bandages and spray antiseptic
Bathinette	Infant furniture
Benzedrine	Medicinal preparation
Betalight	Self powered light sources
Bitumastic	Paints and joint compounds
Black Leaf 40	Tobacco extracts
Blue Rock	Clay pigeon targets
Bobbie	Bobby pins, combs, cigars
Calgon	Water softening chemicals, cleaning agents
Calrod	Electric heating units
Camoquin	Antimalarial preparation
Carbitol	Solvents
Carbofrax	Furnaces, refractory materials, etc.
Carborundum	Abrasives, refractory materials, related equipment
→ Cardioverter	Electronic heart-beat monitor and pacer, etc.
Carousel	Photographic projectors, organs and other items
Catalin	Synthetic resins
Caterpillar	Tractors, engines, treads, etc.
Celanese	Compositions, threads, fabrics, clothing
Celastic	Fabrics, softeners

Trademark	*Particular goods on or in connection with which the trademark is used*
Cello-Solve	Solvents
Cellucotton	Surgical dressing
Celotex	Wallboard and other building materials
Chevron	Machinery packing, petroleum products and other items
Chlorex	Solvents
Chloromycetin	Anti-biotic preparations and sensitivity discs
Chromax	Low conductivity wire, lacquers, castings and other items
Chromel	Alloy
Coca-Cola	Beverages
Coke	Beverages
Corex	Glass paints, seats, tops and other items
Cumar	Resin
Cyclone	Fencing, aircraft engines, seeders and other items
DAA	Diacetone acrylamide
Dacron	Synthetic fibers
Danforth	Anchors, marine hardware and devices
Debeaker	Machine for trimming the beak of a fowl
Decalin	Decahydronaphthalene
Deepfreeze	Home freezers, water heaters and ranges
De-Ion	Electrical equipment
Di-Phenolic Acid	Chemical intermediate
Dry Ice	Solid carbon dioxide, containers and sportswear
Dual-Seal	Covers, strips and insulated glass
Dulux	Resins, paints and other items
Duraloy	Metal alloys
Duraplex	Synthetic alloys
Eidophor	Electrical appartus
Electronic Secretary	Telephone answering apparatus
Electro-Silicon	Cleaning and polishing preparations
Elon	Rayon textile fabric, photographic developer, sunwear
Emulphor	Emulsifying agent
Erector	Toys
Evapor-Ion	Vacuum pumps
Fascinator	Spectacles
Fathometer	Depth measuring apparatus
Fiberglas	Glass fibers and products made therefrom
Flexowriter	Power operated typewriters, tape and ribbons
Flexwood	Fabric backed wood veneer
Fluorophene	Bactericide and fungicide chemicals
Foamite	Fire extinguishing devices and compositions and cups
Footlets	Socks and hosiery
Formica	Flakeboard, adhesives, wall tile, and other items
Freon	Fluorinated hydrocarbons
Gantrisin	Chemo-therapeutic agent
Geon	Polyvinyl resins and automobile parts
Glyptal	Synthetic resins and paints
Go Kart	Miniature automobiles
Gyropilot	Automatic steering mechanism
Gyrosyn	Compass equipment
→ Head	Snow skis and ski clothing
Helanca	Yarns and threads and clothing made therefrom
Hercolyn	Ester of rosin
Hipersil	Magnetic metal alloys
Hovercraft	Vehicles and platfrms supported on a gaseous cushion
Hula-Hoop	Plastic toy hoops

Trademark	*Particular goods on or in connection with which the trademark is used*
Humantin	Antibiotic preparation
Hydrafrac	Hydraulically fracturing oil producing formations
Hydroseal	Plastic cement and other items
Igepon	Washing and scouring agent
Inductosyn	Electrical apparatus
Instant On	Television sets
Intertype	Typesetting
Invar	Alloy
Ironclad	Batteries, bags, cotton fabric, and other items
Jacobs	Tools, coffee, scales, and loom supplies
Jeep	Automobiles, valves, and other items
Jet Line	Hardwear, compressed gas equipment and other items
Kaltron	Pharmaceutical preparations and fertilizer
Kodak	Photographic and related equipment and other items
Kodapak	Solvents, sheets and film cartridges
Koroseal	Various plastic items
Kovar	Alloyed metal
Laminac	Synthetic resins
Lastex	Yarns
Laundromat	Renting of washers in self service laundries
Lavite	Electrical insulation
Leatherette	Fabric, gloves and various paper items
Lexide	Sheet material made of fabric and rubber
Link	Pilot training equipment, computers, servomechanisms
Linotype	Machines for producing type bars
Liquid lead	Ink
Lucite	Plastics and paints
Lux	Aircraft flotation, fire extinguishers and other items
Masonite	Fiberboard and plastics
Methocel	Methyl cellulose
Micarta	Various molded products
Microballoon(s)	Hollow synthetic resin particles
Micro-data	Microfilm equipment
Modutrol	Medicinal preparations and electric motor controls
Monel	Alloys
Monotype	Type casting equipment and insulated wire
Mycalex	Electrical insulating material
Mylar	Plastic film
Nekal	Solvents, wetting agents and other items
Nichrome	Resistance wire, alloys, metal castings
Nico-fume	Insecticide and fumigants
Ni-Rist	Ferrous castings
Nitralloy	Alloy steel
Nonex	Glass lantern and lamp globes and chimneys
O	Silicate of soda
Oilgear	Valves, pumps and hydraulic devices
Orlon	Synthetic fibers
→ Orthomode	Hybrid mixers
Paraplex	Synthetic chemical compositions
Para-sail	Parachutes
Parkerizing	Corrosion resistant coatings, castings, and chemical compositions
Perbunan	Rubber and rubber substitute materials
Perf-a-tape	Joint tape for wallboard
Permutit	Water purifying materials
Phospor bronze	Alloy

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Trademark	*Particular goods on or in connection with which the trademark is used*
Photostat	Cameras and photographic developing equipment
Photronic	Light sensitive cells
Phytin	Pharmaceutical product
Ping-pong	Game apparatus
Pitocin	Pharmaceutical preparation
Plasmatron	Electrical plasma-flame or plasma-jet apparatus
Plastacele	Thermoplastic materials
Plexiglas	Synthetic resin materials
Pliofilm	Rubber derivative films, sheets or strips
Pliolite	Latex, resinous materials and paints
Pliowax	Resinous material for use in paints
Pluronic	Polyoxyalkylene ether
Polane	Chemical addition agents for fuels
Polaroid	Photographic equipment and other items
Polyfoam	Polyurethane foam sheets and electrical lines
Polymerin	Paints, varnishes, and paint enamels
Polynosic	Synthetic textile fibers
Pop	Rivets and rivet tools, chemicals and other items
Porocel	Absorbent materials
Primacord	Detonating fuse
Priscoline	Preparation having an action on blood circulation
Push-Back	Theatre chairs
Pusher	Polymeric compositions and fresh grapes
Pyralin	Pyroxylin enamels, paints, adhesives and other items
Pyrex	Glass, cooking ware, lenses and other items
Ram	Electronic equipment, tools, presses and other items
Refinite	Pool equipment, water softening equipment
Resinox	Synthetic resins
Revertex	Rubber and rubber substitutes
Rice Krispies	Cereal breakfast food
Ripple	Soles, colognes, knives, wines and other items
Rocklath	Plaster board
Rockwell	Hardness tester, tools and other items
Roll-Bond	Heat exchangers and refrigerator evaporators
Roots	Blowers, pumps and meters
Roquefort	Cheese
Rotary Union	Rotary joints
Santomerse	Chemical compounds
Scintillometer	Gamma ray spectrometers
Scotch	Pressure sensitive tape, paper, films and other items
Shakeproof	Electrical terminals, screws, screwdrivers, and gears
Sheetrock	Plaster wall board, plaster and other items
Silastic	Compounds, insulating tape, coatings and silicone dental material
Snap-on	Wrenches, dental polishers and other items
Solid Circuit	Integrated semiconductor networks
Solvesso	Hydrocarbon solvents
Sonar	Fish lures, insecticides and hairdressing
Speed-Nut	Fasteners
Static Mixer	Nozzles for mixing fluid materials
Steel-Flex	Sectional air bags
Stellite	Metal alloys, textile machine parts and machinery
Stenograph	Shorthand machines and ribbons, paper tapes, tripods and instruction materials
Steri-Pad	Surgical dressing
Stiflex	Fiber reinforced rubber compositions
Storm Choke	Subsurface safety valves
Straddle Truck	Vehicles adapted to move piled lumber
Styrofoam	Expanded synthetic resinous material
Sylphon	Heat regulators

Trademark	*Particular goods on or in connection with which the trademark is used*
Sylphrap	Sheets made of regenerated cellulose
Synchrotester	Photographic flash synchronization testers
Synpor	Storage battery separators and retainers
Syntron	Rectifiers, infra-red heaters, tools and other items
Tagalong	Trailers and perfume dispensers
Talon	Fasteners, threads and yarns, tents and other items
Tapper	Keg-like containers and shoe soles
Technicolor	Motion picture films and other items
Teflon	Synthetic resin polymers and products
Teletype	Printing-telegraph apparatus
Teletypesetter	Typesetting and type-casting apparatus
Tenderay	Meat and meat products
Tetralin	Tetrahydronaphthalene
Tetronic	Nonionic polymerized alkylene oxide compound
Textolite	Nonmetallic sheet material
Thenfadil	Antihistaminic preparation
Thermit	Metal compounds for welding
Thermos	Vacuum bottles, camp stoves, tents and other items
Thiokol	Sulfur containing plastics, rocket motors and other items
→ Touch-tone	Telephone communication service and musical instruments
Transite	Asbestos cement pipe and other items
Trav-O-lator	Endless conveyor
Trigger	Indicating and tripping fuses, soap powder, chemical additives for activating salt
Triton	Synthetic organic compounds and other items
Trombone	Sprayers
Twist-Lock	Torch tips and electrical wiring apparatus
Uformite	Synthetic resins
Urotropin	Hexamethylenetetramine or hexamethethylenamine
Vacumatic	Fountain pens, pencils and desk sets
Varsol	Hydrocarbon solvents and oils
Vaseline	Petroleum jelly, medicinal preparations and other items
Velcro	Synthetic materials which adhere when pressed together
Verichrome	Photographic film
Victrola	Records, talking machines, radios and other items
Videofile	Document storage systems
Vinylite	Resins and paints
→ Vise-grip	Wrenches, pliers, closures, clamps, etc.
Vistac	Synthetic hydrocarbon polymers and oils
Vistanex	Compounding agents, adhesives and other items
Votator	Machines for processing fluid, plastic or other materials
Vultex	Rubber latex, bricks and bowling pins
Vycor	Glassware and seal rings
Water Pik	Oral hygiene appliance
Weather-Ometer	Apparatus for testing the effect of weather on objects
Wig-Jig	Frame for holding wigs
→ Wire Nut	Connecting members for joining the ends of wires
Zip	Ball point pens, jewelry, vending machines and other items
Zipper	Electrical plugs, fresh vegetables, belting, cigarettes and undergarments

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Selmi, In re, 1946 C.D. 525; 591 O.G. 160 ---- 706.02(a)
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Thompson v. Hamilton, 1946 C.D. 70; 585 O.G. 177 ---- 1101.02(f)
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Van Otteren v. Hafner et al., 757 O.G. 1026; 126 U.S.P.Q. 151 ---- 201.03
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Numbers agree with those in the Manual of Clerical Procedure.

APPENDIX III

The code indicia listed are suggestive of the subject matter and may more readily be kept in mind.

FORM PARAGRAPHS

1 Abandonment Express — Ab

(Section 711.01)

Applicant's letter of express abandonment in compliance with Rule 138 is acknowledged.

The file will be forwarded to Abandoned Files Unit.

4 Amendment Received After Period for Response Has Expired — Amt late

(Sections 710.02(d), 711.02, 714.17)

The proposed amendment filed _____ (date) has not been entered, because it was received after expiration of the statutory period for response to the Office action dated _____ (Rule 135).

The application will be forwarded to Abandoned Files Unit.

7 Attorney Deceased — Atty dies

(Section 406)

The Patent Office has received notice of the death of the attorney of record. His power, as a consequence, is terminated and a copy of this action is being mailed directly to the applicant. Applicant may appoint a new attorney.

14 Consular Certificate Omitted — Consul

(Section 604.04(a))

The oath is objected to as informal in that it lacks authentication by a diplomatic or consular officer of the United States (Rule 66a). This informality can be overcome only by forwarding the original oath to the appropriate officer for authentication. Applicant should therefore promptly request return of the oath for this purpose. Such request must be accompanied by an order for a copy of the oath to be retained in the file. See Section 604.04(a), MPEP. After authentication, the oath should be returned promptly to the Patent Office.

19 Drawings, Office Cannot Make

(Section 608.02(a))

Applicant is advised to employ the services of a competent patent draftsman outside the Office because the Drafting Branch of the Patent Office does not have the facilities, at the present time, for preparing new drawings.

20 Drawings, Transferred—Case Up for Action

(Section 608.02(l))

In view of the transfer on _____ (date) of the drawings to application Serial No. ____, pursuant to applicant's request under Rule 88, and the intention to abandon this application, the filing of the express abandonment of the instant application is required.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE ONE MONTH FROM THE DATE OF THIS LETTER.

21 Drawings, Transferred—Amendment Received

(Section 608.02(e))

In view of the transfer on _____ (date) of the drawings from this application to application Serial No. ____, pursuant to applicant's request under Rule 88, the proposed amendment submitted on _____ (date) has not been entered.

24 Drawing Mailed to Applicant

(Section 608.02(x))

On _____ (date) the Office Draftsman mailed a new drawing for approval and signature.

A SHORTENED STATUTORY PERIOD FOR SIGNING AND RETURNING THIS DRAWING IS SET TO EXPIRE TWO MONTHS FROM THE DATE OF THIS LETTER.

25 Extension of S.S.P. Ext. SSP

(Section 710.02(e))

THE SHORTENED PERIOD FOR RESPONSE TO THE OFFICE ACTION OF _____ (date) IS EXTENDED UNTIL _____ (date).

No further extension may be granted unless approved by the Commissioner. Rule 136(b).

27 Interference Terminated, Unanswered Office Action

(Sections 710.02(b) and 1109.01)

Interference No. ____ has been terminated by a decision favorable to applicant. Ex parte prosecution is resumed.

However, this application contains an unanswered Office action.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO SUCH ACTION IS SET TO EXPIRE TWO MONTHS FROM THE DATE OF THIS LETTER.

30 Oath, New Required — Stale oath

(Sections 602.05 and 602.05(a))

Since more than 5 weeks plus mailing time elapsed between the date of execution of the oath and the filing of the application, a new oath is required, identifying this application by serial number and filing date, in the body thereof. Rule 65(c).

31 Oath, Specification Omits Parent Case

(Section 201.11)

It is noted that this application appears to claim subject matter disclosed in applicant's prior copending application Serial No. ____, filed _____. A reference to this prior application must be inserted in the specification of the present application, if applicant intends to rely on the filing date of the prior application (Rule 78).

(date)

32 Omnibus Claim — 35 USC 112

(Section 706.03(h))

Claim _____ is rejected for failing to particularly point out and distinctly claim the invention as required by 35 U.S.C. 112.

33 Patent Attorney, Desirable — Get Atty.

(Section 401)

NOTE: Do Not Use If Nothing Patentable Appears To Be Disclosed.

Since the value of a patent is largely dependent upon the skillful preparation of the specification and claims, applicant may consider it desirable to employ the services of a registered patent attorney or agent.

The Office cannot aid in the selection of an attorney or agent.

34 Post-Office Address — P.O.

(Section 605.03)

The application is objected to as informal because applicant's post-office address appears incomplete in that _____. A statement signed by applicant giving his complete post-office address is required.

35 Priority Papers — Priority OK

(Section 201.14(c))

Receipt is acknowledged of papers submitted under 35 U.S.C. 119, which papers have been placed of record in the file.

36 Papers Acknowledgment, Papers in Copending Application

(Section 201.14(c))

Applicant's claim for priority, based on papers filed in (parent) (copending) application Serial No. ____ submitted under 35 U.S.C. 119, is acknowledged.

37 Priority, No Papers — Priority—No copy

(Section 201.14(c))

Acknowledgment is made of applicant's claim for priority based on an application filed in _____ (country) on _____ (date). It is noted, however, that applicant has not filed a certified copy of the _____ application as required by 35 U.S.C. 119.

38 Priority, Not in Oath — Priority—Oath NG

(Section 201.14(c))

Receipt is acknowledged of papers filed _____ (date), based on an application filed in _____ (country) on _____ (date). Applicant has not complied with the requirements of Rule 65(a), since the oath does not acknowledge the filing of any foreign application. A new oath is required if priority under 35 U.S.C. 119 is sought.

40 Priority Papers, Outside Year

(Section 201.14(c))

Receipt is acknowledged of the filing on _____ (date), of a certified copy of the _____ (country) application referred to in the oath. It is not seen how a claim for priority can be based on an application filed in _____ (country) on _____ (date), since the United States application was filed more than one year thereafter. The certified copy is herewith returned.

41 Quayle, Ex Parte — Q

(Sections 710.02(b))

Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE TWO MONTHS FROM THE DATE OF THIS LETTER.

42 Residence Omitted—Case Ready for Issue — No Res.

(Section 605.02)

Applicant's residence has been omitted from the papers.

Because this application is ready for allowance, the city and state of applicant's post-office address will be presumed to be the city and state of his residence.

If the above is incorrect, applicant should submit a statement of his place of residence no later than at the time of payment of final fee.

45 Shortened Statutory Period — SSP 2 or SSP 4

(Section 710.0)

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE _____ MONTHS FROM THE DATE OF THIS LETTER.

48 Status Letter — Status (_____) (date)

The above-identified application is expected to be reached for action on or about _____. (date)

56(a) Venue Lacking in Oath — No Venue

(Section 604.02)

The oath in this application lacks the statement of venue. To correct this defect, applicant is required to furnish either a new oath in proper form, identifying the application by serial number and date of filing, or a certificate by the officer before whom the original oath was taken stating that he was within his jurisdiction when he administered that oath.

56(b) Venue Does Not Agree With Seal — Venue NG

(Section 604.02)

The oath in this application appears defective in that the venue does not correspond with the seal. To correct this defect, applicant is required to furnish either a new oath in proper form, identifying the application by

serial number and date of filing, or a certificate by the executing officer before whom the original oath was taken and stating that he was within his jurisdiction when he administered that oath.

61

When Allowable, Citing Art

(Section 1302.04)

Pat. No. *Date* *Name* *Class & Subclass*

The above patent is cited to show the state of the art.

The application is being prepared for allowance and the Notice of Allowance will be sent in due course.

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Appendix I Table of Orders and Notices

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1888, Jan. 24. Order No. 453. Each Interference Record To Be Complete in Itself. 66 O.G. 1599 _____ 1111.02

———, May 28. Order No. 480. Changing Name of Attorney on the Drawing Forbidden. 81 O.G. 1425_____ 608.02(u)

1889, Feb. 9. Order No. 525. Specification To Be Rewritten if Confused by Erasures and Amendments. 74 O.G. 503_____ 1302.02

———, July 2. Order No. 560. Erasure of Notations Required. 48 O.G. 119_____ 1302.03

1892, June 25. Order No. 767. Entries on File Jacket Limited to Permanent Parts of Record. 60 O.G. 1_____ 717.01

1894, Sept. 4. Notice. Death of a Member of a Firm Having Power of Attorney; New Power Not Required_____ 402.04(a)

1899, Mar. 27. Order No. 1271. Parties Who May Have Access to an Application File___ 104

1900, Aug. 25. Order No. 1365. Suggesting Claims for Interference Involving a Case in Issue. 93 O.G. 557_____ 1101.01(o)

———, Sept. 11. Order No. 1370. Substance of Cited Ms. Decision To Be Given_____ 707.06

1903, Jan. 26. Order No. 1514. Interference Declaration Papers_____ 1102.01(a), 1102.01(b)

———, July 10. Order No. 1537. "Counts Compared" in Interference Papers_____ 1102.01(a)

1906, July 13. Notice. Estimating Cost of Correcting Drawings _____ 608.02(s)

1907, July 19. Order No. 1733. Arrangement of Papers in Application Files_____ 717.01(a)

1908, Apr. 17. Order No. 1759. Entry of Amendment Filed During Interference Proceedings To Await Termination of Interference _____ 1111.05

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1909, June 15. Order No. 1805. Protest Against Issuance of Patent Not To Be Entered in File _____ 1309.02

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———, May 10. Order No. 1854. Disposal of Amendment Filed After Case Is Abandoned_ 714.17

———, June 2. Order No. 1862. Admission of Additional or Substitute Drawings. 156 O.G. 801_____ 608.02(a), 608.02(t)

———, Nov. 15. Order No. 1883. Entry, "Noted" in Interference File on Termination of Interferences _____ 1107

1912, Feb. 3. Order No. 1958. Conditions Precedent to Amendment of Drawing_____ 608.02(q)

———, Mar. 1. Order No. 1961. Unsigned Amendment, Disposal of_____ 714.01(b)

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———, Dec. 20. Order No. 2024. Examiner to Notify Associate Attorney of the Revocation of His Power _____ 402.06(a)

1913, Oct. 14. Order No. 2076. Intervention of Executor Not Compulsory. 195 O.G. 543__ 409.01(f)

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———, July 13. Order No. 2146. Search Noted in File Wrapper_____ 717.05

———, Aug. 4. Notice. Fee Stamp From Embassy or Legation Not Required_____ 604.05

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———, Aug. 11. Notice—Rule 312. Entry of Amendment in Part _____ 714.16(e)

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———, Feb. 12. Notice. In Citing a Commissioner's Order Give Date or O.G_____ 707.06

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1930, Jan. 29. Notice. Losing Party in Interference _____ 1111.09

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———, Feb. 4. Order No. 3141. Amendments That May Be Made by Examiner. 391 O.G. 757 _____ 1302.04

———, Apr. 19. Notice. Orders for Photostats To Be Signed by Primary Examiner_____ 905.01

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———, Oct. 11. Notice. Cases up for Third Action and 5-year Cases To Be Personally Considered by Primary Examiner_____ 707.02(a)

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———, Sept. 27. Notice. Amendment Presenting Suggested Patent Claims After Time Limit, Is Not Entered Without Commissioner's Approval ---------- 1101.02(f)
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———, July 26. Circular, Modified. Present Practice as to Holding of Abandonment for Incomplete Response ---------- 714.03
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